



HIGH COURT OF AUSTRALIA

NOTICE OF FILING

This document was filed electronically in the High Court of Australia on 13 Oct 2022 and has been accepted for filing under the *High Court Rules 2004*. Details of filing and important additional information are provided below.

Details of Filing

File Number: S80/2022
File Title: Self Care IP Holdings Pty Ltd & Anor v. Allergan Australia Pt
Registry: Sydney
Document filed: Form 27F - Outline of oral argument
Filing party: Respondents
Date filed: 13 Oct 2022

Important Information

This Notice has been inserted as the cover page of the document which has been accepted for filing electronically. It is now taken to be part of that document for the purposes of the proceeding in the Court and contains important information for all parties to that proceeding. It must be included in the document served on each of those parties and whenever the document is reproduced for use by the Court.

BETWEEN:

SELF CARE IP HOLDINGS PTY LTD (ACN 134 308 151)
First appellant

SELF CARE CORPORATION PTY LTD (ACN 132 213 113)
Second appellant

AND:

10 **ALLERGAN AUSTRALIA PTY LTD (ACN 000 612 831)**
First respondent

ALLERGAN, INC
Second respondent

OUTLINE OF ORAL SUBMISSIONS OF THE RESPONDENTS

Part I: Certification

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

Part II: Outline of Argument

2. **Issues:** The issues for resolution in this appeal, simplified, are as follows:

- (a) Is “PROTOX” deceptively similar to “BOTOX”? (Yes.)
- 20 (b) Did Self Care use “*Instant Botox® Alternative*” as a trade mark in one or more contexts? (Yes.)
- (c) Is “*Instant Botox® Alternative*” deceptively similar to “BOTOX”? (Yes.)
- (d) Do the “defences” in s 122 of the *Trade Marks Act 1995* (Cth) (**TM Act**) operate to protect Self Care from a finding of infringement? (No.)
- (e) Did Self Care engage in misleading or deceptive conduct? (Yes.)

3. **Uncontentious matters:** The Respondents (**Allergan**) emphasise certain uncontentious matters that frame the Court’s consideration of the above issues: **R[14]-[16]**.

PROTOX is deceptively similar to BOTOX

4. The BOTOX registration (as a defensive mark under s 185) is valid and there is no dispute
30 that the goods in relation to which PROTOX is used are those in respect of which BOTOX is registered in class 3: **R[17]-[18]**.

5. The principles as to deceptive similarity under s 120(1) and s 10 are uncontroversial: **R[19]-[21]**. The assessment involves a comparison of the marks from an imperfect recollection of a notional use of BOTOX on Class 3 goods and an estimate of their effect on the minds of potential consumers: *Australian Woollen Mills Ltd v F S Walton & Co Ltd* (1937) 58 CLR 641 at 659. The surrounding circumstances in which the use of the trade mark occurs provides the setting against which to assess consumers’ reaction to the marks: **R[22]**.

6. The Full Court was correct at FC [28]-[33] (CAB 232-233) to find appellable error in the primary judge's failure to ask the right question: **RS [24]**. The Full Court thereafter asked and answered for itself the correct question without appellable error in its dispositive reasoning at FC [41]-[42] (CAB 236). The visual and aural impressions are strongly similar: short consonants before the identical and distinctive -OTOX, being "*undoubtedly very similar in look and sound*". The similarities in impression "*imply an association*". The closeness of PROTOX with the distinctive registered mark BOTOX in the context of the same goods and the unchallenged findings as to the consumer market compel a conclusion of deceptive similarity: **R[25]-[27]**.
- 10 7. FC [43] (CAB 236-237) is unnecessary to the decision. It is responsive to Self Care's reliance upon *CA Henschke & Co v Rosemount Estates Pty Ltd* (2000) 52 IPR 42 at [52]. *Henschke* should be overruled, because the registration, use and reputation of BOTOX on class 5 goods is not relevant to the inquiry posed by s 120(1) and s 10 in relation to class 3 goods: **R[29]-[34]**. If *Henschke* is not overruled, FC [43] explains why Self Care's case still fails: **R[35]**.
8. An additional reason why Self Care must fail on deceptive similarity is that Self Care's decision to cleave closely to BOTOX to capitalise on its fame and reputation is an intention that invokes the rule in *Woollen Mills*: **R[36]-[38]**.

Trade mark use of 'Instant Botox® Alternative':

- 20 9. The principles governing the question of trade mark use are uncontroversial: **R[40]**.
10. Trade mark use must be considered by reference to each separate instance of "*Instant Botox® Alternative*" in the material appearing in RBFM at pages 9-17. When each use of the sign "*Instant Botox® Alternative*" is considered in context, it becomes apparent that Self Care has used the sign as a trade mark: **R[42]-[46]**. *Irving's Yeast-Vite Ltd v Horsnail* (1934) 51 RPC 110 is distinguishable. To the contrary, Self Care's use of the sign "*Instant Botox® Alternative*" is analogous to the infringing use of "*TUB HAPPY*" in *Mark Foys Ltd v Davies Coop & Co Ltd* (1956) 95 CLR 190 at 205: **R[44]**.
- 30 11. PJ [239] (CAB 71) displays appellable error. PJ [247]-[254] (CAB 72-74), while ostensibly directed to a different case which Allergan did not and does not run, might be read as supportive of PJ [239]. In that context, the Full Court was entitled to examine PJ [247]-[254] and correctly found at FC [57]-[70] (CAB 240-243) that they also contain appellable error and thus do not improve upon PJ [239]. In any event, in circumstances where the Full Court was correct to conclude that the sign "*Instant Botox® Alternative*" was used as a trade mark, any deficiency in the Court's reasoning at FC [57]-[70] would not sound in relief: **R[47]-[49]**.

Deceptive Similarity of ‘Instant Botox® Alternative’

12. The Full Court was correct at FC [71]-[76] (CAB 243-245) to find appellable error in the primary judge’s factual assessment. The distinctive and memorable central component of *Instant Botox® Alternative* is effectively identical to BOTOX. Consumers may recall the presence of descriptive words around BOTOX but will not dwell on them to give concrete meaning. The final word “alternative” does not necessarily imply difference as to source. **R[50]-[53]**. The clever crafting of the phrase, with the intention to leverage off BOTOX’s reputation, should have attracted the rule in *Woollen Mills*: **R[54]**.

Section 122 of the TM Act

- 10 13. **Not comparative advertising:** Section 122(1)(d) of the TM Act does not apply in the present context, because: (a) Self Care has not used Allergan’s registered mark BOTOX (simpliciter) as a trade mark: **R[56]**; and (b) in any event, any use of the registered mark BOTOX was not “*for the purposes of comparative advertising*”: **RS[57]**.
14. **Not descriptive use:** Section 122(1)(b)(i) of the TM Act does not apply in the present context, because Self Care’s use of the sign “*Instant Botox® Alternative*” was not (a) descriptive: **R[59]**; or (b) in “*good faith*” on the uncontested findings: **RS[60]**.
15. **Role of section 122(1)(b) and (d):** These provisions are not defences in the strict sense. Rather, they work with s 120 to define what is or is not infringement. If the case falls within them, there is no infringement without further need to enquire whether there would
20 have been infringement under s 120: *Mark Foys* at 197-198; **R[61]-[64]**.

Misleading or deceptive conduct

16. **Issue:** The only issue on appeal concerns the allegation that Self Care’s marketing material at RBFM pages 9-17 conveyed a representation that the effect of Inhibox would last for a period equivalent to that which would be achieved with treatment by Botox injection, as found at FC [114] (CAB 256). Such a representation, if conveyed, was false on the unchallenged findings of fact: **R[66]**.
17. **Resolution:** The Full Court was correct at FC [101]-[103] (CAB 251-252) to find appellable error in the primary judge’s failure to construe Self-Care’s use of the sign “*Instant Botox® Alternative*” in its full context. In turn, the Full Court committed no
30 appellable error at FC [107]-[115] (CAB 253-256) in its findings as to the target market and that the sign in context - which included repeated emphasis on “long term effect” - conveyed the alleged representation: **R[67]-[68]**.

Dated: 13 October 2022



Justin Gleeson SC