



## HIGH COURT OF AUSTRALIA

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#### Details of Filing

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#### Important Information

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**Part I: Suitable for publication**

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


**Part II: Outline of oral argument**

2. “Reputation”, for present purposes, refers to consumers’ familiarity with a trade mark and with its use in relation to particular goods: *Henschke FC* at [52] (JBA 369). (Appellants’ Submissions in Response to Amicus (ASRA) [6]-[8]). Consideration of reputation, so understood, is irrelevant to the determination of deceptive similarity.
3. Section 120(1) requires a comparison with the mark as registered, not as used. See also s120(2) and (3); ASRA [9], [10], [19], [20], [25], [26]; s 6 “registered trade mark”; s 69(1), s 10. Particulars of registration inform the scope of protection for all marks agnostic as to reputation.
4. According to the test for deceptive similarity set out by this Court in *Shell* (JBA 218-219) and *Australian Woollen Mills* (JBA 82), consumers are imputed with an imperfect recollection of the registered mark. Accordingly, consumers’ actual recollection of the mark is irrelevant. ASRA [13]-[18].
5. Further, taking account of actual recollection of a well known mark (such that consumers are less likely to confuse the mark with another) would be to discourage the more extensive use of marks, contrary to the statutory purpose. By the same token, a suggestion that increased consumer familiarity with a mark *increases* the likelihood of deception (as compared with the imperfect recollection scenario which is ordinarily imputed) would be incoherent as a matter of logic.
6. The imputed recollection is of a notional use of the mark in relation to the registered goods, not any actual use of the mark: *MID Sydney* at FCR 245 (JBA 460). Thus, consumers’ familiarity with the actual use of the mark in relation to particular goods is irrelevant. That is so a fortiori where, as here, the actual use of the mark is in relation to goods not the subject of the asserted registration. It is contrary to the wording, structure and purpose of s 120 to have regard to consumers’ familiarity with the *use* of the registered mark in relation to goods which are *not* the subject of the asserted registration under s 120(1). See also *Wingate* (JBA 755); *Coldstream Refrigerators Limited v Aircraft Pty Limited* (1950) 20 AOJP 1491 at 1496; *SAP Australia Pty Ltd Sapien Australia Pty Ltd* (1999) 169 ALR 1 at [46].
7. Further, a defensive mark registered under s 185 is not treated differently from other marks under s 120. The requirements for registrability of a mark are not the same as the

requirements for establishing infringement, and all marks, however they become registered, are treated equally under s 120: ASRA [38]-[41]; *Swancom* at [67], [68] (SJBA 506) and s 186 of the Act.

8. Where a registered mark consists of a number of elements, it is not a correct application of the imperfect recollection test to say that one element will dominate the imperfect recollection of a mark because it is in fact better known than the other elements (noting that this is not a scenario relevant to the present case). Rather, it is the other way around: the fact that an element of a registered mark has become better known in the trade may be caused by (i.e, reflect or evidence) the fact that it dominates the imperfect recollection of a mark. So understood, evidence concerning consumers' heightened familiarity with one element of a mark having a number of elements may provide support for a conclusion otherwise reached, that the hypothetical consumer, imputed with an imperfect recollection of a notional use of the mark, would recall that element in particular: ASRA, fn 7; *Saville Perfumery* per Viscount Maugham at RPC 174 (SJBA 490).
9. Evidence as to how a word in a mark might be pronounced or is in fact pronounced in the market, or evidence of actual confusion, is not evidence determinative of any relevant question such as what is an essential feature, or the likelihood of deception, but can be a permissible guide or litmus test for judicial determination of the relevant issues.
10. The register of marks is a guide to traders' future name choices, uncomplicated by external and possibly fluctuating reputation.
11. The Respondents' Submissions in Response to Amicus Curiae [28]-[31] and the Full Court judgment paragraphs referred to therein cannot stand with the infringement test that assumes notional use of BOTOX across the relevant class, i.e. it assumes BOTOX is already used on an anti-wrinkle cream. That assumption confounds, and demonstrates the error in, the Full Court approach.

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**A J L Bannon A R Lang**

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0418 162 834

[bannon@tenthfloor.org](mailto:bannon@tenthfloor.org)