

O/0503/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003704694
IN THE NAME OF PROFUMI DI PANTELLERIA S.R.L.
FOR THE TRADE MARK**

PROFUMI DI PANTELLERIA JOYANN

IN CLASS 3

AND

**THE OPPOSITION THERETO UNDER NO. 433537
BY JEAN PATOU**

Background and pleadings

1. On 27 June 2019, PROFUMI DI PANTELLERIA S.R.L. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the European Union. The applicant subsequently applied for the same mark in the UK on 30 September 2021. In accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union, by filing an application for the EU mark in the UK within nine months of the end of the transition period, the applicant is entitled to rely on the priority date of the EU mark in UK proceedings. Therefore, the date of the application in these proceedings is considered to be 27 June 2019.

2. The application was published for opposition purposes on 25 February 2022 and registration is sought for the following goods:

Class 3: *Bleaching preparations and other substances for laundry use; Scouring substances; Polishing preparations; Abrasives; Cleaning preparations; Soap; Ethereal oils; Cosmetics; Hair care lotions; Dentifrices; Colour cosmetics for the eyes; Beauty care cosmetics; Cosmetics for animals; Eyes make-up; Cosmetic preparations for eyelashes; Lip cosmetics; Eyebrow cosmetics; Cosmetics for protecting the skin from sunburn; Cosmetics for use on the skin; Cosmetics in the form of oils; Cosmetics in the form of milks; Cosmetics in the form of gels; Cosmetics in the form of powders; Cosmetics in the form of lotions; Cosmetics in the form of eye shadow; Cosmetics in the form of rouge; Cosmetics in the form of creams; Cosmetic kits; Cotton wool for cosmetic purposes; Lotions for cosmetic purposes; Glitter in spray form for use as a cosmetics; Make-up; Beauty masks; Cosmetic pencils; Colouring preparations for cosmetic purposes; Sun blocking preparations [cosmetics]; Decorative cosmetics; Cosmetic hair dressing preparations; Facial preparations; Cosmetic products for the shower; Moist wipes for sanitary and cosmetic purposes; Cosmetic body scrubs; Serums for cosmetic purposes; Temporary tattoos for cosmetic purposes; Cosmetic dyes; Toners for cosmetic use; Artificial nails for cosmetic purposes; Perfumed toilet waters; Perfumed powder [for cosmetic use]; Deodorants for human beings or for animals; Extracts of perfumes; Scented wood; Essential oils as perfume for laundry*

purposes; Essential oils for use in the manufacture of scented products; Natural oils for perfumes; Scented oils; Potpourris [fragrances]; Perfumery; Air fragrancing preparations; Sachets for perfuming linen; Natural perfumery; Synthetic perfumery; Perfumes; Perfumes for cardboard; Perfumes for ceramics; Perfumes for industrial purposes; Liquid perfumes; Solid perfumes; Scented sachets; Scented bathing salts; Perfumed tissues; Scented soaps; Body deodorants [perfumery]; Scented water; Aromatics for perfumes; Bases for flower perfumes; Perfumed creams.

3. On 17 May 2022, JEAN PATOU (“the opponent”) opposed the application under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).¹

4. Under Section 5(2)(b), the opponent relies on the trade marks set out below:

(i) UK00000714290 (the 290 mark)

JOY

Filing date: 26 January 1953; registration date: 26 January 1953

The opponent relies on *Perfumes* in class 3.

(ii) UK00917895714 (the 714 mark)



Filing date: 04 May 2018; Registration date: 19 March 2019

¹ In its counterstatement the applicant criticised paragraph 5 of the opponent’s statement of ground in which the opponent stated: “*The Opponent has filed the opposition against some of the services applied for in the Application, as listed above*”. I assume that paragraph 5 contains an error. In any event when the opponent filed the Form TM7 in answer to the question “*Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?*” it ticked the box “*all goods and services*”. Further, the opponent subsequently confirmed in its written submissions that the opposition is directed against all of the goods applied for.

The opponent relies on the following goods and services:

Class 3: *Perfume; Eau de parfum; Toilet water; Cologne; Cosmetic creams; Body gels; Oils for cosmetic purposes; Beauty milk; Beauty lotions; Personal deodorants; Cosmetic masks; Cosmetics; Hair lotion; Make-up preparations; Cleansing milks and Make-up removing lotions; Shaving soap; Aftershave lotions and balms.*

Class 35: *Retailing of perfumery, cosmetics, beauty products and hair products; Online retailing of perfumery, cosmetics, beauty products and hair products; Direct mail advertising; Direct mail advertising; Product demonstrations and product display services; Sample distribution; Sales promotion.*

5. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to Section 6 of the Act. Only the 290 mark completed its registration process more than five years before the priority date of the mark in issue, and it is subject to proof of use pursuant to Section 6A of the Act.

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the applicant's mark is similar to its own marks, and the respective goods and services are identical or similar.

7. Under Section 5(3), the opponent relies on the 290 mark and claims a reputation in relation to *perfumes*, stating that use of the applicant's mark would, without due cause, take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

8. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

9. Only the opponent filed evidence during the evidence rounds. It also filed written submissions dated 12 October 2022. I shall refer to the evidence and submissions to the extent that I consider necessary.

10. The opponent is represented by Williams Powell and the applicant by Murgitroyd & Company. Neither party asked to be heard nor did they file submissions in lieu. This decision is taken following a careful perusal of the papers.

EU Law

11. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

12. The opponent's evidence consists of two witness statements, one by Nicola Harrison and the other by Lionel Darolles. Ms Harrison is a trade mark attorney employed by Williams Powell, the firm representing the opponent in these proceedings. Her witness statement is dated 11 October 2022 and is accompanied by three exhibits (NH01- NH03). Mr Darolles is a legal manager at the opponent's company. His witness statement is dated 10 October 2022 and is accompanied by 20 exhibits (LD01-LD20).

DECISION

Proof of use

13. Section 6A states as follows:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

14. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the priority date of the application in issue, namely 28 June 2014 to 27 June 2019.

17. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic*

sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.

Proof of use assessment

18. The opponent’s evidence is as follows:

- The opponent is a French company. It bought the rights in the ‘JOY’ trade marks globally, including the UK, from Jean Patou Worldwide Limited in 2017. The acquisition included the goodwill and reputation, as well as the registered trade mark rights;
- The mark ‘JOY’ was first used in relation to a perfume produced by Jean Patou (who at the time was a famous Parisian fashion designer) in 1930. Mr Darolles, the opponent’s witness, states that ‘JOY’ quickly became an iconic, luxury fragrance brand, gaining worldwide acclaim and establishing a significant market share within the fragrance sector. Additional fragrances were released under the overarching ‘JOY’ brand (such as ‘ENJOY’, ‘JOY FOREVER’, and ‘EAU DE JOY’), but always containing the ‘JOY’ name highlighted in some form, as shown below:



- Mr Darolles states that the perfume ‘JOY’ enjoyed incredibly high sales when it was launched and over time it became the second best-selling perfume of all time. However, I note, that no historical figures are provided. Mr Darolles also states that the perfume ‘JOY’ has been associated with many high-profile figures throughout its history, including Jackie Kennedy, and Vivien Leigh;

- The perfume 'JOY' is mentioned in authoritative books dealing with the subject of perfumes; extracts from books are provided which describes 'JOY' as *"one of the five greatest perfumes in the world"*, *"the costliest perfume in the world"*, *"iconic and iconoclastic"*, *"one of the greatest floral perfumes ever created"*, *"great and classic jasmine fragrances of the twentieth century"* and *"timeless"*;
- Mr Darolles states that 'JOY' was awarded the acclaim of "Scent of the Century" at the UK FIFI awards in 2000, *"beating its longstanding rival Chanel No. 5 (widely regarded as the most famous perfume of all time)"*;
- EU sales figures for the years 2013-2018 are as follows:

	2013	2014	2015	2016	2017	2018
JOY	387,581	425,831	319,029	268,788	185,231	143,272
JOY FOREV ER	206,559	106,799	60,397	41,653	60,292	16,979
TOTAL	594,140	532,630	379,426	310,441	245,523	160,251

These figures are shown in euros and represent the wholesale value. Mr Darolles states that the retail value would be significantly higher with a typical retail sale being approximately four times the wholesale value. He estimates that the UK sales during this time would account for approximately 20% of these sales - this would amount to approximately 450,000 euros over a period of five years;

- The UK sales figures (wholesale) for 'JOY' and 'JOY FOREVER' in the period 2015 to 2018 were as follows (figures shown in GBP):

	2015-2016	2016-2017	2017-2018
Joy	£47,296.01	£46,468.74	£49,011.67
Joy Forever	£7,869.30	£10,136.28	£10,254.16
Total	£55,165.31	£56,605.02	£59,265.83

- Christian Dior became a licensee of the trade mark 'JOY' in 2018 and it launched the perfume 'JOY by Dior' in the same year. The launch was accompanied by an advertising campaign featuring the Hollywood actress, Jennifer Lawrence, as evidenced by an article dated 30 August 2018 in Vogue. Mr Darolles describes this as a collaboration with a high-profile, luxury brand continuing the luxurious image of the perfume 'JOY'. The 'JOY by Dior' perfume received press attention and industry accolades including (a) an article from UK newspaper The Times, recommending 'JOY' by Dior as a must-have Christmas gift in 2019; (b) nomination as a finalist in several categories of awards in 2019 including 'Reader's Choice for Women' (as voted for by readers of the Evening Standard), 'People's Choice Women' (as voted for by users of the retail website boots.com), 'Best new fragrance women', and 'Ultimate Launch'. 'JOY' by Dior perfume was also awarded first place in the 'Best New Women's Fragrance' Category in the Style Beauty Awards 2020 compiled by The Sunday Times newspaper in the UK;
- 'JOY' perfumes are sold at a variety of select luxury and prominent retailers, for example Harrods in the UK. At the time of its inception, 'JOY' perfume was renowned for being the most expensive fragrance in the world. 'JOY by Dior' eau de parfum has a current retail price of £118 for 90ml placing it in the prestige category of perfumes;
- Between 2013 and 2014 Jean Patou Worldwide Limited entered into limited license agreements with P&G for them to use, *inter alia*, the mark 'JOY' within a 'JOY OF PINK' mark. P&G made sales of 'LACOSTE JOY OF PINK' in the UK to the value of USD 173,000 in the financial year 1 July 2013 - 30 June 2014 and USD 387,000 in the financial year 1 July 2014 - 30 June 2015.

19. The UK wholesale figures are not particularly high, being in the region of £55,000/£60,000 per year, totalling £171,036.16 in the period between 2015 and 2018 and euros 450,000 in the period between 2013 and 2018. Even considering that the turnover generated by the retail price would be around four times higher than that generated from the sale of goods to wholesalers, the figures given in evidence are not particularly impressive, taking into account the price of the goods and the size of the UK market for the goods concerned - which I would expect to be very large. If one considers that the retail price of a bottle of 'JOY' perfume is £118, and that between 2015 and 2018 the opponent sold about £240,000 worth of goods in one year (at retail price),² on a rough calculation the opponent would have sold just over 2,000 bottles of perfume a year, which is a relatively small figure in the context of the relevant market. The number of bottles sold in the period 2013-2014 would have been higher (around 4,000) but still not remarkably high.

20. There was a collaboration with the famous Dior brand in 2018 and the evidence indicates that the 'JOY by DIOR' perfume was nominated for a number of UK awards and received some press coverage in the UK within the relevant period. There were some further sales as a result of a collaboration with another famous brand, namely 'LACOSTE', however, this was use of the trade mark 'LACOSTE JOY OF PINK', in which the trade mark 'JOY' would have lost its independent distinctive character, being presented as part of the phrase 'JOY OF PINK' preceded by the house mark 'LACOSTE'. I therefore consider that this use alters the distinctive character of the trade mark 'JOY' *solus*, and does not count towards genuine use. There is also evidence of very long-standing and continuous use of the mark 'JOY' for nearly a century and evidence of UK press coverage and awards, although there is no indication of marketing spend or market share. Overall, I am satisfied that the opponent (or its predecessor in title) has made genuine use of the '290 mark in relation to perfumes during the relevant period.

Section 5(2)(b)

21. Section 5(2)(b) of the Act is as follows:

² I calculated this by multiplying the highest annual wholesale value of £60,000 x 4

“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 trade mark is protected,

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

22. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

23. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

24. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

25. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

26. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court (GC) clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

27. The GC confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

28. The goods and services to be compared are as follows:

The applicant’s goods	The opponent’s goods and services
<p>Class 3: <i>Bleaching preparations and other substances for laundry use; Scouring substances; Polishing preparations; Abrasives; Cleaning preparations; Soap; Ethereal oils; Cosmetics; Hair care lotions; Dentifrices; Colour cosmetics for the eyes; Beauty care cosmetics; Cosmetics for animals;</i></p>	<p>The 290 mark Class 3: <i>Perfumes</i></p> <p>The 714 mark Class 3: <i>Perfume; Eau de parfum; Toilet water; Cologne; Cosmetic creams; Body gels; Oils for cosmetic purposes; Beauty milk; Beauty lotions; Personal</i></p>

<p><i>Eyes make-up; Cosmetic preparations for eyelashes; Lip cosmetics; Eyebrow cosmetics; Cosmetics for protecting the skin from sunburn; Cosmetics for use on the skin; Cosmetics in the form of oils; Cosmetics in the form of milks; Cosmetics in the form of gels; Cosmetics in the form of powders; Cosmetics in the form of lotions; Cosmetics in the form of eye shadow; Cosmetics in the form of rouge; Cosmetics in the form of creams; Cosmetic kits; Cotton wool for cosmetic purposes; Lotions for cosmetic purposes; Glitter in spray form for use as a cosmetics; Make-up; Beauty masks; Cosmetic pencils; Colouring preparations for cosmetic purposes; Sun blocking preparations [cosmetics]; Decorative cosmetics; Cosmetic hair dressing preparations; Facial preparations; Cosmetic products for the shower; Moist wipes for sanitary and cosmetic purposes; Cosmetic body scrubs; Serums for cosmetic purposes; Temporary tattoos for cosmetic purposes; Cosmetic dyes; Toners for cosmetic use; Artificial nails for cosmetic purposes; Perfumed toilet waters; Perfumed powder [for cosmetic use]; Deodorants for human beings or for animals; Extracts of perfumes; Scented wood; Essential oils as perfume for laundry purposes; Essential oils for use</i></p>	<p><i>deodorants; Cosmetic masks; Cosmetics; Hair lotion; Make-up preparations; Cleansing milks and Make-up removing lotions; Shaving soap; Aftershave lotions and balms.</i></p> <p>Class 35: <i>Retailing of perfumery, cosmetics, beauty products and hair products; Online retailing of perfumery, cosmetics, beauty products and hair products; Direct mail advertising; Direct mail advertising; Product demonstrations and product display services; Sample distribution; Sales promotion.</i></p>
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<p><i>in the manufacture of scented products; Natural oils for perfumes; Scented oils; Potpourris [fragrances]; Perfumery; Air fragrancing preparations; Sachets for perfuming linen; Natural perfumery; Synthetic perfumery; Perfumes; Perfumes for cardboard; Perfumes for ceramics; Perfumes for industrial purposes; Liquid perfumes; Solid perfumes; Scented sachets; Scented bathing salts; Perfumed tissues; Scented soaps; Body deodorants [perfumery]; Scented water; Aromatics for perfumes; Bases for flower perfumes; Perfumed creams.</i></p>	
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Comparison with the goods of the 714 mark

29. A number of goods in the contested specification fall within the opponent's broad term *cosmetics* which is defined as "*any preparation applied to the body, especially the face, with the intention of beautifying it*". The opponent's specification also includes *perfumes* and *hair lotions* which would encompass other goods in the applicant's specification. Hence the following goods in the applicant's specification are either self-evidently identical to the opponent's goods, or fall within the opponent's goods and so are identical on the principle outlined in *Meric*:

Cosmetics; Hair care lotions; Colour cosmetics for the eyes; Beauty care cosmetics; Cosmetics for animals; Eyes make-up; Cosmetic preparations for eyelashes; Lip cosmetics; Eyebrow cosmetics; Cosmetics for protecting the skin from sunburn; Cosmetics for use on the skin; Cosmetics in the form of oils; Cosmetics in the form of milks; Cosmetics in the form of gels; Cosmetics in the form of powders; Cosmetics in the form of lotions; Cosmetics in the form of eye shadow; Cosmetics in the form of rouge; Cosmetics in the form of creams; Cosmetic kits; Lotions for cosmetic purposes; Glitter in spray form for use as a

cosmetics; Make-up; Beauty masks; Cosmetic pencils; Colouring preparations for cosmetic purposes; Sun blocking preparations [cosmetics]; Decorative cosmetics; Cosmetic hair dressing preparations; Facial preparations; Cosmetic products for the shower; Cosmetic body scrubs; Serums for cosmetic purposes; Cosmetic dyes; Toners for cosmetic use; Perfumed toilet waters; Perfumed powder [for cosmetic use]; Deodorants for human beings or for animals; Extracts of perfumes; Perfumery; Natural perfumery; Synthetic perfumery; Perfumes; Liquid perfumes; Solid perfumes; Perfumed tissues; Scented soaps; Body deodorants [perfumery]; Scented water; Perfumed creams; Scented oils.

30. In addition, the following goods in the applicant's specification have (or might have) cosmetics purposes and so are similar to at least a medium degree to the opponent's goods, because although they have a different nature, they have the same purpose, i.e. beautification/personal care, are sold through the same trade channels, and are complementary:

Dentifrices; Soap; Cotton wool for cosmetic purposes; Moist wipes for sanitary and cosmetic purposes; Temporary tattoos for cosmetic purposes; Artificial nails for cosmetic purposes; Scented bathing salts.

31. This leaves a range of cleaning and home fragrances products, namely *Bleaching preparations and other substances for laundry use; Scouring substances; Polishing preparations; Abrasives; Cleaning preparations; Ethereal oils; Scented wood; Essential oils as perfume for laundry purposes; Potpourris [fragrances]; Air fragrancing preparations; Sachets for perfuming linen; Perfumes for cardboard; Perfumes for ceramics; Scented sachets;* as well as products used in the manufacturing of perfumes, namely *Essential oils for use in the manufacture of scented products; Natural oils for perfumes; Perfumes for industrial purposes; Aromatics for perfumes; Bases for flower perfumes.*

32. Ms Harrison filed evidence to show that home and cleaning products are increasingly influenced by perfume and cosmetic scents, and vice versa and states that scents have been inspired by cleaning products and that it is therefore not

inconceivable that a company who manufactures and sells cleaning products would move into producing scents and perfumes, and vice versa. The evidence consists of:

- screen prints from <https://avamayaromas.com/scents/> taken on 11 October 2022. It shows that their scent range, which is used for everything from home fragrance, candles and wax melts to bath and body products has been inspired by well-known fragrances by companies such as Dior, YSL, Jo Malone, Thierry Mugler etc, in addition to cleaning products such as Fairy, Lenor, Zoflora and Method;
- an Ideal Home article dated 6 November 2020 which explains how scents inspired by cleaning products have become increasingly popular;
- an article from the Manchester Evening News dated 16 March 2022 reporting on a popular cleaning product that has been determined to smell *“just like Marc Jacobs’ perfume”*.

33. Aside from the fact that this evidence is after the relevant date, and as such has limited weight, it only shows that manufacturers of cleaning products and home fragrances are copying well-known perfumes. It does not show that, for example, manufacturers of perfumes for personal use produce similarly scented home fragrances or vice versa. Hence, this is not evidence of convergence in the market that might justify a finding of complementarity. The goods have different uses and purposes (perfumes being used to give a pleasant smell to one's body and cleaning products and home fragrances being used to clean and give a pleasant smell to houses, respectively), are neither complementary or in competition, and even though they may be sold through the same trade channels, they are unlikely to be found in close proximity to each other. Hence, I find that the following goods in the applicant's specification are dissimilar:

Bleaching preparations and other substances for laundry use; Scouring substances; Polishing preparations; Abrasives; Cleaning preparations; Ethereal oils; Scented wood; Essential oils as perfume for laundry purposes;

Potpourris [fragrances]; Air fragrancing preparations; Sachets for perfuming linen; Perfumes for cardboard; Perfumes for ceramics; Scented sachets.

34. Moving to the goods used in the production of perfumes and scented products, namely *Essential oils for use in the manufacture of scented products; Natural oils for perfumes; Perfumes for industrial purposes; Aromatics for perfumes; Bases for flower perfumes*, these goods target manufacturers and as such have different users, purpose, trade channels and are neither complementary nor in competition. These goods are dissimilar.

Comparison with the goods of the 290 mark

35. The 290 mark only covers *perfumes*. For similar reasons to those which I set out above, I find that the following goods in the applicant's specification are dissimilar to the opponent's perfumes:

Bleaching preparations and other substances for laundry use; Scouring substances; Polishing preparations; Abrasives; Cleaning preparations; Ethereal oils; Scented wood; Essential oils as perfume for laundry purposes; Potpourris [fragrances]; Air fragrancing preparations; Sachets for perfuming linen; Perfumes for cardboard; Perfumes for ceramics; Scented sachets; Essential oils for use in the manufacture of scented products; Natural oils for perfumes; Perfumes for industrial purposes; Aromatics for perfumes; Bases for flower perfumes.

36. As regards the remaining goods, I find that the following goods are identical or highly similar to the opponent's perfumes:

Perfumed toilet waters; Perfumed powder [for cosmetic use]; Deodorants for human beings or for animals; Extracts of perfumes; Perfumery; Natural perfumery; Synthetic perfumery; Perfumes; Liquid perfumes; Solid perfumes; Perfumed tissues; Scented soaps; Body deodorants [perfumery]; Scented water; Perfumed creams; Scented oils.

37. Further, I find that the cosmetic and personal care goods listed at paragraphs 29 and 30 above are similar to a medium degree to the opponent's *perfumes*, as they have a similar purpose, i.e. beautification, can be scented with the opponent's perfumes, share trade channels and are normally produced by the same undertakings.

Average consumer

38. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39. The average consumer of the parties' goods is a member of the general public. The cost of the goods in question is likely to vary, and the majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, smell and suitability of the product for their specific needs. Therefore, the level of attention paid during the purchasing process will be medium.

40. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, or online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural

component to the purchase through advice from a sales assistant or representative.

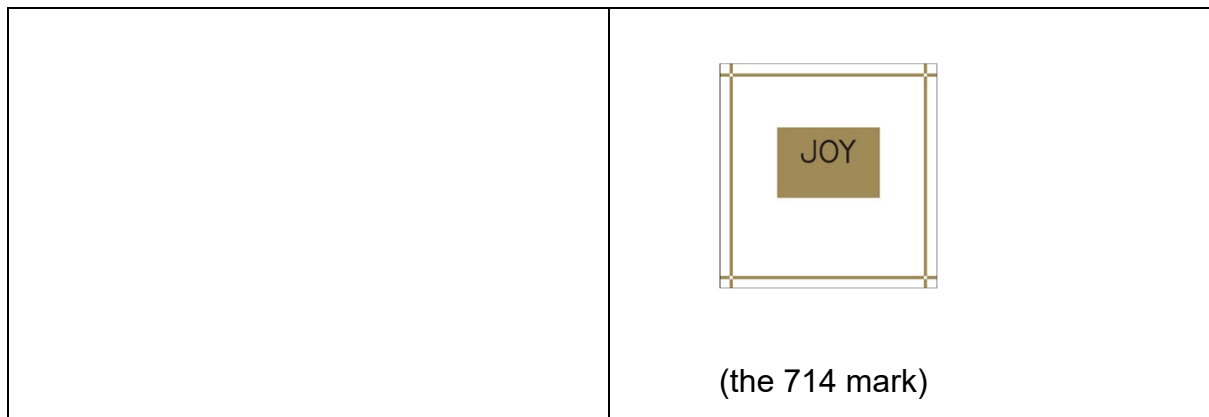
Comparison of marks

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The applicant's mark	The opponent's marks
PROFUMI DI PANTELLERIA JOYANN	JOY (the 290 mark)



43. The opponent's 290 mark consists of the word 'JOY' presented in capital letters. There are no other elements to contribute to the overall impression, which lies in the word itself.

44. The opponent's 714 mark consists of the word 'JOY' presented in black capital letters. The word 'JOY' appears within a golden rectangular background, which is enclosed within a golden rectangular frame. In my view, it is the words 'JOY' which plays the greater role in the overall impression of the mark, with the presentational/device elements playing a lesser role.

45. The applicant's mark consists of the words 'PROFUMI DI PANTELLERIA JOYANN' presented in capital letters. In my opinion, the overall impression rests in the words in equal measure.

46. The opponent's states:

"The additional element "PROFUMI" is easily translatable into English to "perfume", which is the exact goods for which the Opponent's Mark has a reputation, and the goods covered by the Opponent's Marks. The other element that would be recognised by an English-speaking consumer is JOYANN. This part of the mark wholly contains the Opponent's Mark –namely the word JOY, presented alongside the additional letters "ANN" intended to identify the Applicant as the source of the goods for which protection is sought. Conceptually the Application is similar to a high degree, due to the distinctive part of the mark being "JOY", and referring to perfume within the mark. The

Opponent's Mark will easily be seen by the relevant public as an extension of the Opponent's Mark".

47. It is not clear to me what the opponent means when it says that the additional letters "ANN" are intended to identify the applicant as the source of the goods for which protection is sought. First, the opponent's argument clearly ignores the principle that a mark must be considered as a whole and, it seems to me, artificially dissects the marks in a way which is not in accordance with the guidance provided by the case-law. Second, the opponent completely ignores the element 'DI PANTELLERIA', the fact that the letters J, O, Y are subsumed with the word 'JOYANN' and the fact that the length of marks influences the effect of the differences between them. I therefore reject the opponent's arguments.

48. Visually and aurally, the marks coincide to the extent that the last word of the applied-for mark, 'JOYANN' begins with the sequence 'JOY' which form the only verbal element of the opponent's marks. However, the word 'JOY' in the applicant's mark is not presented as a standalone element but is part of the word 'JOYANN'. In this connection I refers to the opponent's own evidence that when the mark 'JOY' has been used as part of the word 'ENJOY' the letters 'EN' have been presented as a background, with 'JOY' superimposed on top, creating a separation between the two verbal elements, which is not how the element 'JOY' is presented in the applicant's mark. Since the word 'JOY' is subsumed into the word 'JOYANN' in the applicant's mark and it is not presented as a separate element, it follows that the average consumer will not recognise or identify the meaning of the word 'JOY' because it is lost within the word 'JOYANN'. The fact that the letters 'JOY' are presented as part of a different word, does not permit the inference that they will be perceived as an independent distinctive element. In addition, the applicant's mark is much longer than the opponent's marks, being 26 letters and 3 letters respectively. The similarity of the marks therefore rests only on the fact that the applicant's mark incorporates the three letters 'J', 'O' and 'Y' - which represent the entirety of the opponent's marks - within its fourth verbal element. Given the different length of the marks, and the fact that the letters 'J', 'O' and 'Y' are subsumed within the word 'JOYANN', I find that, as a result, the coincidence of the sequence 'JOY' in the marks is not sufficient to dispel the

public's impression that the marks bear no visual or aural similarity, and their overall impressions is different. The marks are visually and aurally different.

49. Conceptually, JOY is a dictionary word meaning “a feeling of great happiness” and its meaning is well-known. However, for the reasons which I have explained above, this meaning is not present in the applicant's mark. The applicant's mark ‘PROFUMI DI PANTELLERIA JOYANN’ is made up of four Italian words, meaning perfumes from Pantelleria, Pantelleria being an Italian island, and ‘JOYANN’. Although there is no dictionary definition of ‘JOYANN’, in my view, the word is likely to be perceived as variation of Joanne, a British female name (because it looks and sounds very much like it). Whether or not the average consumer is able to translate the Italian words in the applicant's mark, the marks are conceptually different.

Distinctive character of earlier marks

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

51. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

52. The 290 earlier mark consists of the word ‘JOY’. The word ‘JOY’ means “a feeling of great happiness” and is synonym with delight, pleasure, triumph and satisfaction. Although ‘JOY’ does not directly describe the goods for which it is registered, given its meaning, it conveys desirable emotions for perfumes (and the other registered cosmetic goods in class 3) to evoke and as, such, it has a laudatory connotation. In my view, this mark has a level of inherent distinctive character between medium and low. In its statement of ground and written submissions, the opponent refers to a EUIPO decision³ which it claims shows that the EUIPO has recognised the reputation and well-known character of ‘JOY’ for perfumes in the UK. However, this decision is not binding upon me, and I must make my own assessment based upon the evidence that has been filed in this case.

53. The 714 mark has additional graphic elements; however, they are very basic and ornamental and do not increase the distinctiveness of the mark to any material extent. In any event, since it is the distinctiveness of the common element that matters, any increased distinctiveness brought by the stylisation (which has no counterpart in the applicant’s mark) would not bring the opponent’s case any further forward.

54. I have already discussed the opponent’s evidence. Although the sale figures in the UK are not negligible, they are not particularly remarkable either. However, I also note that use of the mark ‘JOY’ for perfumes is very long-standing, having been released in the 1930s and having enjoyed almost a century of continuous use; this points to

³ Opposition no. B 003063221 to EUTM no. No 17 910 973 JOYFEEL.

JOY being recognised as a vintage perfume. The evidence also indicates that the JOY perfume saw enough of a boom to be identified as an iconic brand and one of the most popular scents from the 20th century. Further, the legacy of the JOY perfume has endured as shown by the fact that it has maintained a luxury price tag and was licensed to a very well-known brand like Dior, that launched a co-branded version called ‘JOY by Dior’ which achieved the first place in the 2020 Best New Women’s Fragrance category, a major UK consumer poll, run by The Sunday Times – in this connection, it is notable that almost 1.6 million votes were cast. Further, JOY perfume was the ‘Reader’s Choice for Women’, as voted for by readers of the Evening Standard and the ‘People’s Choice – Women’, as voted for by users of the retail website boots.com, in 2019. Taking these awards in conjunction with the longevity and history of the mark into account as shown by the evidence as a whole, I find that the level of inherent distinctive character of the trade mark JOY had been enhanced to a medium to high level for perfumes at the relevant date.

Likelihood of confusion

55. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

56. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

57. Earlier in this decision I found that:

- some of the competing goods in class 3 are identical, some are similar to various degree, and some are dissimilar;

- the relevant consumers of the goods at issue include members of the general public;
- the purchasing process will be predominantly visual although I do not discount aural considerations. The goods will be selected with an average (or medium) degree of attention;
- the earlier marks and the contested marks are visually, aurally and conceptually different;
- the earlier marks are inherently distinctive to a low to medium degree and their distinctiveness has been enhanced to a medium to high degree through use.

58. Given my finding that the marks are visually, aurally and conceptually different, the only possible outcome of the case is that there is no likelihood of confusion. In *Calvin Klein Trademark Trust v OHIM*, Case C-254/09 P, the CJEU found that:

“53. As regards the third part of the first ground of appeal, it should be noted, first, that, where there is no similarity between the earlier mark and the mark applied for, the reputation of or the goodwill attaching to the earlier mark and the fact that the goods or services concerned are identical or similar are not sufficient for it to be found that there is a likelihood of confusion between the marks at issue (see, to that effect, Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 54; Case C-234/06 P II *Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraphs 50 and 51; and the judgment of 11 December 2008 in Case C-57/08 P *Gateway v OHIM*, paragraphs 55 and 56).

54. In the judgment under appeal, the General Court found that there was no similarity between the marks at issue. It stated, at paragraph 52 of that judgment, that the visual, phonetic and conceptual examination of the marks shows that the overall impression created by the earlier marks is dominated by the element ‘ck’ whereas that created by the trade mark applied for is dominated by the element ‘creaciones kenny’, concluding that the lack of

similarity between the signs at issue thus stems from their visual, phonetic and conceptual differences.

56. It must be observed in that connection that, contrary to what appears to be stated at paragraph 39 of the judgment under appeal, the existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. According to established case-law, in order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (see *OHIM v Shaker*, paragraphs 41 and 42; the judgment of 20 September 2007 in Case C-193/06 *P Nestlé v OHIM*, paragraphs 42 and 43; and *Aceites del Sur-Coosur v Koipe*, paragraph 62). In that connection, it is sufficient for the common component not to be negligible.

57. However, it is clear that the General Court found, first, that the overall impression created by the mark applied for is dominated by the element ‘creaciones kennya’, on which the consumer concerned will to a very great extent focus his attention and, second, in particular at paragraph 44 of the judgment under appeal, that the element ‘ck’ occupies only an ancillary position in relation to that element, which, in essence, amounts to a conclusion that the element ‘ck’ in the mark applied for is negligible.

58. Thus, having ruled out, on the basis of a properly conducted analysis, any similarity between the marks at issue, the General Court correctly concluded, at paragraphs 53 to 57 of the judgment under appeal, that, notwithstanding the reputation of the earlier marks and the fact that the goods covered by the marks at issue are identical, there is no likelihood of confusion between the marks.”

59. However, if I am wrong to the extent that the presence of the letters J, O, Y in the applicant's mark gives rise to a very low degree of visual and aural similarity, I will, for the sake of completeness, consider the opponent's argument that there will be a likelihood of indirect confusion in the sense that the applicant's mark will be seen by the relevant public as an extension of the opponent's mark.

60. Given what I have said above about the word 'JOY' being subsumed within the word 'JOYANN' in the applicant's mark and not retaining an independent distinctive role, there is no reason why the average consumer would make any connection between the marks, let alone being confused about the existence of an economic connection between the users of the marks. Clearly, there will be no direct confusion where the marks share such limited similarity (if any). There is no likelihood of confusion.

61. The opposition under Section 5(2)(b) fails.

Section 5(3)

62. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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”.

63. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

64. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and the court's answer to question 1 in *L'Oreal v Bellure*).

65. The relevant date for the assessment under Section 5(3) is the priority date of the application at issue, being 27 June 2019.

Reputation

66. In *General Motors, Case C-375/97*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

67. Bearing in mind my earlier assessment of the evidence before me, I am satisfied that the opponent had a qualifying reputation at the relevant date for perfumes. I find that the opponent’s reputation in relation to perfumes is moderate.

Link

68. As noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks. I found that the marks are visually and aurally similar to, at best, a very low degree and conceptually different;

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. Some of the contested goods are identical, some are similar to various degree and some are dissimilar.

The strength of the earlier mark's reputation. The opponent's marks have a moderate reputation in relation to perfumes.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The earlier marks are inherently distinctive to a low to medium degree and their distinctiveness has been enhanced to a medium to high degree.

Whether there is a likelihood of confusion. I found that there is no likelihood of confusion.

69. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's registrations to mind when confronted with the applicant's mark, thereby creating the necessary link.

70. I am not persuaded that the earlier marks would be brought to the mind of the relevant public when seeing the contested mark, even for identical goods. Having concluded that it is unlikely that the average customer when coming across the mark as a whole would take the letters J, O and Y as a reference to the word 'JOY', the opponent's case has no prospects of success under Section 5(3) and is bound to fail just as it failed under Section 5(2)(b) for the same reasons, since reputation cannot be taken into account in relation to the assessment of similarity.⁴ If there is any similarity between the marks it is too minimal for a link to be made.

⁴ Ravensburger AG v OHIM, Case T-243/08 and Gateway v OHIM, Case C58/08 P

OUTCOME

71. The opposition fails, and the applied-for mark will proceed to registration.

COSTS

72. As the applicant has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the applicant the sum of £700 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the opponent's statement:	£300
Considering the opponent's evidence:	£400
Total	£700

73. I therefore order JEAN PATOU to pay PROFUMI DI PANTELLERIA S.R.L. the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 31st day of May 2023

Teresa Perks
For the Registrar