When is a trade mark infringing?

Date : July 24, 2023

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There are many circumstances where the use of a logo, image, word, phrase or other form of mark may be infringing on a registered trade mark. However, it can sometimes be difficult to comprehend or identify when infringement occurs where it is not clear if the alleged infringing mark is actually being used as a trade mark.

Pursuant to s 120 of the *Trade Marks Act 1995* (Cth) ("**the Act**"), a person can only infringe a **registered** trade mark. Therefore, if a person uses a trade mark but has never taken steps to register the trade mark with IP Australia (and obtain registration), they do not receive the protection and exclusive right provided by the Act to make a claim and/or prosecute infringement of their trade mark.

In order to determine whether you may be infringing on a registered trade mark, it is suitable to consider whether a reasonable person would view that your mark is "substantially similar" to the registered trade mark in relation to provision of the same or similar goods or services.

This premise was considered by the High Court of Australia recently in the case of *Self Care IP Holdings Pty Ltd & Anor v Allergan Australia Pty Ltd & Anor [2023] HCA 8 ("Self Care case")*. The question the Court was asked to consider was whether Self Care IP Holdings Pty Ltd and Self Care Corporation Pty Ltd (jointly "**Self Care**") infringed on Allergan Inc's ("**Allergan**") registered trade marks of 'BOTOX'.

Allergan is a pharmaceutical company which manufactures the well-known botulin substance, Botox. Allergan obtained registration of the word 'BOTOX' with IP Australia in 1991 and has maintained that registration ever since.

Self Care is a company which supplies cosmetic products and had been displaying the mark

‘instantBotox®alternative’ on its packaging of its products and also marketed 2 products under the names ‘Inhibox’ and ‘Protox’.

Allergan claimed that Self Care’s marks were infringing Allergan’s registered trade marks, and therefore sued Self Care for trade mark infringement and misleading & deceptive conduct, claiming damages.

The primary decision of the Federal Court of Australia did not consider Self Care’s marks to be infringing on Allergan’s trade marks or misleading to consumers. However, upon Allergan’s appeal to the Full Court of the Federal Court of Australia, the Full Court disagreed with the primary decision and determined that both ‘instantBotox®alternative’ and ‘Protox’ were deceptively similar and infringing as consumers would likely consider these items to be an expansion of Allergan’s product base and would mislead consumers that Self Care’s products would likely have the same result as ‘Botox’.

Self Care then appealed the Full Court’s decision to the High Court of Australia.

The High Court unanimously ruled that Self Care did not infringe on Allergan’s registered trade marks as:

a. Self Care did not use ‘instantBotox®alternative’ as a trade mark for the purposes of s 7 and 17 of the Act; and
b. the marks ‘Protox’ and ‘Botox’ were sufficiently different that a consumer would not be misled to consider them to have come from the same entity; and
c. Self Care did not mislead or deceive consumers as a reasonable person would not have understood the effect of the representation of ‘instantBotox®alternative’

However, the High Court went further and held that, when considering whether infringement of a trade mark has occurred for the purposes of s 120 of the Act, the reputation of the trade mark and its owner are not relevant.

What this case tells us is that trade mark infringement is not a simple area of law or easy to identify at times. It requires a great deal of scrutiny and legal advice, regardless of whether a mark is being used as a brand, on a product, on a website or in every day documentation.

If you are unsure if someone may be infringing on your registered trade marks, please feel free to contact our office to obtain some further information and advice.

We recommend that any person seeking to begin a new business (such as registering a business name or incorporate a company) conduct due diligence, including searches of the trade marks database as well as marks being used within the public domain, to ensure that they may not be now or in the future infringing on another person’s rights. Not conducting such due diligence can be an extremely costly consequence, even many years into the future.

If you would like more information or advice in relation to intellectual property law, contact Hayley Hitch at hayleyh@matthewsfolbigg.com.au or the Principal of the Matthews Folbigg

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