



HIGH COURT OF AUSTRALIA

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Details of Filing

File Number: S79/2022
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Important Information

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7. Among the matters to be assessed are a mark's look and its sound, and the idea that it naturally suggests to the mind of one who sees it: ACS[20]-[24]. Reputation, insofar as it exists, may bear on the assessment of deceptive similarity in influencing the impression and idea of the mark in the minds of consumers: ACS[4], [25].
8. **Statutory purpose** The statutory purpose is not determinative of the relevance of reputation in the assessment of deceptive similarity. It is uncontroversial that the statutory scheme allows owners of registered trade marks to sue on the marks themselves without proof of reputation, by contrast with an action in passing off. Taking reputation into account does not diminish this underpinning purpose, *cf.* RRACS[4], nor does it promote the 'erosion' or 'collapse' of the distinction between infringement and passing off, *cf.* RRACS[17]. See also ARACS[14]-[17].
9. **Authoritative support** At RRACS [13] it is said that the 'cases give no support for including reputation as a factor to counter (or to favour) a finding of deceptive similarity'. See also ARACS [27]-[28]. This is not so. See *e.g.* ACS[57]-[64] and esp. *Johnson & Johnson* (SJBA D22.326), *Coca-Cola* (JBA D18.404), *Mars* (see ACS[63]). See also: *Adidas AG v Pacific Brands Footwear Pty Ltd (No 3)* (2013) 308 ALR 74 at [218]-[219].
10. **Henschke FC, &c.** *Henschke FC* and decisions following upon it (esp. *Meat Group* (JBA, D14.237), *Swancom*, (SJBA D26.575)) reject the proposition that reputation is relevant to the assessment of deceptive similarity for the purpose of s 120(1). They do support the limited 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. *E.g. Henschke FC* at [52], JBA, D16.345 at 369-370.
11. *Henschke FC* is to be doubted. First, the authorities on which it relies do not support its rejection of reputation more broadly. (Although they do, correctly, make plain that in an infringement action the court does not consider the totality of a defendant's conduct as in a passing off suit.) See: ACS[38]-[49]. Secondly, the authorities *Henschke FC* seeks to reconcile with its approach resist reconciliation. See: ACS[50]-[54]. Thirdly, later authorities do not advance any other or novel basis upon which it might be said that reputation is irrelevant. See *e.g.*: ACS[55]-[56]. *Henschke FC, &c.* advance no proper basis for rejecting the relevance of reputation, nor for suggesting that it might be deployed only against the registered owner to discount likelihood of confusion.
12. **The parties on Henschke FC** The parties assert that reputation is irrelevant to the assessment conducted pursuant to s 120(1) because the authorities upon which *Henschke*

FC relies give no support for its inclusion: ARACS[31]; RRACS [13]ff. This is a straw man. The *AC* submissions dealt with these authorities because they disclose no authoritative basis for *Henschke FC*'s findings *against* the consideration of reputation, as summarised in [10] above, and not because they demonstrate relevance of reputation.

13. **Other matters extrinsic to the mark** A mark's *intrinsic* characteristics, such as its look, are not the only characteristics relevant to the assessment of deceptive similarity. Long-standing authority allows also for consideration of extrinsic matters: ACS[29]-[32]. They include particular pronunciations of the marks in issue (*Wingate*, JBA D30.716), the claimed infringer's actual intention, and any evidence of actual confusion (*Woollen Mills* JBA C8.65). These various factors, including reputation, are to be weighed in all the circumstances. They are not apt for dismissal, as mere '*distractions*' (*cf.* ARACS [23]).
14. **Reputation in the UK** In the United Kingdom, reputation is taken into account in assessing the likelihood of confusion under a similar, albeit not identical, infringement provision in the *Trade Marks Act 1994* (UK), on the basis that the more distinctive the earlier mark, including by reason of reputation as a result of use, the greater the likelihood of deception or confusion: ACS[65]-[66], *Kerly* 16th Ed. at 593[16-088].
15. **Resolution** First, 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 consumers by reason of the registered owner's use of the mark. Secondly, no sound basis exists for ignoring reputation. Thirdly, no sound basis exists for considering it in such a way that it is only capable of lessening the risk of 'imperfect recollection' and consequentially the risk of confusion; it may be considered '*both ways*': Burrell & Handler at 405-6, (JBA E32.776; SJBA E32.545). Fourthly, no sound basis exists for asserting that ss 10 and 120(1) preclude the consideration of reputation derived from use of the registered mark other than in relation to the goods the subject of the registration (*cf.* ARACS [3], [6]). Finally, the way in which reputation may be relevant will depend on the factual circumstances in each case. See: ACS[6], [71].

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