

## Article Information

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## Reputation in a Registered Trade Mark not a factor for Deceptive Similarity: Self Care IP Holdings Pty Ltd v Allergan Australia Pty Ltd

The recent High Court decision of *Self Care IP Holdings Pty Ltd v Allergan Australia Pty Ltd*<sup>[1]</sup> provides clarity on the contentious question of the role of reputation in trade mark infringement proceedings.

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On appeal, the Court unanimously overturned the decision of the Full Court of the Federal Court of Australia, where the Full Court held that Self Care IP Holdings Pty Ltd (**Self Care**) infringed Allergan Australia Pty Ltd's (**Allergan**) BOTOX trade mark and misled consumers. Read our insight on the Full Court's decision [here](#).

### Background

Both parties to this decision were manufacturers and sold skin care and anti-wrinkle pharmaceutical products. Self Care sells anti-wrinkle skin care products under the trade marks "FreezeFrame", "Protox" and "Inhibox". "PROTOX" was described as being able to "*prolong the look of Botox*"<sup>[2]</sup> and INHIBOX" was marketed as an "instant Botox alternative".<sup>[3]</sup>

Allergan manufactured the famous "BOTOX" suite of anti-wrinkle products, including the defensive word mark "BOTOX" for class 3 "...*anti-ageing creams; anti-wrinkle cream.*"

### Issues for the High Court

On appeal, the High Court had to consider:

- whether Self Care used the phrase "*instant Botox® alternative*" on its packaging and website as a trade mark;
- if Self Care had used the phrase "*instant Botox® alternative*" as a trade mark, and if so, was it deceptively similar to the registered "BOTOX" trade mark?; and
- whether Self Care's "PROTOX" trade mark was deceptively similar to the "BOTOX" trade mark.

However, in order to properly consider the above, the Court first had to determine if reputation should be considered when assessing deceptive similarity for the purposes of trade mark infringement under section 120(1) of the *Trade Marks Act 1995* (Cth) (**Act**).

### "Instant Botox® alternative"

A trade mark is a sign used, or intended to be used, to distinguish goods from one trader to another, commonly called a "badge of origin".<sup>[4]</sup> As such, any use of a trade mark must be used to indicate a connection between the goods and the user of that trade mark.

The Court held that Self Care's use of "*instant Botox® alternative*" did not amount to a badge of origin and therefore could not be considered to be a trade mark for the following reasons:

- "*instant Botox® alternative*" was not displayed consistently across Self Care's packaging and website, with different fonts and sizes often used, indicating that it was not used as a 'badge of origin';<sup>[5]</sup> and

- the phrase frequently appeared alongside two actual badges of origin, being ‘FREEZEFRAME’ and ‘INHIBOX’ which were both considered to be distinctive and stylised marks.[\[6\]](#)

As the Court held that “instant Botox® alternative” was not used as a trade mark, it did not need to assess any deceptive similarity nor comparative advertising defences.

### **Reputation and deceptive similarity**

The Court was tasked with deciding if reputation in a trade mark can be relied upon when determining if infringement of a trade mark has occurred. Both Self Care and Allergan had agreed prior to the appeal that the reputation in a trade mark is not relevant when determining deceptive similarity under s120(1) of the Act.

Due to the significance and contentious nature of the issue, the Court appointed two specialist IP barristers as *amicae curiae* (‘friends of the Court’) to assist the Court.[\[7\]](#) The *amicae curiae* contended that taking into account reputation in assessing deceptive similarity was practical in considering how potential consumers will remember a trade mark, particularly in the context of BOTOX, as the word itself had no ordinary signification except for what it has come to mean in relation to Allergan’s use of the trade mark.[\[8\]](#)

The Court considered that the decisions *Registrar of Trade Marks v Woolworths Ltd*, *CA Henschke & Co v Rosemount Estates Pty Ltd* and *Australian Meat Group v JBS Australia Pty Ltd* confirmed the difficulty the courts have had reconciling the use of reputation within the text and practical operation of s120(1).[\[9\]](#) In those decisions, reputation was considered relevant where it may lessen the risk of “*imperfect recollection*” when assessing deceptive similarity.

The Court held that reference to, or reliance on, reputation in a trade mark when assessing registered trade mark infringement under s120(1) is impermissible. The hypothetical person or notional buyer is a person with no knowledge of any use of the registered trade mark, the goods and services produced, any acquired distinctiveness in the trade mark and importantly, any reputation associated with the trade mark.[\[10\]](#)

For clarity, there are only four instances where the consideration of reputation is required by the Act in the assessment of a trade mark:

- Section 24 – considering whether a trade mark has become “*generic*”;[\[11\]](#)
- Section 60 – determining the reputation acquired by a prior registered trade mark and that because of that reputation, the use of an applicant’s trade mark would be likely to deceive or cause confusion;[\[12\]](#)
- Section 120(3) – the infringement of a “*well known*” trade mark in Australia;[\[13\]](#) and
- Section 185 – registering a defensive trade mark;[\[14\]](#)

### **PROTOX v BOTOX**

Given that reputation does not need to be considered in section 120(1) infringement cases, the Court held that whilst Allergan was correct, and there were visual and aural similarities between the two marks, PROTOX and BOTOX,[\[15\]](#) it was unlikely that consumers would confuse the two. This was because the words were sufficiently different, and that there was no “real, tangible danger” of confusion or deception occurring.[\[16\]](#)

The Court noted that whilst the phrase “*prolong the look of Botox®*” incorporated the trade mark “BOTOX”, it did not suggest an affiliation between the two products; products will often suggest that they can be used to enhance another trader’s product without an association between the two.[\[17\]](#)

### **What does this mean for reputation?**

This decision clarifies the position of reputation in assessing deceptive similarity in section 120(1) trade mark infringement proceedings. It also highlights the importance of claims of misleading or deceptive conduct or tort of passing off where a plaintiff wishes to rely on reputation.

Piper Alderman has a nationally recognised intellectual property practice which has experience in both registering trade marks and infringement proceedings in all Australian jurisdictions.

[\[1\]](#) [2023] HCA 8.

[\[2\]](#) Ibid [70].

[\[3\]](#) Ibid [55].

[4] *Campomar Sociedad Limitada v Nike International Ltd* (2000) 202 CLR 144, [65].

[5] *Self Care IP Holdings Pty Ltd v Allergan Australia Pty Ltd* [2023] HCA 8 [55].

[6] *Ibid*, [56].

[7] *Ibid* [35].

[8] *Ibid*.

[9] *Registrar of Trade Marks v Woolworths Ltd* (1999) 93 FCR 365, *CA Henschke & Co v Rosemount Estates Pty Ltd* (2000) 52 IPR 42 and *Australian Meat Group* (2018) 268 FCR 623.

[10] *Self Care IP Holdings Pty Ltd v Allergan Australia Pty Ltd* [2023] HCA 8 [49] - [50]. It is worth noting that *Registrar of Trade Marks v Woolworths Ltd* was concerned with the registrability of a trade mark, and not infringement. The statements made in *Henschke* were considered obiter, and not binding, while *Australian Meat Group* tried to reconcile the two previous cases, somewhat inconsistently, by accepting that while reputation was not relevant for deceptive similarity, it *might* be used to counter propositions that there was deceptive similarity arising from imperfect recollection.

[11] *Ibid* 20 [45].

[12] *Ibid* 19 [42].

[13] *Ibid* 19 [44].

[14] *Ibid* 19 [43].

[15] *Ibid* [69].

[16] *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592, 595.

[17] *Self Care IP Holdings Pty Ltd v Allergan Australia Pty Ltd* [2023] HCA 8 [70]