

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2068848
BY G.T.R. GROUP S.p.A.
TO REGISTER THE MARK "JOIS & JO" IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO
BY JEAN PATOU

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2068848
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5

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by Jean Patou.

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DECISION

BACKGROUND

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On 15th April 1996, G.T.R.Group S.p.A. of Via Latina, 130, Isernia, Italy, applied under the Trade Marks Act 1994 for registration of the trade mark **JOIS & JO** (in a slightly stylised form as shown below) in respect of:

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Class 3

“Soaps; cleaning and polishing preparations, all for cosmetic and / or toiletry purposes; perfumery, essential oils, cosmetics, hair lotions; dentifrices.”

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Class 9

“Glasses, sunglasses; frames and cases for all the aforesaid goods.”

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Class 18

“Leather and imitation of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.”

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Class 25

“Clothing, footwear, headgear.”

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On the 28th January 1997 Jean Patou filed notice of opposition to the application. The grounds of opposition are in summary:

i) Jean Patou, the opponents, are the proprietors of the mark JOY, registered in

class 3 for:

perfumes and non-medicated face powder (714290), perfumes, toilet water, face powder and talcum powder (885815), and perfumes, perfumery, non-medicated toiletries, cosmetics, soap, anti-perspirants and deodorants for personal use (2047390).

ii) The opponents claim that the word JOY is phonetically and visually very similar to the mark applied for, JOIS & JO, and is likely to cause confusion and lead to association with the opponents' earlier trade marks and would therefore be contrary to the provisions of Section 5(2)(b) of the Act.

iii) The opponents' mark JOY has been used extensively in the UK and has acquired a reputation by virtue of such use; to the extent that use of the mark JOIS & JO would take unfair advantage of and be detrimental to the distinctive character and reputation of the opponents' trade mark and would therefore offend Section 5(3) and 5(4) of the Act.

The opponents further request that the Registrar refuse application No 2068848 in the exercise of his discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as he did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicants subsequently filed a counterstatement denying all of the grounds of opposition, other than agreeing that the opponents are the registered proprietors of the trade marks as claimed. Both sides ask for an award of costs. Neither party wished to be heard in the matter. My decision will therefore be based on the pleadings and the evidence filed.

OPPONENTS' EVIDENCE

This takes the form of a statutory declaration by Jean de Mouy dated 20 August 1997. Mr de Mouy is the President of Jean Patou - a French Company - the opponents in these proceedings. His company has been selling perfume under the trade mark JOY in the United Kingdom since 1950. He provides approximate retail sales figures for the years 1987 to 1995, although it is not clear if this relates solely to the sale of "JOY" products or whether it relates to the whole range of products sold.

YEAR	£
1987	612,880
1988	627,920
1989	616,640
1990	676,800
1991	501,960

1992	475,640
1993	545,960
1994	530,160
1995	428,640
1996	404,200

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Mr de Mouy states that an average of £50,000 is spent annually on advertising in the United Kingdom in the national press and in magazines such as *Vogue*, *Harper*, *Elle*, *Marie Claire*, *Cosmopolitan*, *Hello*, *Tatler* and *Country Life*, again this could relate to the promotion of all the products of the company.

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At "JdM1" he exhibits a selection of advertisements featuring the mark, and at "JdM2" some packaging showing use of the mark in relation to perfume and eau de toilette. Also provided are examples of packaging for perfumed soap and perfumed body cream which have the mark "JOY de BAIN" with each of the words shown on a separate line underneath each other. Point-of-sales advertising material is also produced at exhibit "JdM3". Again some of this relates to the use of the mark "JOY", but also includes examples for other Jean Patou brands such as "1000", "Sublime", "Eau de Patou", "Huile de Chaldee", "The MA collection", "Patou pour Homme", & "Voyageur". Only that relating to the mark "JOY" has been taken into consideration.

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Mr de Mouy states that the trade mark "JOY", as applied to perfumery, is a very well known mark. He goes onto claim that the word "JOY" is phonetically and visually similar to the first word "JOIS" of the mark applied for, and that if "JOIS & JO" were to be applied to perfumery or cosmetic products then confusion would seem inevitable. He makes the point that the goods covered in the application are identical or similar to those for which his company already has a registration.

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No instances of confusion have been identified. Mr de Mouy claims that the applicants have, thus far, only sold clothing under the mark in dispute. Oppositions to the applicants' mark have been filed in a number of countries. Mr de Mouy lists these as Argentina, Canada, Chile, Portugal, Spain, Switzerland, Thailand and Uruguay, although he does point out that decisions have not been issued in any of these countries.

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Finally, Mr de Mouy produces at exhibit "JdM4" copies of a trademark search which shows his registrations (referred to earlier). This exhibit also shows registrations under the name of "JOY" for perfumed soap registered to Procter and Gamble Ltd, and "BATHJOY" for non-medicated bath salts registered to Bathjoys Ltd. Both pre-date the opponents' registrations.

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APPLICANTS' EVIDENCE

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This consists of a statutory declaration by Eugenio Vinci dated 27 January 1998. Mr Vinci is the Managing Director of the G.T.R. Group S.p.A.

Mr Vinci states that he is unaware of the mark "JOY" being used on anything other than perfumes

and eau de toilette whereas his application covers items such as face powder, talcum powder, cosmetics etc. This he claims is substantiated by the opponents' evidence where the only instances of use of the mark "JOY" shown are for perfumes and eau de toilette. However, he is willing to concede that "JOY" is a well known trade mark for perfumery.

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Mr Vinci does not agree that his mark "JOIS & JO" would be confused for the opponents' mark "JOY". He points out that the opponents' mark is a single syllable word which has a definite meaning in the English language and in some of the evidence filed by the opponents there are references to the use of the word in editorials such as "What a joy" and "Legendary and timeless, JOY symbolizes humor, sophistication and the joy of living".

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He points out that, in contrast, his mark is made up of two fanciful words, connected by an ampersand, neither of which have a dictionary meaning. He says that the first word of the applicants' mark contains two syllables. He therefore contends that the visual, phonetic and conceptual differences between the two marks are such that in practice there is no likelihood of confusion. He accepts that his company has not so far marketed perfumery under the "JOIS & JO" mark and there has been no opportunity to test the likelihood of confusion between directly competing products in practice.

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Mr Vinci also points out that the Portuguese Registry rejected an opposition based on the same grounds earlier this year. He states that his company has registered the mark "JOIS & JO" in Italy, Denmark, Finland, Iceland, Japan, Malta, Mexico and Sweden. A copy of the International Trade Mark registration No 658405 is produced at exhibit "EV/1". Examples of proposed packaging for the products is provided at "EV/2".

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Finally Mr Vinci also makes the point that there are other examples of the mark "JOY" on the register for class three goods such as the one registered to Procter and Gamble for soap. Mr Vinci notes that Procter and Gamble have not opposed his registration for soap in class three.

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No evidence in reply was filed.

That concludes my review of the evidence. I now turn to the decision.

DECISION

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Firstly I consider the grounds of opposition under Section 5 (2) (b) which states:

*"5.(2) A trade mark shall not be registered if because -
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier mark is protected,*

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there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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The applicants have not denied that the goods at issue are identical, and given that both specifications include soaps, perfumery and cosmetics I am satisfied that the application covers goods which are identical with or similar to those for which the opponents' mark is already

registered.

Consequently, I do not need to apply the test for similar goods which was laid down by Jacob.J. in the British Sugar plc v James Robertson & Sons [“TREAT” 1996 RPC 281] . I need only
5 decide whether the marks are so similar that there exists a likelihood of confusion on the part of the public.

In deciding whether the two marks are similar I rely on the decision of the Court of Justice of the European Communities in the Sabel v Puma case C251/ 95 - ETMR [1998] 1-84. In that case
10 the court stated that:

“Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

It is Mr de Mouy’s contention that the first word in the mark applied for, “JOIS & JO”, is visually and phonetically similar to the registered mark “JOY”. Mr de Mouy has not explained how he is pronouncing the word “JOIS”. There are a number of possibilities but it would be my view that the pronunciation “joys” would be the most likely to cause confusion with the applicants’ mark. However it is clear that I should not divide up the mark in order to compare the first word of the applicants’ mark with the opponents’ mark. I must consider each of the marks in their entirety.

Even assuming that JOIS would be pronounced JOYS by a significant proportion of the public, the closest the marks could be said to be phonetically is JOY - v - JOYS & JO. The first mark consists of a single syllable, the second mark consists of three words each of one syllable. There is no evidence that the public would pronounce JOIS as JOYS. In my view it is equally (if not

more) likely to be pronounced Jo-iss or Joyce. Therefore I do not find the marks phonetically similar enough to give rise to a likelihood of aural confusion.

5 Considering the marks visually, JOY is a single word of three letters, whereas JOIS & JO consists of two words and an ampersand, which are considerably longer in terms of letters (seven) than the first mark. I do not find the marks visually similar at all.

10 It is clear from the Sabel v Puma case, that a mark with a strong reputation deserves more protection than one with limited reputation. It is accepted by the applicants that the opponents' mark enjoys considerable reputation in the market place. However, there are clear conceptual differences between the marks, JOY has a clear meaning of "happiness". The words JOIS & JO do not have any dictionary meaning, but in combination they appear to be the names of two individuals. . Even allowing for imperfect recollection and less than perfect pronunciation, the differences, phonetically, visually and conceptually are sufficient to ensure that there is no
15 likelihood of confusion.

Next I turn to the opposition under Section 5(3) which states:

20 *"(3) A trade mark which -
(a) is identical with or similar to an earlier trade mark, and
(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

25 *shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".*

30 No evidence has been filed in support of this ground of opposition. I have already found that the marks are not similar. Therefore the opposition under this Section fails.

Finally I turn to the opposition under Section 5(4) which reads:

35 *"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -*

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

40 *(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

45 *A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."*

In deciding whether the mark in question "JOIS & JO" offends against this section, I intend to

adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

5 *“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.*

10 *A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:*

15 *‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:*

20 *(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*

25 *(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and*

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

30 With these considerations in mind I turn to assess the evidence filed on behalf of the opponents in the present proceedings as set out earlier in this decision.

 It is clear from the statutory declaration of Mr de Mouy and the attached exhibits that the opponents have a considerable reputation in perfumery, and this is acknowledged by the applicants.

35 The applicants and the opponents are clearly operating in the same field of business, namely the perfumery business, in all its connotations.

40 The similarity of the marks has been dealt with earlier in this decision, when considering the opposition under Section 5(2)(b). It is my opinion that the marks are not similar enough to give rise to any likelihood of confusion.

45 The opponents have shown in their evidence that their perfume is highly specialised. All of the point of sales material and the advertising provided seek to emphasise the exclusiveness of their perfume, and there are references to it as “the most expensive perfume in the world”. I note that in only one instance the price of the opponents’ goods in December 1992 is shown as being £621 per 30ml (approx 1 fluid ounce). The applicants have not shown any prices for their

product, but I think that it is evident that an individual contemplating purchasing such an expensive perfume would give some thought to their purchase and this would considerably lessen the chances of confusion.

5 Although it is clear that the opponents have a considerable reputation and that the products are clearly in the same field of activity, the opponents have failed to show that use of the applicants' mark would cause confusion or deception. The manner in which the trade is carried out and the class of person involved also mitigate against the likelihood of confusion. The opposition under this section therefore fails.

10 The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £435.

15 **Dated this 27th day of October 1998**

George W Salthouse
For the Registrar
20 **The Comptroller General**