



HIGH COURT OF AUSTRALIA

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Details of Filing

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Important Information

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I CERTIFICATION

1. These submissions are in a form suitable for publication on the internet.

II STATEMENT OF ISSUES

2. These submissions are made pursuant to the Court's request at T2709 - 2716, for the appointment of an *amicus curiae* as contradictor to the contention put by both parties to the effect that any reputation of the registered trade mark should not be taken into account in assessing deceptively similarity between it and an allegedly infringing mark for the purpose of s 120(1) of the *Trade Marks Act 1995* (Cth) (**1995 Act** or the **Act**).
3. It is submitted that in the assessment of deceptive similarity, it is permissible to consider a mark's reputation, at least in the sense of what the mark means to the relevant class of consumer by reason of the registered owner's use of the mark.
4. A review of the authorities reveals that reputation has in fact been taken into account by courts in this way in assessing deceptive similarity under s 120(1) of the Act or its statutory predecessors or analogues. This is the practical reality of considering the 'idea' of a mark and how consumers will remember it, particularly in assessing a mark such as BOTOX which has no meaning except for that which it has come to mean to consumers by virtue of the Respondents' use of the mark generally.
5. Reputation in this sense can only involve the reputation in the mark in the form registered. It cannot include any other elements (such as get-up or the use of a combination of marks) that might go to establishing a trade mark owner's reputation or goodwill in order to found an action in passing off or contravention of s 18 of the *Australian Consumer Law*.
6. It is submitted that the way in which reputation may be relevant will depend on the factual circumstances in each case. There is no reason in principle to limit the treatment of reputation, particularly a strong or 'notorious' reputation of a mark, in such a way that only lessens the risk of 'imperfect recollection' of the mark and consequentially lessens the risk of confusion: *cf CA Henschke & Co v Rosemount Estates Pty Ltd* (2000) 52 IPR 42 (Ryan, Branson and Lehane JJ) (**Henschke FC**), esp. at [52], JBA 369; *Australian Meat Group Pty Ltd v JBS Australia Pty Limited* (2018) 268 FCR 623 at [41], JBA 247; *Swancom Pty Ltd v The Jazz Corner Hotel Pty Ltd* [2022] FCAFC 157 at [80]-[89].

III SECTION 78B NOTICE

7. Notices under s 78B of the *Judiciary Act 1903* (Cth) are not required.

IV CONTESTED FACTS

8. These submissions do not contest the facts.

V ARGUMENT

V.1 The *Trade Marks Act* and its ancestry

9. In considering the question in issue, regard must be had to a long run of Australian and English authorities decided pursuant to successive iterations of trade mark legislation in each jurisdiction. Some of those authorities address sections additional to s 120(1). It is appropriate, therefore, to note the relevant provisions by reference to their legislative ancestry. In *Register of Trade Marks v Woolworths Ltd* (1999) 93 FCR 365, at 369-374, 10 JBA488-493, French J (as his Honour then was) and, at 386-391, JBA505-510, Branson J considered that ancestry, particularly insofar as it concerns certain registrability provisions. These submissions adopt their Honours' analysis and, in connexion with the question of infringement, expand upon it. See also the analysis, especially as to the *Trade Marks Act 1955 (Cth) (1955 Act)*, in *Campomar Sociedad, Limitada v Nike International Limited* (2000) 202 CLR 45 at [40]ff, JBA114ff.
10. Section 10, which falls within Pt 2 (Interpretation) of the *1995 Act*, provides that, 'a trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion'. It reflects, in nearly identical terms, its predecessor, being s 6(3) of the *1955 Act*. No such definition is found 20 in either the *Trade Marks Act 1905 (Cth) (1905 Act (Cth))* or the *Trade Marks Act 1905 (UK) (1905 Act (UK))*, although each placed various prohibitions and restrictions on conduct likely to deceive (or cause confusion).
11. Section 43, which falls within Pt 4 (Application for Registration) Div. 2 (Grounds for rejecting an application) of the *1995 Act*, provides that 'an application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion'. Notably, the required deception or confusion must result from something within the trade mark under consideration, not through a comparison with another trade 30 mark: *Primary Health Care Limited v Commonwealth of Australia* (2017) 260 FCR 359 at [140]. Section 43 and s 60 together reflect the broad provision contained in s 28(a) of the *1955 Act* (*Woolworths* per Branson J at 389, JBA508) and, in part, s 114 of the *1905 Act (Cth)*. Section 28(a) relevantly provided that 'a mark... the use of which would be likely

to deceive or cause confusion... shall not be registered as a trade mark'. Section 114 relevantly provided that '...no mark the use of which would by reason of its being likely to deceive... shall be used or registered as a trade mark or part of a trade mark'. Section 28 found its counterpart in s 11 of the *Trade Mark Act 1938 (UK)* (**1938 Act (UK)**).

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12. Sub-sections 44(1)-(2), also falls within Pt 4, Div. 2 of the *1995 Act* and relevantly provide, subject to the matters set out in ss 44(3) and 44(4), for the rejection of an application for registration if the subject mark is substantially identical with, or deceptively similar to a trade mark with an earlier priority date that is registered by another person in respect of similar goods/services or closely related services/goods. Section 44 is reflected in s 33 of the *1955 Act*, s 25 of the *1905 Act (Cth)* and s 12 of the *1938 Act (UK)*.
13. Section 60, found in Part 5 (Opposition to Registration) Div. 2 (Grounds for opposing registration) of the *1995 Act*, provides that the registration of a trade mark in respect of particular goods or services may be opposed because another trade mark had, before the priority date, acquired a reputation in Australia in respect of those goods or services and, because of the reputation of that other trade mark, the use of the trade mark the subject of the application would be likely to deceive or cause confusion. Section 60, like s 43 referred to at [11] above, reflects s 28(a) of the *1955 Act* and, in part, s 114 of the *1905 Act (Cth)*, and s 11 of *1938 Act (UK)*.
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14. Section 120(1) of the Act provides that '[a] person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered'. Section 62(1) of the *1955 Act*, s 53 of the *1905 Act (Cth)*, and s 4 of the *1938 Act (UK)* dealt with infringement.
15. Section 120(2) provides a defence (broadly equivalent to the Part B defence under s 62(2) of the *1955 Act*) that is not found in s 120(1) of the *1995 Act*: *Anchorage Capital Partners Pty Limited v ACPA Pty Ltd* (2018) 259 FCR 514 at [204]. See also s 5(2) of the *1938 Act (UK)*.
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16. As this Court held in *Campomar* at [42], JBA115, sub-sections 120(3)-(4) reflect an extension of 'the infringement action to restrain activities which are likely adversely to affect the interests of the owner of a "famous" or "well-known" trade mark by the "dilution" of its distinctive qualities or of its value to the owner'. By s 120(3), the owner of a "well-known" mark may prevent a third party's use of a substantially identical or

deceptively similar mark in respect of goods or services unrelated to those covered by the registration. These provisions find no earlier statutory analogues.

V.2 The Trade Marks Act 1994 (UK)

17. The 1994 Act (UK) sits slightly apart from the above legislative developments. It repealed and replaced the 1938 Act (UK), giving effect to the White Paper entitled Reform of Trade Mark Law (Cmnd 1203) and implementing EEC Council **Directive** 89/104 to approximate the laws of member States relating to trade marks – *Halsbury's Statutes*, 4th Edition, Vol 48 p 3 ff: *Woolworths* per French J at [13], JBA488.
18. Section 10(2)(b) of the 1994 Act (UK) implements Article 5(1)(b) of the Directive and provides for infringement of a registered trade mark by the use of a sign in the course of trade which because it 'is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered...there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.'¹
19. In *Wagamama Ltd v City Centre Restaurants PLC* [1995] FSR 713; 32 IPR 613 at IPR 615-617, Laddie J provided useful commentary on the comparison between this provision and its predecessor in s 4 of the 1938 Act (UK).

V.3 The assessment of deceptive similarity: imperfect recollection and impression

20. Save for s 10, the Act is silent as to how a court is to assess deceptive similarity. However, the use of certain words (including those used in s 10) in the Act 'import meanings and applications which have been developed in the case law. Their use suggests the legislature did not intend to jettison the learning that had accrued to them': *Woolworths* per French J at [42] JBA499; Tamberlin J agreeing at [104], JBA514.
21. The classic statements of Windeyer J in *The Shell Company of Australia Limited v Esso Standard Oil (Australia) Limited* (1961) 109 CLR 407 and Dixon and McTiernan JJ in *Australian Woollen Mills Limited v FS Walton and Company Limited* (1937) 58 CLR 641 are set out in the appealed judgment, in the present case **FCJ** [25]-[26], CBA231. These encapsulate the well-established test of judicial estimation of the effect or impression of

¹ Section 10 of the 1994 Act (UK) is set out in full at JBA57-8. A similar provision in s 5(2) of the 1994 Act (UK) applies in the registration context. Cf s 44(2) of the 1995 Act (Cth).

the marks on the minds of potential consumers based on their recollection of the registered owner's mark which may be imperfect.

22. A comparison of word marks requires an assessment of 'their look' and 'their sound'. See *Cooper Engineering Co Pty Ltd v Sigmund Pumps Ltd* (1952) 86 CLR 536 at 538. Courts may also consider 'the idea of the mark' that is the idea that the mark will naturally suggest to the mind of one who sees it: *Jafferjee v Scarlett* (1937) 57 CLR 115 at 121-2 (Latham CJ, McTiernan J agreeing).
23. The 'idea of the mark' is thus a tool courts use to assist their analysis in recognition of the fact that consumers, unlike a court, do not have the opportunity to compare marks side by side. The usual circumstance is that a consumer will see one mark and have a memory of the other mark. Because the issue is whether or not the consumer is likely to be deceived, and not whether on a side by side comparison of the two marks a court considers consumers might be deceived, the 'idea of the mark' enables the court to place itself, as best as possible, into the minds of the consumer: *Telstra Corporation Limited v Phone Directories Company Pty Ltd* (2015) 237 FCR 388 at [213] (Besanko, Jagot, Edelman JJ).
24. The fact that two marks convey the same idea or meaning is not sufficient in itself to satisfy the test of deceptive similarity, however, such a fact can be taken into account in deciding whether two marks which look alike or sound alike are likely to deceive. See *Melbourne Chinese Press Pty Ltd v Australian Chinese Newspapers Pty Ltd* (2004) 63 IPR 38 (Wilcox, Kiefel, Bennett JJ) at [21] referring, *inter alia*, to *Cooper Engineering* at 539.
25. In the submission of the *amicus (amicae) curiae*, reputation may be relevant to the assessment of deceptive similarity in influencing the 'idea of the mark' in the minds of consumers. By reason of the owner's use of the mark certain meanings or associations might be attributed to the mark by consumers, particularly a mark that compromises an otherwise meaningless invented word or an abstract device.
26. In *Lift Shop Pty Ltd v Easy Living Home Elevators Pty Ltd* (2014) 311 ALR 207 the Full Court (Besanko, Yates and Mortimer JJ) observed at [52] 'As the text of s 10 makes clear, it is the resemblance between the competing marks that must be the source of the likely deception or confusion, not other considerations extraneous to the marks themselves.'
27. However, if it is accepted that the 'idea' of a mark may be influenced by an owner's use of it and consequently what it means to consumers, then the taking into account of reputation does not stray beyond consideration of 'competing marks' within s 10.

28. In any event, that reputation may be characterised as, in a sense, ‘extraneous’ to the registered trade mark itself (eg *Lift Shop* at [52]; *Henscke PJ* at [36]) is not fatal to its relevance to the assessment of deceptive similarity in claims for infringement under s 120(1). Long-standing authority allows consideration of various such matters in this context.
29. *First*, courts may take into account of ‘the background of the usages in the particular trade’ (*Shell* at 410), including matters such as the characteristics of the consumers of the relevant goods or services, the circumstances of sale or provision of the goods or services and the manner in which they are marketed. ‘You must consider all the surrounding circumstances’ (*Cooper Engineering* at 538; *Southern Cross* at 594-595, JBA 194-195²) and the market covered by the plaintiff’s monopoly (*Polaroid Corporation v Sole N Pty Ltd* [1981] 1 NSWLR 491 at 498) and the nature and use of third party traders’ marks eg *Cooper Engineering* at 539; *MID Sydney Pty Ltd v Australian Tourism Co Ltd* (1998) 90 FCR 236 at 246D, JBA461.
30. Some of the above may now be considered to be expressly permitted by s 219 of the *1995 Act* (and its predecessor in s 66 of the *1955 Act*) which provide for admissibility of evidence of the ‘usage of the trade concerned and of any relevant trade mark, trade name or get-up legitimately used by other persons.’ However, it is difficult to interpret other trade evidence as falling within this provision, e.g. the Court’s regard to evidence of the particular pronunciations of the marks in issue (LEVI’S and REVISE) in *Wingate Marketing Pty Ltd v Levi Strauss & Co.* (1994) 49 FCR 89 at 105D-G JBA732, per Sheppherd J (Wilcox J agreeing);129B, 130D, JBA756-7 per Gummow J.
31. *Second*, courts may take into account the claimed infringer’s actual intention. If the court finds the claimed infringer has adopted a mark ‘for the purpose of appropriating part of the trade or reputation of a rival, it should be presumed to be fitted for the purpose and therefore likely to deceive or confuse’: *Australian Woollen Mills* at 657, JBA81.
32. *Third*, courts may take into account any evidence of actual confusion, and such evidence is of ‘of great weight’: *Australian Woollen Mills* at 658, JBA82, including under the *1995 Act*; see eg *Melbourne Chinese Press* at [51]: ‘Evidence of actual confusion is relevant to a claim of infringement by reason of deceptive similarity; it goes to the existence of a real

² Citing *Pianotist Co Ltd* (1906) 23 RPC 774 at 777 per Parker J.

and tangible danger of deception or confusion (*Southern Cross* at 595 and 597-8 [JBA195 and JBA197-198]).’

V.4 Reputation: the authorities

33. In contradicting the contention made by both parties to the effect that any reputation of the registered trade mark should not be taken into account in assessing deceptively similarity between it and an allegedly infringing mark for the purpose of s 120(1) of the *1995 Act*, it is convenient to commence the analysis by reference to *Woolworths, C A Henschke & Co v Rosemount Estates Pty Ltd* (1999) 47 IPR 63 per Finn J (*Henschke PJ*), and, in particular, *Henschke FC* on which subsequent cases so heavily rely.
- 10 34. *Woolworths* The question for the Full Court’s consideration was the extent to which, if at all, the reputation in the name ‘Woolworths’ could be taken into account in assessing whether ‘WOOLWORTHS metro’ was ‘deceptively similar’ to ‘metro’ under s 44(2) of the *1995 Act*. French J, at [50], JBA501-2, relying on Kitto J in *Southern Cross* at 594-595, JBA194-195, identified a number of propositions relevant to the assessment of deceptive similarity, including the need to take into account all the ‘surrounding circumstances’ - ‘the circumstances in which the marks will be used, the circumstances in which the goods or services will be bought and sold and the character of the probable acquirers of the goods and services’. French J at [61], JBA505 (Tamberlin J agreeing at [104]-[106] JBA514) approved of the decision at first instance to the effect that
- 20 ‘Woolworths’ ‘should be discounted... having regard to its aural prominence and familiarity to most Australians, it is the element of the mark most likely to be noticed and remembered’. In so doing. French J held that the:
- ...reference to the familiarity of the name “Woolworths” in Australia was appropriate. Where an element of a trade mark has a degree of notoriety or familiarity of which judicial notice can be taken, as is the present case, it would be artificial to separate out the physical features of the mark from the viewer’s perception of them. For in the end the question of resemblance is about how the mark is perceived. In the instant case the visual impact of the name “Woolworths” cannot be assessed without a recognition of its notorious familiarity to consumers.
- 30 35. At [98]-[99], Branson J, in dissent, determined that whether a particular word is familiar to all Australians is irrelevant to ‘the question whether two marks resemble each other’, but were it ‘appropriate to have regard to the wide recognition accorded to the word “Woolworths” in Australia’ that recognition coupled with the use by retailers of home brands was ‘a factor tending to increase, rather than diminish, the risk of confusion’: at [100], JBA514.

36. **Henschke PJ** The relevant question for the Court was whether Rosemount's use of the words 'Hill of Gold' on its proposed wine was deceptively similar to, and therefore infringed Henschke's 'Hill of Grace' mark under s 120(1) of the 1995 Act: *Henschke PJ* at [9]. Finn J stated at [36]:

Before turning to an evaluation of the evidence, it is particularly important in the infringement case to emphasise, as the parties accept, that the reputation of the Hill of Grace wine and such magnetism as it may in consequence exert do not provide a proper or available basis for proving an association between Hill of Gold and Hill of Grace. The comparison is between the marks themselves, ignoring extraneous circumstances: see *Shanahan, Australian Law of Trade Marks and Passing Off* (2nd Ed), 338-339; *New South Wales Dairy Corporation v Murray Goulburn Co-Operative Company* (1989) 14 IPR 26 at 67; and see *Polaroid Corporation v Sole N Pty Ltd* [1981] 1 NSWLR 491. (emphasis added)

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37. Significantly, neither party at first instance disputed that reputation was irrelevant. The authorities relied on by Finn J are considered in detail below. Ultimately, referring to the tests in *Australian Woollen Mills* and *Shell*, Finn J determined that Hill of Gold was not deceptively similar to Hill of Grace and the infringement claim failed: *Henschke PJ* at [37]-[45]. See also *Henschke FC* at [33], JBA361.

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38. **Henschke FC** On appeal, Henschke asked the Court to consider the question of reputation notwithstanding the way in which the matter was argued below, which it did: *Henschke FC* at [35], JBA362. The determination of the Court, *per curiam*, is succinctly summarised in *Meat Group* at [41], JBA [247]:

The limited proposition which the Court accepted Woolworths stood for was not that reputation is relevant generally to deceptive similarity. That is what was being rejected. It was a proposition that deceptive similarity from imperfect recollection might be countered by showing the well-known nature of the registered mark and the lessened likelihood of imperfect recollection.

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39. At [42], JBA364, the Court referred to *Shell* at 410, JBA213 and *MID Sydney* at FCR 245-5, JBA460-461 and stated that the 'deceptiveness that is contemplated must result from similarity; but the likelihood of deception must be judged not by the degree of similarity alone but, by the effect of that similarity in all the circumstances'. The Court then accepted that regard could be had to such matters as 'the background of the usages in the particular trade' ([44], JBA365). Thereafter, however, the Court (at [52], JBA369) rejected the notion that those circumstances might encompass the taking into account of the reputation of the trade mark owner generally. It did so by reference to the distinction that arises between a passing off action and trade mark infringement and its reasoning following thereupon: [44]ff, JBA365ff.

40. This distinction is explained in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at 161, 1B IPR 440 at 452 wherein Greene MR held:

The Statute law relating to infringement of trade marks is based on the same fundamental idea as the law relating to passing off. But it differs from that law in two particulars, namely: (1) it is concerned only with one method of passing off, namely, the use of a trade mark, and (2) the statutory protection is absolute in the sense that once a mark is shown to offend, the user of it cannot escape by showing that by something outside the actual mark itself he has distinguished his goods from those of the registered proprietor.

- 10 41. From this distinction, relying also on *Murray Goulburn* at 67 and *Polaroid* at 497, the Court at [44] and [45], JBA365, observed that ‘what is required is a comparison between the mark of the registered owner and that of the alleged infringer’ such that, in manner said to be ‘consistent’ with authority ‘it is not easy to see what relevance the reputation an applicant may have in a particular mark (even the ‘icon status’ of that mark) has in an action for infringement brought in reliance on s 120(1) of the *1995 Act*’.
42. However, it is submitted, upon a proper consideration, none of *Murray Goulburn*, *Polaroid* nor *Saville Perfumery*, nor indeed, *Aristoc Ltd v Rysta Ltd* [1945] AC 68 (referred to at [45], JBA365) deals with the (ir)relevance of reputation in the manner described above.
- 20 43. As to *Murray Goulburn* and *Polaroid*, both clearly state that it is the totality of the conduct of the *defendant* to which the court does not have regard: [44], JBA365; *Polaroid* at 497. This sits uncomfortably with the broader proposition in respect of which these authorities were called in aid.
44. As to *Saville Perfumery*, it is not at all apparent that Greene MR was intending his reasoning to refer ‘not to the reputation of a particular trader or of a particular name but to the way, or circumstances, in which a particular class of goods is marketed’: [44], JBA365. However, after referring to ocular comparison, Greene MR held at RPC 161, IPR 452:

30 But if the Court were to confine itself to this test the protection afforded by the law of trade marks would in many cases prove illusory... Propositions of this kind, if accepted, would, as it appears to me, divorce the law of trade marks from business realities. In the case of certain goods, traders, and perhaps the public too, may be expected to receive so strong an impression of the actual mark as to lead to the conclusion that nothing short of a degree of resemblance apparent to the eye will cause the necessary likelihood of deception. On the other hand, many articles do not fall within this category. (emphasis added)

45. **Texts** Both *Henschke FC* at [44], JBA 365 and *Henschke PJ* at [36] refer to **Shanahan**³ at 338-339, the latter in support of the proposition that ‘[t]he comparison is between the marks themselves, ignoring extraneous circumstances’.
46. Shanahan at 338 indeed says this in terms, additionally observing that ‘[i]t is well established in the United Kingdom’ and specifying that the ‘extraneous circumstances’ are ‘of the kind that might be relevant in passing off proceedings’. In support of that proposition the learned authors rely on *Kerly’s 12th Ed*⁴ at [14-16]. Both *Henschke FC* at [44], JBA 365 and *Henschke PJ* at [36] also refer to *Kerly’s 12th Ed*, the latter, again, in support of the proposition that extraneous circumstances are to be ignored.
- 10 47. *Kerly’s 12th Ed* at [14-16] states (footnotes interpolated):
- “In actions for infringement the comparison is to be made between the mark as registered, taking into account any disclaimer, and the defendant’s mark as it appears in actual use. [The passage was approved in *Coca-Cola v Struthers* [1968] RPC 231, per Lord Cameron at p 242 (Inner House of Court of Session).] Considerations which may arise in consequence of a particular way in which the plaintiff’s mark may have been used eg additions or variations, though relevant in a claim for passing off, will not generally be relevant when the only question is infringement; it is the marks themselves that must be compared. [*Saville Perfumery* at 175 (HL), [IPR 464-465]. See also Lord Evershed in *Electrolux v Electrix* (1954) 71 RPC 23 at 31.] If the registered mark is inherently likely to lead the public to rely on a particular feature or to ask for the goods by using the name of some device, that is a circumstance to be considered; but where any such practice of the public may have resulted from something other than the use of the registered mark itself, the plaintiff should base his claim on passing off. [*Tatem v Gaumont* (1917) 34 RPC 181.] The “imperfect recollection” of the “ordinary customer” must be borne in mind. Similarly, additions by the defendant, though they might serve to prevent actual deception, will not save the defendant if the registered mark or a mark too nearly resembling it is used. [Where the plaintiff’s mark is only registered in Part B other considerations may apply, see below.]”
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- 30 48. *Kerly’s 12th Ed* at [14-16], is plainly referring to use with additions or variations to the mark or to the get-up upon which the mark appears, by contrast with the mark as registered; it is not referring to reputation. And neither *Struthers* at 242, *Saville* at IPR 464-465, *Electrolux* at 31 nor *Tatem* is authority for the proposition that reputation is extraneous to infringement and thus irrelevant. (Indeed, *Struthers*, at 233, refers to the *Pianotist Co. Ltd* (1906) 23 RPC 774 at 777 to the effect that ‘you must consider all the surrounding circumstances’. See the approach of French J in *Woolworths* described above.)

³ D R Shanahan, *Australian Law of Trade Marks and Passing Off*, 2nd ed 1990 at 338-339.

⁴ A Blanco White and R Jacob, *Kerly’s Law of Trade Marks and Trade Names*, 12th ed 1986.

49. *Henscke PJ* at [36] and *Henschke FC* at [44]-[45], JBA 365-366 are unsupported by the texts.
50. At [45], JBA 366, having analysed the above authorities and texts, *Henschke FC* observes that ‘it is not easy to see what relevance the reputation an applicant may have in a particular mark... has in an action for infringement brought in reliance of s 120(1) pf the TM Act... the course of authority has been quite to the contrary’. With respect, for the reasons articulated above, the Full Court’s conclusion as to the ‘course of authority’ was not open to be made. Against this background the Full Court turned to consider four cases that sit uncomfortably with its conclusion: *de Cordova v Vick Chemical Co* (1951) 68 RPC 103, *Colgate-Palmolive Ltd v Pattron* [1978] RPC 635, *The Coca-Cola Company v All-Fect Distributors Ltd* (1999) 96 FCR 107, and *Woolworths*.
51. *de Cordova* concerned the infringement of the registered trade mark, ‘Vicks VapoRub Salve’, by the use, as a trade name, of the words ‘Karsote Vapour Rub’. Radcliffe LJ held (at 105-106): ‘Since words can form part, or indeed the whole, of a mark, it is impossible to exclude consideration of the sound or significance of those words. Thus it has long been accepted that, if a word forming part of a mark has come in trade to be used to identify the goods of the owner of the mark, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader, for confusion is likely to result.’ *Henschke FC* endeavours to explain the approach of Radcliffe LJ on the basis that ‘[w]hat is to be considered is the significance of a particular word or phrase among traders and consumers in a particular market’ but was itself unconvinced, accepting that it was ‘difficult, nevertheless, to resist’ an acceptance that his Lordship was in fact referring to reputation: [46] JBA366. This Court too should be unconvinced: *de Cordova* is authority for the relevance of reputation (and, in any event, certainly not its irrelevance).
52. *Colgate* concerned the infringement of the registered trade marks, COLGATE, by the use of TRINGATE, and an action for passing off. In determining the infringement case in the plaintiff’s favour, the Court of Appeal of Trinidad and Tobago made reference to the plaintiff’s reputation: 648-649, 652-653. The Privy Council upheld the decision. At 662, Lord Edmund-Davies declared the appeal ‘hopeless’ and, at 666, held ‘on the body of undisputed evidence... it is in their Lordships’ judgment impossible to hold that the Court of Appeal were disentitled to arrive at the conclusions they did... Indeed, had this appeal come direct to this Board from the learned trial judge, their Lordships would have formed exactly the same view.’ Notwithstanding that determination, *Henschke FC* at [47], JBA367 concluded that the Privy Council ‘had in mind principally the passing-off claim. Their

Lordships did not in terms, consider the test of “deceptive similarity”. Certainly they did not endorse a proposition that reputation was generally relevant in applying that test’. With respect, it is difficult to see how, in the circumstances, the Privy Council did not consider deceptive similarity and did not endorse the relevance of reputation. (cf *Hashtag Burgers Pty Ltd v In-N-Out Burgers, Inc* (2020) 159 IPR 186 (Nicholas, Yates and Burley JJ) at [39] FCAFC 235, *In-N-Out Burgers, Inc v Hashtag Burgers Pty Ltd* (2020) 150 IPR 73 at [117] per Katzmann J at [117] both of which held that the Privy Council determined the matter by reference to ‘deceptive similarity’).

53. *Coca-Cola* involved a registered mark being a contour drawing of the glass bottle in which Coca-Cola was traditionally sold. In considering whether the sale, &c. of confectionery shaped like the contour drawing infringed the trade mark pursuant to s 120(2) of the 1995 Act⁵, the Court referred to the extensive nature of Coca-Cola’s reputation, which was common ground before the primary judge ([5]-[7], JBA407-408). In assessing deceptive similarity, the Court in *Coca-Cola* referred to Dixon and McTiernan JJ in *Australian Woollen Mills* at 659, JBA 83, and relied on the fact that ‘the contour bottle is extremely well-known’ as the first factor relevant to assessing deceptive similarity: [41], JBA420. Whilst accepting that the *Coca-Cola* FC considered relevant the ‘extremely well-known’ nature of the contour bottle, *Henschke FC* at [50], JBA368 declared, ‘we do not think that their Honours, by that brief reference, are to be taken to have decided that reputation evidence, of the kind which is undoubtedly relevant in a passing off action, is generally relevant to a question of deceptive similarity’. With respect, noting the plain language of the *Coca-Cola* FC, this conclusion was not open.
54. As to *Woolworths*, having regard to the conclusions reached by the majority, *Henschke FC* sought, *first*, to distinguish it on the basis that it was not an infringement case, *secondly*, carefully to confine the proposition for which it is authority, and, *thirdly*, to reject the existence of authoritative support for any wider proposition as to the relevance of reputation: [52], JBA369. In so doing, the Court held (at [52], JBA369), that *Woolworths* (and *de Cordova*, *Colgate* and *Coca-Cola*) are authority for no wider proposition than, ‘in assessing the nature of a consumer’s imperfect recollection of a mark, the fact that the mark, or perhaps an important element of it, is notoriously so ubiquitous and of such long standing that consumers generally must be taken to be familiar with it and with its use in relation to

⁵ Although a decision under s 120(2), it is to be noted that reliance was made on reputation in assessing deceptive similarity.

particular goods or services is a relevant consideration'. The Court also held (at [52], JBA369-370) that *Murray Goulburn, Polaroid, Aristoc* and *Saville Perfumery* did not support any wider proposition of relevance of reputation attaching to the registered mark on a question of deceptive similarity under s 120(1) of the Act. Nothing in those cases suggests that the proposition should be so confined. And the Court's earlier references of *de Cordova* and *Colgate* are at odds with the proposition for which it says, at [52], JBA369, they stand as authority.

- 10 55. **Swancom** Most recently the Full Court in *Swancom* (Yates, Abraham, Rofe JJ) has said at [80], including by reference to *Henschke FC*, 'There is no scope under s 120(1) to consider the reputation associated with any mark, save (perhaps contentiously) where reputation is a matter of notoriety.'⁶ The Court at [79] noted the observation of an earlier Full Court in *MID Chifley* of the artificiality of the question that 'the person who may be caused to wonder is not one who knows of the actual business of the proprietor of the registered mark' or its goods or services (see *MID Chifley*, JBA460F). However, the very next section of the judgment in *MID Chifley* which does not appear in *Swancom* is:

20 There are however, cases, of which this is one, in which it is appropriate to take into account the use, or proposed use by the alleged infringer and also the character of the registered mark itself... In considering the probability of deception, all the surrounding circumstances need to be taken into consideration [citing Kitto J in *Southern Cross*].

56. Other authorities relied on in *Swancom*, focus not on the reputation of the trade mark owner but on the conduct of the alleged infringer and the principles that:
- a. the question whether there is a likelihood of confusion is to be answered, not by reference to the manner in which the respondent has used its mark in the past, but by reference to the use to which it can properly put the mark: *Berlei Hestia Industries Ltd v Bali Co Inc* (1973) 129 CLR 353 at 362 (per Mason J); and
 - b. it is no answer, under s. 62 (1.) the predecessor to s 120(1) of the 1995 Act, that the defendant's use of the mark is in all the circumstances not deceptive, if the mark itself is deceptively similar: *Marc A Hammond Pty Ltd & Ors v Papa Carmine Pty Ltd* [1976] 2 NSWLR 124.
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⁶ Although noting at [82] that the appellant in that case did not contend that its marks were notoriously ubiquitous.

V.5 Other authorities considering the relevance of reputation

57. Other authorities refer to the relevance of reputation in various ways. They include the following.

58. *Johnson & Johnson v Kalnin* (1993) 114 ALR 215 This case involved consideration of the likelihood of deception or confusion of the mark BAND>>IT in the face of the registered mark BAND AID pursuant to ss 28(a) and 33(1) of the 1955 Act. In dealing with a submission that the BAND AID mark is 'so famous'⁷ that the 'likelihood of any imperfect recollection should be discounted,' Gummow J held at ALR 221:

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The evidence does not admit any conclusions as to the precise mechanisms involved in cognitive processes. But it does suggest that the process of perception and recognition of a word involves not so much the reading of the entire word or, in this case, the compound expressions “band-aid” or “band>>it” but the seeing and identification of certain features which are then matched to that which is contained in the memory, so that the word then is recognised. It is that process which is liable in the present situation to lead persons into error.

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59. Branson J in her dissenting judgment in *Woolworths* at [87], JBA510 suggested that the above consideration of reputation evidence appeared to have been made in the context of s 28(a) and not s 33 of the 1955 Act. However, with respect, that inference is not plain from Gummow J's reasons and is countered by the reference to both provisions in the surrounding paragraph and the reference to 'imperfect recollection' which evokes the test for deceptive similarity under s 33.

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60. *NEC Corporation v Punch Video (S) Pte Limited* [2005] FCA 1126 This was an Appeal from a decision of the **Delegate** of Trade Marks. NEC opposed the registration of NECVOX principally pursuant to s 44 of the 1995 Act. Branson J held that ‘all the surrounding circumstances have to be taken into consideration’: at [15], relying on *Woolworths* at 382, (JBA501-2) per French J (Tamberlin J agreeing). Her Honour found that ‘NEC enjoyed a substantial reputation in the NEC marks in Australia and elsewhere’: at [19]. Upon being asked to consider the impact of reputation in a third party mark, VOXON, Branson J held that in the absence of sufficient evidence concerning it or circumstances permitting judicial notice to be taken of its notoriety it warranted no weight: [24]-[25]. Branson J ultimately, upheld the opposition on other grounds (intention to deceive or cause confusion): at [35].

⁷ Indeed, like BOTOX, it was the subject of a defensive registration.

61. ***Pfizer Products Inv v Karam (2006) 237 ALR 787*** This was an Appeal from a decision of the Delegate concerning Viagra's opposition to HERBAGRA pursuant to ss 43, 44 and 60 of the *1995 Act*. In the context of considering reputation, Gyles J observed at [50], 'I am by no means satisfied that it is appropriate to take reputation into account for the purposes of the comparison relevant for s 44 ... There is support for the use of reputation in connection with infringement (*Henschke FC...* at [51] [JBA369]; *Caterpillar Loader Hire (Holdings) Pty Ltd v Caterpillar Tractor Co* (1983) 48 ALR 511; (1983) 1 IPR 265; (1983) 77 FLR 139 per Lockhart J at 151, Franki J at 141 and Neaves J at 163). It is not clear that, if correct, this is to be imported into s 44 (*cf NEC Corporation v Punch Video (S)*)'.
62. ***Kimberley-Clark Worldwide, Inc v Goulimis (2008) 78 IPR 612*** At [43], Jagot J determined the matter on that basis that reputation was relevant to deceptive similarity insofar as it related to the assessment of the nature of a consumer's imperfect recollection of a mark. Her Honour held that the dominant reputation of the HUGGIES marks in the market for baby-toddler products (particularly personal care products) supported the conclusion that the applicant's mark HUGGIE MUMMY should not be registered in relation to the 'closely related service' of direct selling of baby-toddler's toys, videos, games etc. on the ground of deceptive similarity under s 44(2).
63. ***Mars Australia Pty Ltd v Sweet Rewards Pty Ltd (2009) 81 IPR 354*** This case concerns a claim of infringement of the registered and indisputably famous MALTESERS marks by the words 'Malt Balls'. At [96]-[97] Perram J held that the familiarity of consumers with MALTESERS was 'relevant to assessing a consumer's imperfect recollection of the mark' and diminished the chance of confusion. In upholding the decision on appeal, the Court noted the parties' arguments on reputation, but decided the matter by reference to the descriptive nature of 'Malt Balls' and a visual comparison of the marks; reputation was not determined: *Mars Australia Pty Ltd v Sweet Rewards Pty Ltd* (2009) 84 IPR 12 (Emmett, Bennett, Edmonds JJ) at [21]-[30].
64. ***Singtel Optus Pty Ltd v Optum Inc (2018) 140 IPR 1 (registration)*** This case is another example of application of the *Woolworth's* proposition – notoriety of the registered mark OPTUS was held to lessen the risk of confusion with OPTUM and 'lend further weight to the conclusion' that the marks were not deceptively similar, based on the 'visual and aural differences and the differences in the connotations conveyed by the marks': [140], [143] and [144] per Davies J.

V.6 The United Kingdom position after the 1994 Act

65. In the United Kingdom, reputation is taken into account in assessing the likelihood of confusion (both for registration and infringement purposes) as summarised in *Kerly's Law of Trade Marks and Trade Names*, 16th ed Sweet & Maxwell, London, 2018, at p 409 [11-054]: 'The more distinctive the earlier mark, the greater will be the likelihood of confusion... A mark may have a particularly distinctive character either per se (or as sometimes said, inherently), or because of the reputation it enjoys with the public as a result of use.' See: *Sabel v Puma* (2000) 48 IPR 716 at 735, JBA535. See also: *Kerly's*, 16th Ed, at p 419 [11-081], at p 593 [16-088] and *Comic Enterprises Ltd v Twentieth Century Fox Film* [2016] EWCA Civ 41, [2016] FSR 30 at [31] per Kitchen LJ; *Specsavers International Healthcare Ltd v Asda Stores* [2012] EWCA Civ 24, 2012 FSR 19 at [51] - [52]. Cf Pumfrey J in *Daimler Chrysler v Javid Alavi* [2001] RPC 42 at [80], and in *Reef Trade Mark* [2002] RPC 19 at [14]; and Jacobs LJ at [83] (Rix LJ and Auld LJ agreeing) in *Reed Executive PLC v Reed Business Information Ltd* [2004] RPC 40 (see also *Kerly's* 16th ed First Supplement at [16-094]); Mr Iain Purvis QC in *Kurt Geiger v A-List* BL O-075-13 at [38] and [39].
66. Notwithstanding the amendments brought about by the Directive, the language of s 10(2) of the 1994 (UK) Act (at JBA57) is very close to the combined text of ss 120(1) and 10 of the 1995 Act (Cth), subject to the additional words in the UK provision referring to the likelihood of confusion 'which includes the likelihood of association with the trade mark'. These words have been given a narrow construction, no broader than the 'classic infringement' test under the 1938 Act (UK) of association as to origin: *Wagamama* (above [19]) at IPR 625.33-41. See also IPR 617, 619, 628.

V.7 Conclusions as to reputation

67. It is submitted that the correct approach in considering deceptive similarity under s 120(1) is that propounded by Professors **Burrell and Handler** - recognising that 'reputation can cut in two directions': *Australian Trade Mark Law* 2nd ed, Oxford University Press, 2016 at 406, JBA778.
68. Whether, and the manner in which the reputation of the registered mark may be taken into account in assessing deceptive similarity, will depend on the factual circumstances of each case. These will include the nature of the marks themselves, the manner in which the allegedly infringing mark 'so nearly resembles' the registered mark and whether the alleged infringer's goods or services are likely to be perceived to emanate from the same

source in the sense of a brand extension or sub-brand of the registered mark. See Burrell and Handler at p 405; *Woolworths* at [100] per Branson J discussing ‘home brands’; *In the Matter of John Fitton & Co Limited’s Application* (1949) 66 RPC 110⁸, and *In the matter of the Australian Wine Importers Trade Mark* [1889] 6 RPC 31. See also *Kerly’s* 16th Ed. at [11-061] regarding sub-brands and, relatedly, ‘indirect confusion’. See, similarly, *Kimberley-Clarke* above at [62] and *Pfizer*, above at [61] (albeit in a 60 context).

69. In response to AS[37], the fact that a policy reason for the system of trade mark registration was to avoid the need for proving reputation (in a passing off sense), does not render reputation irrelevant to proceedings under the *1995 Act*. Indeed, certain provisions of the Act expressly require proof of reputation *e.g.* ss 60, 120(3)-(4) and 185. A similar response may be given to RS[34] and the suggestion that consideration of the reputation of a mark impermissibly imports concepts from passing off or ACL actions into trade mark law. The concepts from passing off that are deemed impermissible by the authorities are primarily those associated with the alleged infringer’s particular manner of use of the mark *e.g.* use with other marks, get-up or other matter, disclaimers and different pricing from that of the registered owner. See *e.g.* *Wingate* at FCR 128C- 129A per Gummow J; *Polaroid* at 497.
70. In the context of an invented yet well-known word mark such as BOTOX, to borrow the words of French J (as his Honour then was) in *Woolworths* at [61] JBA505, ‘it would be artificial to separate out the physical features of the mark from the viewer’s perception of them’. That perception or the ‘idea’ of the mark has formulated in the minds of notional consumers as a result of the way that the mark has been used.

V.8 The significance of the defensive mark

71. In the present case, the issue arises in circumstances where the BOTOX has achieved registration in class 3 as a defensive mark under s 185 of the Act by reason of the extent to which it had been used in respect of its registered goods and the resulting likelihood that its use in relation to other goods would be taken to indicate a connection between those other goods and the respondents. It would be an odd result if that very reputation, deemed to cause the relevant connection for s 185 purposes, is disregarded entirely in considering infringement of the mark under s 120(1). In other circumstances, the question of infringement of a well-known mark may arise under s 120(3) but this applies only to use in respect of goods ‘unrelated’ to the goods the subject of the registration. Section 120(3)

⁸ *Vivo International Corporation Pty Ltd v Tivo Inc* (2012) 99 IPR 1 per Nicholas J at [145].

does not apply to BOTOX here because the defensive registration has been granted in respect of similar (in fact the very same) goods to those of the appellant.

VI NOTICE OF CONTENTION

72. The requirement for a Notice of Contention does not arise.

VII TIME ESTIMATE

73. It is estimated that up to one hour will be required for the presentation of the oral argument.

Dated: 1 December 2022

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ANNEXURE

List of Relevant Statutory Provisions

| No. | Title | Section(s) | Relevant Version |
|-----|---|---|---|
| 1. | <i>Trade Marks Act 1995</i> (Cth) | Sections 10, 43, 44, 60, 120, 185, 219 | In force version (Compilation No. 41 dated 1 September 2022) |
| 2. | <i>Trade Marks Act 1955</i> (Cth) | Sections 6,10, 28, 33, 62, 66 | Reprinted as at 28 February 1993 |
| 3. | <i>Trade Marks Act 1905-1934</i> (Cth) | Sections 25, 53, 114 | As at 7 December 1936 |
| 4. | <i>Australian Consumer Law</i> (Schedule 2 to the <i>Competition and Consumer Act 2010</i> (Cth)) | Sections 18 | In force version (Compilation No. 139 dated 5 October 2021) |
| 5. | Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark | Art 9(2)(c) | In force version |
| 6. | <i>Trade Marks Act 1994</i> (UK) | Sections 5,10 | In force version |
| 7. | <i>Trade Mark Act 1938</i> (UK) | Sections 4, 5, 11, 12 | As at commencement |