



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: Appellants' Further Reply

“instant Botox® alternative” – trade mark use

2. Contrary to the Respondents' submission, there was no occasion for appellate intervention in the primary judge's determination that there had been no use of “instant Botox® alternative” as a trade mark in accordance with his reasons at PJ[114], [229]-[246], [255] CAB44, 68-72, 74. Those paragraphs deploy reasoning reflecting the principles accurately set out by the primary judge at PJ[159]-[162] CAB54-55. It was a factual determination made by the primary judge seized of all the facts and with the benefit of extensive submissions of the same nature as those of the Respondents in this court (T3030-3474) and indeed the Appellants (T731-931).
3. The Respondents do not justify the Full Court's appellate intervention on the basis of any error shown in those reasons. Rather, they justify the Full Court addressing, not those reasons, but what appears at PJ[246]-[254] CAB72-74 because in the course of the Full Court appeal it was submitted that those paragraphs, which relate to use of BOTOX *simpliciter* as a trade mark, provided additional support for the primary judge's finding (T3421-3452). There are four difficulties with that submission. First, the Full Court's reasons do not reflect that course of appeal submission as no reference is made to that as a reason why the Full Court address those paragraphs at all or only those paragraphs. On the contrary, at FCJ[49] CAB239 the Full Court refers to PJ[234], but not PJ[239], and then at FCJ[50] mistakenly states that “*the primary judge concluded it [ie. “instant Botox® alternative”] was not used as a trade mark for four reasons*” being the reasons at PJ[246]-[254]. Secondly, it was the Respondents (Allergan) who submitted to the Full Court that those were relevant reasons. In any event, even accepting that characterisation of the course of the appeal, it provides no justification for the Full Court failing to address at all the actual reasons of the primary judge for his determination on the issue and *a fortiori* failing to identify error in those reasons. Thirdly, regardless of the course of the appeal, PJ[246] unequivocally states that what follows is addressing only the question of whether “Botox” alone was used as a trade mark. PJ[247]-[255] reflect precisely that exercise. Each paragraph is framed as support for the conclusion that BOTOX *simpliciter* is not used as a trade mark. The language of those paragraphs is

plainly not addressing the question of whether the composite phrase “*instant Botox® alternative*” was used as a trade mark. That had already been addressed.

4. Fourthly, despite what appears at FCJ[56]-[57] CAB240-241, there was plainly no error in the primary judge’s conclusion in the relevant paragraphs that BOTOX *simpliciter* was not used as a trade mark. The Respondents do not advance a case that BOTOX *simpliciter* was used as a trade mark (T3424-3427).
5. Rather, FCJ[56]-[57] criticise the primary judge for failing to find that “*instant Botox® alternative*” would or might indicate an association between the product and Allergan, a matter irrelevant to trade mark use.
- 10 6. The Respondents in this Court are unable to justify the Full Court’s reasons for reversal of the primary judge’s conclusion on trade mark use. As submitted in chief, the Full Court’s reasons for finding that “*instant Botox® alternative*” was used as a trade mark are clearly infected by an application of an incorrect test, namely an examination of whether “*instant Botox® alternative*” indicates an affiliation with the supplier of Botox injectable product.
7. In this Court the Respondents accept that that is the incorrect test and that the Full Court was incorrect to deploy that test (T3469). The Respondents invite this Court to read the Full Court reasons otherwise than as they are expressed by notionally deleting parts (T3457, 3460-3461). But it is impermissible. FCJ[57], [65] and [67]
- 20 CAB240-243 are clear conclusions that “*instant Botox® alternative*” conveys an association with Allergan and for that reason, is use as a trade mark and FCJ[66] forms part of the same process of reasoning. Contrary to the Respondents’ submission at T3462-3463, the reference to Protox in FCJ[57] was not a slip as the Full Court itself recognised (FCJ2[27] CAB276-277). Even if the phrase did convey the association with Allergan (which it did not), it does not render its employment use *as a trade mark*.
8. The Respondents’ approach is to invite this Court to engage in the same exercise again as the primary judge did, uninfected by the Full Court error. Ignoring for present purposes the absence of a notice of contention inviting this Court to uphold
- 30 the Full Court’s decision for reasons other than those expressed, it is open to this Court to conclude that the Full Court’s reasons did not justify its intervention in the primary judge’s determination, and in those circumstances there is no reason for this

Court to disturb that determination. Rather the Court might restore it, without having to revisit the question afresh.

9. But this Court revisiting the issue afresh does not produce a different outcome as the primary judge's conclusion was clearly correct. In addition to the matters already identified in chief, the Appellants reply to the further matters identified by the Respondents as follows.
10. Contrary to the Respondents' submission (T3156-3210; 3239-3272; 3532-3534; 3629-3635), *Mark Foys* does not advance the question. The passage at 194 (173) is not directed to trade mark use but the registrability of "Tub Happy" as a distinctive mark. At 197 (176) the advertising deployed by the defendant is summarised as including "Tub Happy" prominently displayed in text the same size as the brand Exacto Garments. It is quite unlike the present case. Further, it is not an example of the use of a third party's mark in a comparative phrase, such as in *Yeast-Vite*.
11. Contrary to the Respondents submission (T3380-3387), the internet page at RBFM p16, which like all of the internet pages in the RBFM are from the freeze-frame brand website at the <freeze-frame.com.au> domain name, does not present "Instant Botox® ALTERNATIVE" as a brand or a product. The brand name Inhibox appears immediately above it under the umbrella brand name Freeze-frame. An image of the product which can be purchased on the left bears the brand name Freeze-frame and, in smaller font, the brand name Inhibox. It does not bear the phrase "Instant Botox® ALTERNATIVE". That phrase is rather an affirmation of a quality in the product category for which the viewer was searching by clicking through "Injection Free Alternative" which appears as one of the available selections above the blue band and then further clicking on Inhibox within that product category. That is apparent from "Home/Injection Free Alternative/Inhibox 10ml" which appears in the blue band immediately above "INHIBOX 10 ML". The capitalisation of ALTERNATIVE emphasises that characteristic. There is nothing to indicate that a customer could link directly to any of the webpages without coursing through from the Freeze-frame homepage. In relation to the Respondents' submissions concerning RBFM p17 (T3310-3314), the page is cut off at the top. It is not possible to determine the route to that page but inferentially it is likely to be the same as p16.

“instant Botox® alternative” – deceptive similarity

12. For reasons already submitted orally in reply in relation to Protox (T4253-4341), contrary to the Respondents’ submission (T3476-3479), there was no appellable error in the primary judge’s finding that *“instant Botox® alternative”* was not deceptively similar to BOTOX, namely there is no error in not making specific reference to confusion as to source or origin at the stage of the deceptive similarity analysis in circumstances where the assumption is that the phrase is used as a trade mark denoting origin (contra FCJ[72] CAB244).
13. Again, the Respondents are in the position of being unable to support the reasoning of the Full Court because it is accepted that it deploys the Botox reputation for injectables and further fails to make the correct comparison with the notional use of Botox on creams (T3490-3575). In particular, FCJ[74]-[75] CAB244-245 are clearly infected by both errors as previously submitted. The primary judge’s approach at PJ[256], [257] CAB74 is not so infected.
14. Any revisitation of that issue by this Court on the grounds now proposed by the Respondents does not produce a different outcome.
15. The Respondents’ reliance on a test involving “dominant cognitive cue” (T3487; 3508; 3549) warrants specific mention. That expression first appeared in *Accor Australia & New Zealand Hospitality v Liv* (2017) 345 ALR 205 [2017] FCAFC 56 at [206]. The time-honoured test of trade mark comparison is that regard must be paid to the “essential features” of the marks in determining substantial identity or deceptive similarity (*de Cordova v Vick Chemical Co* (1951) 68 RPC 103 at p106; *Shell* at 414.8 (217); *Eclipse Sleep Products v Registrar of Trade Marks* (1957) 99 CLR 300 at 315). The Full Court in *Pham Global v Insight Clinical Imaging* (2017) 251 FCR 379; [2017] FCAFC 83 at [51] said: *“The dominant cognitive cues are the essential features striking the eye in a side by side comparison so as to determine whether marks are substantially identical”*. Although “dominant cognitive cue” has achieved some currency, the expression is devoid of relevant meaning. Cognition is the process or knowing or perception. If a cue includes a reference to a word, in the context of a word mark, it perhaps refers to letters of a word that an English speaker can understand. In short, the expression obfuscates the traditional test.
16. Here, the essential features of the impugned “mark” (assuming trade mark use) are “instant”, “Botox®” and “alternative”. Each word must be borne in mind in

determining deceptive similarity. Doing so, as the primary judge did, leads to the conclusion that there was no deceptive similarity.

“instant Botox® alternative” - comparative advertising defence (s122(1)(d))

- 10 17. The Respondents have submitted that s 122(1)(d) is otiose, because any use it excuses would not constitute trade mark use under s 120(1). That, however, is not correct. In particular it does not address the Appellants’ alternative submission (T2085-2089), which identifies that s 122(1)(d) has work to do in a case such as the present, where the trade mark alleged to be infringed forms part of a comparative phrase, and it is that comparative phrase, rather than the trade mark within it, which is alleged to be the infringing “sign” for the purposes of s 120(1). If use of the phrase *“instant Botox® alternative”* amounted to a “sign” used “as a trade mark” within the meaning of s 120(1) based on an objective determination of its appearance in context, and was deceptively similar to BOTOX, it would be an infringing use of that sign within that provision. However, the use of “Botox” in that phrase would qualify, and thus be defensible, as a use of “the trade mark” (being the registered trade mark alleged to be infringed) “for the purposes of comparative advertising”. The relevant use of the trade mark is the use of “Botox” in the comparative phrase found to be infringing. That gives the section work to do. It accommodates what is otherwise intractable, a section designed to protect comparative advertising but only if the trade mark on its own is used without words of comparison.
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