



## HIGH COURT OF AUSTRALIA

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#### Details of Filing

File Number: S80/2022  
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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**

*“instant Botox® alternative” – Trade mark use*

2. Images of the freeze-frame Inhibox anti-wrinkle cream product with *“instant Botox® alternative”*: FCJ[47] CAB238; RBFM11. 426 Mark covers creams: PJ[19] CAB22.
3. Section 120(1) applies (not 120(3)). The PJ was correct to find no use as a trade mark based on freeze-frame and Inhibox branding, script style, presentation and ordinary meaning of *“instant Botox® alternative”*: AS[18]-[22]; *Shell* at 425 (228); PJ[114], [229]-[246], [255] CAB44, 69, 71. Descriptive words are less apt to appear as “trade marks”: AS[19]. Any ordinary meaning of *“instant Botox® alternative”* may be considered including knowledge of Botox, but only for that limited purpose. PJ correctly found it was comparative advertising or ‘ad-speak’: PJ[233]. It is difficult to envisage how this can be done if not in a way such as this.
4. The FC erred in deploying Botox’s reputation for injectables to conclude that *“instant Botox® alternative”* conveyed an association with Allergan and therefore was used as a trade mark: AS[27]-[31]. Any purported connection with the trade mark owner is irrelevant: AS[18]; PJ[160] CAB54. *A fortiori* it is an error to use the Botox reputation for an impermissible purpose.
- 20 5. The error infected its trade mark use conclusion, compounded by its incorrect use of Protax to support that reasoning: AS[24]-[31] FCJ[57], [63]-[67] CAB240-243; FCJ2[27] CAB276.
6. In doing so, the FC did not address the PJ’s reasons why *“instant Botox® alternative”* was not used as a trade mark but rather his reasons why Botox *simpliciter* was not so used: AS[25] PJ [246]-[254] CAB72-74 FCJ[50]-[63] CAB239-242.
7. What is permissible, is *“the usage of the trade concerned and of any relevant ... trade name or get-up legitimately used by others”*: s 219 TMA PJ[174] CAB57. That included uses by other traders of phrases similar to *“instant Botox® alternative”*: AS[31] PJ[242] CAB 71. Hence, the words *“The original instant .... .. Botox® alternative”* on the Inhibox pack (FCJ[238] CAB238) and similarly in website advertising (RBFM12).
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8. No different conclusion applies to the website advertising at FCJ[48] CAB238 which is only reached via the freeze frame website and clicking on ‘Injection Free Alternatives’ then ‘Inhibox’ (RBFM13).
9. Finally, the FC’s conclusion that the phrase conveyed an association failed to address the PJ’s reasons for rejecting the ACL claim that the phrase as used on the Inhibox pack conveyed an affiliation association, a decision not appealed: AS[15]; PJ[39], [114](1), [454], [455](3)-(5), [461]-[464] CAB26, 44, 118, 119.

*“instant Botox® alternative” – Deceptive similarity*

10. PJ correctly found that *instant Botox® alternative* was not deceptively similar to BOTOX: AS[35] PJ[256], [257] CAB74. PJ adopted the correct approach of comparing a notional use of BOTOX across the relevant class 3 (i.e. including anti-wrinkle creams) with the actual use of the impugned phrase by Self Care: AS[36] PJ[173] CAB57.
11. FC erred in impermissibly deploying Botox’s reputation for injectables to conclude that the phrase implies that the Inhibox cream works faster than the Botox injectable and was hence a product in the Botox range: AS[38] FCJ[74], [75] CAB244.
12. Use of factual reputation to expand the scope of protection contradicts the scheme of s120(1) and authority: AS[42], [46] *Swancom* Full Ct at [69], [70], [77], [80], [89].
13. The result is Allergan’s failure to use the mark on creams effectively expanded its protection: AS[44]. The correct comparison with a putative use by Allergan on creams removes the foundation for the FC’s incorrect conclusion: AS[39]. The FC’s reliance on the PJ’s upholding of the validity of the scope of the 426 mark to include class 3 goods (relating to protection for use of BOTOX *simpliciter*) is also a confounding error: AS[41] PJ[300], [334] CAB83, 90; FCJ[75] CAB244.

*Protox – Deceptive similarity – Image FCJ[17] CAB229*

14. PJ correctly found Protox and Botox were not deceptively similar: AS[47] PJ [211] CAB65. FC’s contrary conclusion was infected by the same error of impermissible reliance on the Botox reputation for injectables: AS[48]-[50] FCJ[41]-[43] CAB236.

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

15. If there was infringing trade mark use, it was a use of BOTOX for the purposes of comparative advertising. Concurrent findings that the phrase conveys a comparison: AS[55] PJ[500]-[504] CB127-128; FCJ[110], [112], [114] CAB254-256.

16. The defence is not limited to the use of BOTOX *simpliciter*: AS[57] FCJ[121] CAB257. The defence can apply where there is infringement: AS[58] FCJ[126], [131], [132] CAB258, 260; *Swancom* at [260] (636); *Bohemia* at [296](330).
17. The PJ's finding that Self Care intended to leverage off the reputation of Botox, not to mislead, but to compete did not preclude the defence, contra FCJ [127], [128]; CAB 259: AS[59] B5p51 E36p802 *Campomar* [4] (103). The PJ finding: AS[14] PJ[71], [73], [75], [208], [468]-[469] CAB33, 34, 64-65, 120. An appeal against those findings was rejected by the FC: FCJ[38], [40] CAB235-236.
- "instant Botox® alternative" – defence under s 122(1)(b)*
- 10 18. The FC erred in rejecting the defence if the phrase was used as a trade mark: AS[61] FCJ[133] CAB261 and that the intention to leverage finding bespoke a lack of good faith: AS[62] FCJ[134] CAB216.
- "instant Botox® alternative" – efficacy misrepresentation*
19. The ACL issue is whether *"instant Botox® alternative"* conveyed a representation that the wrinkle-reducing effects of freeze-frame Inhibox last as long as Botox *"about 4 months"* (a misstatement of PJ[11] *"up to 4 months"*): AS[63] FCJ [109] CAB 254. FC said it did: FCJ[114] CAB 256.
20. PJ was correct to find that the word *"alternative"* did not convey that its effect was as long lasting as that of Botox: AS[64]-[66] PJ[497(3)], [499]-[504] CAB 126-128.
- 20 The different treatment regimes are contraindicative of a temporal representation *a fortiori* against the nebulous *"up to 4 months"*.
21. FC's counterintuitive conclusion that *"alternative"* means effectively *"the same"* was infected by its erroneous finding that *"instant Botox® alternative"* conveyed that Inhibox had the same trade source as Botox, contrary to the unappealed ACL finding of the PJ to the contrary: AS[67] FCJ[108] CAB253. That finding was based on, and confounded by, an unrelated PJ finding as to what Botox® *simpliciter* would convey if used on a cream: AS[67] FCJ[108] CAB253 PJ[334] CAB90. RS[68] seeks to support the FC finding by relying on statements which were not the subject of any claim or were undertaken not to be maintained and were thus not in issue (PJ[114] CAB44) and are not restrained by or referred to in the FC's injunction 2: CAB285.
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Dated: 13 October 2022

A J L Bannon A R Lang

0418 162 834

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