O/0630/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3802378
IN THE NAME OF MARTIN JOHN MOSS
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 436122
BY JEAN PATOU

Background and pleadings

1. On 23 June 2022, Martin John Moss ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK, under number 3802378 ("the applicant's mark"). Registration is sought for *room scenting sprays* in class 3. Details of the application were published for opposition purposes on 8 July 2022.

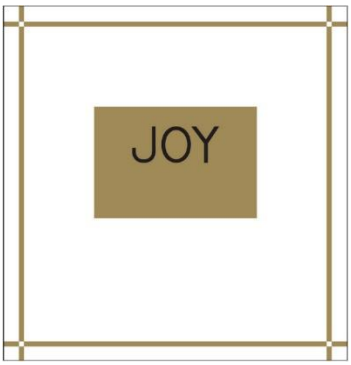
2. On 8 September 2022, Jean Patou ("the opponent") opposed the applicant's mark under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").

3. For the purposes of its claim under section 5(2)(b), the opponent relies upon the following trade marks:

i) **JOY**
UK registration no. 714290
Filing date: 26 January 1953
Registration date: 26 January 1953

Goods relied upon:
Class 3: Perfumes.

("the opponent's first mark")

ii) 

UK registration no. 917895714
Filing date: 4 May 2018
Registration date: 19 March 2019

Goods relied upon:

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.

("the opponent's second mark")[1]

4. The opponent's marks qualify as earlier trade marks in accordance with section 6 of the Act. As the opponent's first mark had completed its registration process more than five years before the filing date of the applicant's mark, it is subject to the use requirements specified within section 6A of the Act. The opponent's second mark had not completed its registration process five years or more before the filing date of the applicant's mark. Therefore, it is not subject to the use provisions.

5. In its statement of grounds, the opponent contends that the competing marks are similar and that the parties' goods are similar. On this basis, the opponent argues that there is a likelihood of confusion, including the likelihood of association.

6. As for section 5(3), the opponent claims that its first mark enjoys a significant reputation in the UK in respect of *perfumes*. It submits that this reputation is such that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the repute and distinctive character of its mark. The opponent also

[1] The opponent's second mark is a comparable trade mark based upon pre-existing EU trade mark number 17895714. On 1 January 2021, in accordance with article 54 of the Withdrawal Agreement between the UK and EU, a comparable UK trade mark was automatically created. It is now recorded on the UK register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

contends that the relevant public would believe there is an economic connection between the users of the competing marks.

7. The applicant filed a counterstatement, denying the grounds of opposition. The applicant denies that the competing marks and the parties' goods are similar. They also dispute that there is a likelihood of confusion.

8. The opponent is professionally represented by Williams Powell. The applicant is not professionally represented. Only the opponent filed evidence.[2] No hearing was requested. Neither party filed written submissions in lieu of attendance, though I note that the applicant filed written submissions during the evidence rounds. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

10. The opponent's evidence is given in the witness statements of Nicola Harrison, dated 11 July 2023, and Lionel Darolles, dated 13 July 2023. Ms Harrison is a Trade Mark Attorney with the opponent's representatives. Her statement is accompanied by one exhibit (NH1). She gives evidence as to an alleged overlap between the parties' goods. Mr Darolles is Legal Manager of the opponent company, a position he has held

[2] I note that the applicant attempted to file evidence alongside its written submissions dated 18 September. However, by official letter dated 29 September 2023, the Tribunal indicated that this was not in correct evidential format. An opportunity was given to the applicant to file amended evidence. No response or amended evidence was received from the applicant. As such, by official letter dated 15 November 2023, the Tribunal confirmed that the evidential materials originally filed would not be attributed any weight in the final determination of the proceedings. On this basis, I will only take the applicant's filing into account insofar as it contains submission, rather than evidence of fact.

since 2017. His statement was filed with 20 exhibits (LD1-LD20). He provides the opponent's evidence of use.

11. The opponent's evidence was accompanied by written submissions dated 13 July 2023.

12. The applicant filed written submissions dated 18 September 2023.

13. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

Preliminary remarks

14. I note that, within the applicant's submissions, they contend as follows:

> "[…] we have been trading on amazon under the mark we are trying to register, for around 14 months, without any confusion with the oppositions brand / mark. We have also been trading via our own website, also without any customer confusion."

15. Whilst I acknowledge these comments, I must clarify that the absence of confusion in the marketplace does not tend to be relevant.[3] This is because the absence of confusion may be down to the earlier mark having only been used to a limited extent, in relation to only some of the goods for which it is registered, or in such a way that there has been no possibility of one mark being mistaken for the other.[4] I accept that a lack of actual confusion may be persuasive in circumstances where parties have been trading alongside one another over an extended period of time.[5] However, even though the applicant says that they have been trading under the mark, there is no evidence before me as to the form that trade has taken, what trade mark has been used, or on what scale. Even if I was to attribute the applicant's 'evidence' any weight in these proceedings, it merely consists of three undated printouts from its website.

[3] *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283
[4] *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220
[5] *Azumi Limited v Nick Robinson*, BL O/078/22, paragraphs 34-35

This is far from sufficient for establishing that the parties have traded in circumstances where the relevant public has been exposed to their marks and has been able to differentiate between them without confusion as to the trade origin of the goods.

16. I also note that the opponent has provided a selection of decisions from the Opposition Division (EUIPO) which found that 'JOY' had a reputation and/or an enhanced distinctive character for *perfumes*.[6] While I acknowledge the contents of these decisions, it suffices to say that they are not relevant to the present proceedings. It is well established that previous decisions of the EUIPO are not binding on the Registrar. I must base my assessments upon the evidence before me, not upon conclusions reached by other IP offices.

Proof of use

17. As noted above, the opponent relies on its first mark under its section 5(2)(b) and 5(3) grounds to the extent that it is registered for *perfumes* in class 3. In its notice of opposition, the opponent made a statement of use in respect of these goods.[7] Within its counterstatement of 3 February 2023, the applicant indicated that it would require the opponent to provide proof of use in relation to *room scenting sprays* in class 3.[8]

18. In the official letter dated 9 March 2023, the Tribunal advised that, since the opponent's first mark was only registered in respect of *perfumes and non-medicated face powder*, proof of use could only be requested for these goods. An opportunity was given for the applicant to file an amended counterstatement.

19. An amended counterstatement was duly filed on 30 March 2023. However, the applicant still requested proof of use in relation to *room scenting sprays*. Whilst this did not prevent the defence being admitted into the proceedings, the effect of this is that the applicant has not put the opponent to proof of use for the goods it relies upon. As such, I will proceed on the basis that genuine use of the opponent's first mark has been accepted in respect of *perfumes*.

[6] Exhibit LD20
[7] Form TM7, questions 2-3a
[8] Form TM8, question 7

Section 5(2)(b)

Legislation and case law

20. Sections 5(2)(b) and 5A of the Act read as follows:

> "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 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."
>
> "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."

21. 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.

My approach

22. To my mind, the opponent's first mark represents the opponent's best case. It is clearly more similar to the applicant's mark than the opponent's second mark because it simply consists of the word 'JOY', without any additional (differing) figurative elements. Moreover, the goods and services of the opponent's second mark are no closer to the applicant's goods than the goods of its first mark. As such, I will proceed on the basis of the opponent's first mark, returning to consider its second mark only if it becomes necessary to do so. For the sake of brevity, I will hereafter refer to the opponent's first mark as "the opponent's mark".

Comparison of goods

23. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
Class 3: Perfumes.	Class 3: Room scenting sprays.

24. Ms Harrison provides evidence which is said to show an overlap between home scent/cleaning products and perfumes.[9] On the basis of this evidence, she says it is not inconceivable that a company who manufactures and sells room scenting sprays would move into producing personal scents and perfumes, and vice versa. This evidence consists of:

[9] Exhibit NH1

i) Printouts from avamayaromas.com/scents, obtained on 11 October 2022, showing a range of scents for candles, wax melts and reed diffusers.[10] The scents are "inspired" by well-known fragrances by companies such as Dior, Tom Ford and Jo Malone, as well as cleaning products such as Method, Fairy and ZoFlora. The webpage states that "[…] these scents are in no way affiliated with the designer fragrance".

ii) An article from *Ideal Home*, which is undated but said to be from 6 November 2020. The article explains how scents "inspired" by cleaning products have become increasingly popular. The founder of the company refers to such scents as "dupes", which I understand to mean a duplicate or copy of something.

iii) An article from *Manchester Evening News*, which is undated but said to be from 16 March 2022. This reports on one shopper likening the scent of a cleaning product stocked by B&M, Tesco and Aldi to a Marc Jacobs perfume.

25. Firstly, I note that some of this evidence is from after the relevant date. Therefore, it is of limited probative value. In any event, it is my view that this evidence can only be taken to show that some manufacturers of cleaning products and home fragrances are copying well-known perfumes. It does not assist the opponent in demonstrating any material overlaps in the relevant factors which could give rise to similarity between the goods at issue.

26. The law requires that goods be considered identical where one party's description of its goods encompasses the specific goods covered by the other party's description (and vice versa).[11] The word 'perfume' has various definitions; some make explicit reference to something that is applied to the skin, whilst others suggest that it includes goods that make a particular place or thing smell nice.[12] On the basis of the latter, it is my view that its meaning could include items such as room perfumes. Consequently, I find that the opponent's *perfumes* encompass the applicant's *room scenting sprays*.

[10] The webpage also says "[…] our range of scents are available throughout our products". Therefore, it is possible that the scents are used for other goods. However, there is no indication as to what these are.
[11] *Gérard Meric v OHIM,* Case T-33/05
[12] https://www.collinsdictionary.com/dictionary/english/perfume

Therefore, they are to be regarded as identical. If that is not correct, and the applicant's goods cannot be fairly described as a type of perfume, the respective goods are still similar to at least a low degree. This is due to the cumulative effect of overlaps, albeit relatively general, in a number of factors including the nature, purpose, method of use and users of the respective goods.[13] Whilst I accept that one is typically for the home and the other is for the body, both of the goods may consist of fragranced liquids which are sprayed from a container to provide a pleasant smell.

The average consumer and the nature of the purchasing act

27. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 […] 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."

28. The goods at issue in these proceedings are available to the general public. The frequency with which they are purchased, and their associated cost, is likely to vary. For instance, some room sprays are likely to be inexpensive and may be purchased frequently, whereas luxury perfumes may be purchased less often and at greater cost. In my view, this also means that the level of attentiveness exhibited during the

[13] When making a comparison between goods which are not identical, all relevant factors relating to the goods should be taken into account; those factors include their nature, intended purpose, method of use, trade channels, users, and whether they are in competition with each other or are complementary: *Canon*, Case C-39/97, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

purchasing process is likely to vary. The latter are likely to attract more consideration than the former. That being said, I do not consider any of the goods to be merely casual purchases. This is because the average consumer will consider factors such as scent, ingredients and capacity when selecting the goods. Overall, I find that the average consumer will demonstrate a medium level of attention. The goods are typically purchased from retail establishments and their online equivalents, after being viewed on shelves or on websites. As such, it is my view that the purchasing process is predominantly visual in nature. However, I do not exclude aural considerations entirely, since the average consumer may receive word-of-mouth recommendations or discuss the products with sales assistants.

Distinctive character of the earlier mark

29. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee* 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 *WindsurfingChiemsee*, paragraph 51)."

30. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

31. The opponent's mark consists of the plain word 'JOY' with no other elements. It is an ordinary dictionary word which means a feeling of great happiness. The word is not descriptive of the goods relied upon. However, given that it conveys a desirable emotion for perfumes to evoke, it is my view that it has laudatory connotations. As such, I find that the inherent distinctive character possessed by the opponent's mark is between a low and medium level.

32. Evidence has been filed by the opponent and I am now required to determine whether it has demonstrated that its mark had an enhanced distinctive character at the relevant date of 23 June 2022.

33. Mr Darolles gives evidence that the trade mark 'JOY' was first used in relation to a fragrance produced by Jean Patou, a famous Parisian fashion designer, in 1930. He says that it garnered worldwide acclaim and soon became an iconic, luxury brand. Images of perfume bottles adorned with the word 'JOY' have been provided.[14] The perfume can also be seen in printouts from the opponent's website (jeanpatou.com) from 2015.[15]

34. Originally, only 250 bottles were produced for Jean Patou's clients in the US, creating an image of exclusivity. Once it was produced for general sale, the perfume is said to have enjoyed incredibly high sales. Various articles from 2015-2019

[14] Exhibit LD1; Whilst the word 'JOY' is used in conjunction with the word 'FOREVER' on some of the perfumes, I consider this to be use of the registered mark.
[15] Exhibit LD10

regarding the popularity of the perfume have been provided.[16] It is described as "world famous" and is purportedly the second best-selling perfume of all time. 'JOY' also featured in books about perfumes published in 1983, 2006, 2013 and 2015.[17] These, too, describe the success and popularity of the perfume. Many refer to it as being marketed as "the costliest perfume in the world" (each ounce requiring around 10,000 jasmine flowers and over 300 roses). An article from *Town and Country*, dated 23 November 2016, states that 'JOY' was the favourite perfume of Jackie Kennedy (former first lady of the USA) and Vivien Leigh (British actress).[18]

35. Mr Darolles says that the 'JOY' perfume has been advertised in, and received extensive publicity from, third-party publications. Extracts from a selection of UK publications, such as *Good Housekeeping*, *Elle*, *You* and *Vogue*, from 2013-2018 featuring the perfume are in evidence.[19] The perfume was inducted into the UK Fragrance Foundation's Hall of Fame in 1990.[20] It also won this organisation's 'Scent of the Century' FiFi award in 2000.[21] Mr Darolles also provides evidence of other advertising activities connected with the 'JOY' perfume. This comprises two invoices from a third party for tester display units for 'JOY' perfumes in 2013 for around £40,000; invoices from a third party for brochures, 'JOY FOREVER' adverts and 'JOY' business cards in 2013 for around £1,200; and an invoice from a third party for illustrations for gift boxes and bags in 2018 for €2,500.[22] Moreover, printouts from the opponent's Twitter page (which had 60 followers as of December 2015) show a range of posts by the opponent and other Twitter users about 'JOY' perfumes before the relevant date.[23] No indication is given as to where the other Twitter users are based; some of the posts are not in English, suggesting that they are not UK consumers.

36. Mr Darolles provides the following figures from sales of 'JOY' and 'JOY FOREVER' perfumes by SA Designer Perfumes (the opponent's distributor) in the EU:[24]

[16] Exhibit LD2
[17] Exhibit LD3
[18] Exhibit LD4
[19] Exhibit LD5
[20] Exhibit LD6
[21] Exhibit LD7
[22] Exhibit LD8
[23] Exhibit LD9
[24] These figures are taken together since use of 'JOY FOREVER' is use of the mark as registered.

Year	Sales (€)
2013	594,140
2014	532,630
2015	379,426
2016	310,441
2017	245,523
2018	160,251
Total	2,222,411

37. He estimates that UK sales would have accounted for around 20% of the above figures. A selection of invoices regarding the sale of 'JOY' perfumes between June 2013 and December 2020 have been provided.[25] Whilst the invoice amounts include products sold under other trade marks and many of the quantities are not visible, the invoices at least establish that 'JOY' perfumes were sold to UK undertakings before the relevant date. Mr Darolles provides the following UK sales figures for 'JOY' and 'JOY FOREVER' perfumes:[26]

Year	Sales (£)
2015-2016	55,165.31
2016-2017	56,605.02
2017-2018	59,265.83
Total	171,036.16

38. The EU and UK figures are said to represent wholesale values; according to Mr Darolles, the retail value would typically be around four times higher.

39. In 2018, Parfums Christian Dior became a licensee of the 'JOY' mark and launched a fragrance in combination with its own 'Dior' brand. The advertising campaign for this starred Jennifer Lawrence (Hollywood actress).[27] The perfume was recommended as a gift idea by *The Times* in 2019.[28] 'JOY by DIOR' won the Fragrance Foundation's

[25] Exhibit LD12
[26] Again, I take these figures together as use of 'JOY FOREVER' is use of the registered mark.
[27] Exhibit LD13
[28] Exhibit LD15

'Ultimate Launch' award in 2019 and was a finalist in several other categories that year, including Best New Fragrance – Women, Reader's Choice for Women (as voted for by readers of *Evening Standard*), People's Choice – Women (as voted for by users of boots.com) and Best New Fragrance – Women.[29] The perfume also won Best New Women's Fragrance in the Style Beauty Awards 2020, compiled by *The Times*.[30] This is said to be the UK's biggest luxury consumer beauty awards, voted for by around 1.6million readers. As of the relevant date, the 'JOY by DIOR' perfume had a rating of 4.5 stars on average from 107 reviews on Dior's website.[31] Reviews from UK purchasers can be seen in the printouts provided, with many positive comments about the fragrance, luxury and quality of the perfume.

40. Mr Darolles says that the luxurious and aspirational nature of 'JOY' has been carefully maintained since 1930; the perfume is sold at select luxury and prominent retailers in the UK, such as Harrods. He states that this is reflected in the high price point. An extract from Harrods' website is in evidence, which shows a 90ml bottle of 'JOY by DIOR' being retailed for £112.[32] Mr Darolles says that this puts the perfume in the "prestige category".

41. No details of the perfume market in the UK have been provided and there is no evidence to that effect. Moreover, the opponent has not given any indication as to what share of that market was held by 'JOY' perfumes at any time before the relevant date. However, the opponent has provided turnover figures. Its distributor achieved sales of around €2.2million between 2013 and 2018 in the EU, and Mr Darolles' narrative evidence is that around 20% of this is attributable to the UK. This would equate to around €440,000. Whilst this information could have certainly been presented in more precise terms, it has not been challenged by the applicant. A further turnover of around £170,000 was achieved in this territory between 2015 and 2018. These turnover figures are supported by invoices demonstrating sales to UK consumers before the relevant date. It is my impression that the market for perfumes in the UK is very large. In this context, the figures provided by the opponent are not particularly remarkable.

[29] Exhibit LD16
[30] Exhibit LD17
[31] Exhibit LD18
[32] Exhibit LD14

However, I bear in mind that goods of this nature are not typically purchased very often. I also accept that these are wholesale figures and Mr Darolles' unchallenged statement that the retail prices are generally higher. Whilst the evidence suggests only a small amount has been invested in promoting 'JOY' perfumes in the UK (around £40,000 and €2,500), the perfume received coverage in third-party publications in this territory (some of which are household names) over a number of years before the relevant date. The perfume was inducted into a Hall of Fame by a UK-based organisation in 1990 and won a UK award for 'Scent of the Century' in 2000. These accolades clearly speak to the success of the perfume. The evidence also shows that the opponent's mark was licensed to a famous company (Dior). The licensed perfume featured in UK publications and won awards (some of which were voted for by the public) before the relevant date. I do not place undue weight on the evidence from Twitter because the opponent's page had a small number of followers and the relevant internet users may not have been based in the UK. Nevertheless, it at least indicates that 'JOY' perfumes had been referenced in posts before the relevant date. Again, whilst I do not place undue weight on these features of the evidence as they are not specific to the UK, the 'JOY' mark appears to have been used in relation to perfumes for nearly 100 years; it is purportedly the second best-selling perfume of all time, and its success and popularity was documented in several books prior to the relevant date. On the balance of all the evidence before me, I find that the distinctiveness of the opponent's mark had been enhanced to between a medium and high level at the relevant date in relation to *perfumes*.

Comparison of trade marks

42. It is clear from *Sabel* 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 *Bimbo* 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."

43. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

44. The competing marks are as follows:

The opponent's mark	**The applicant's mark**
JOY	

45. The opponent's mark is in word-only format and consists of the word 'JOY'. As it is the only element of the mark, its overall impression lies in the word itself. The applicant's mark is figurative and comprises the letters 'JA' and the words 'JOY AROMA'. Although the letters play a somewhat subservient role to the words due to the former referring to the first two letters of the latter, they are relatively large and appear at the beginning of the mark. As such, it is my view that the letters and the words contribute a roughly equal amount to the overall impression of the mark. Of the two words, 'JOY' is more distinctive and has more impact.

46. Visually, the competing marks coincide in the shared use of the word 'JOY'. This is the sole element of the opponent's mark and co-dominates the overall impression of the applicant's mark. Given that the registration of word-only marks (such as the opponent's mark) provides protection for use of the words in any colour or font type,[33]

[33] *LA Superquimica, SA v EUIPO*, Case T-24/17

I do not consider the differences created by the applicant's font or colour to be significant. The competing marks are visually different insofar as the applicant's mark includes the letters 'JA' and the word 'AROMA'. Together, the letters co-dominate the overall impression and, whilst the word 'AROMA' has less impact in the mark, it is not negligible. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the marks.

47. To my mind, it is unlikely that the letters 'JA' in the applicant's mark will be articulated. This is because they will merely be seen as emblematic of the first two letters of the words. The word 'JOY' will be pronounced in the ordinary way. This syllable is identically reproduced in both marks. It is the entirety of the opponent's mark and the first aural element of the applicant's mark. The competing marks are aurally different in that the applicant's mark includes additional syllables emanating from the word 'AROMA'. Overall, I find that there is between a medium and high degree of aural similarity between the competing marks.

48. Conceptually, the word 'JOY' will be understood as a feeling of great happiness. The word 'AROMA' in the applicant's mark conveys the meaning of a pleasant smell. This will be perceived as a strongly allusive, if not descriptive, reference to the goods at issue. If they carry any semantic content, the letters 'JA', being perceived as the first two letters of the words 'JOY' and 'AROMA', will simply reinforce the meanings already outlined. The competing marks conceptually overlap due to the shared meaning of the word 'JOY'. They differ in the additional concept conveyed by the applicant's mark. Bearing in mind my assessment of the overall impressions, I find that there is between a medium and high degree of conceptual similarity between the competing marks.

Likelihood of confusion

49. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is

necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

51. Earlier in this decision, I concluded that:

- The parties' goods are identical or similar to at least a low degree;

- The average consumer is a member of the general public, who will demonstrate a medium level of attention;

- The purchasing process will be predominantly visual in nature, though aural considerations have not been excluded;

- The opponent's mark is factually distinctive to between a medium and high level;

- The overall impression of the opponent's mark lies in the word 'JOY';

- The overall impression of the applicant's mark is co-dominated by the letters 'JA' and the words 'JOY AROMA', with the word 'JOY' having the most impact of the two words;

- There is a medium degree of visual similarity, and between a medium and high degree of aural and conceptual similarity between the competing marks.

52. I acknowledge that the competing marks share the identical word 'JOY'. This is the only element of the opponent's mark and co-dominates the overall impression of the applicant's mark. Nevertheless, there are differences between the marks which are not negligible. The applicant's mark contains the additional word 'AROMA'; although this is (at best) strongly allusive of the goods at issue in these proceedings, resulting in the word having less of an impact, it still contributes to the overall impression. Moreover, the applicant's mark has the letters 'JA' in a slightly stylised font. This element has no counterpart in the opponent's mark and co-dominates the overall impression of the applicant's mark. It also appears at the beginning of the mark, a position which generally has more impact.[34] Therefore, even though these letters read into the words in the applicant's mark, I am not convinced that they will be overlooked. The level of distinctiveness of the opponent's mark and the parties' goods being identical (if I am correct in my primary finding) are, of course, factors in the opponent's favour. However, taking all of the above into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer, even if paying less attention, to distinguish between them and avoid mistaking them for one another. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion.

53. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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

[34] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

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)."

54. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.[35] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.[36] It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.[37]

[35] As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.
[36] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[37] See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13.

55. Whilst the average consumer is likely to notice and recall the differences between the competing marks, they will also identify the identical word 'JOY'. This is the only element of the opponent's mark and is factually distinctive to between a medium and high level. It also co-dominates the applicant's mark and has the most impact of its constituent words. Whether consciously or unconsciously, this will lead consumers through the mental process described in *L.A. Sugar*. It is my view that the similarities and differences between the competing marks readily lend themselves to indicating a sub-brand or brand extension. The addition of the strongly allusive (if not descriptive) word 'AROMA' seems entirely consistent with the use of a variant 'JOY' mark which contains an informative reference to the goods sold under the mark. Further, the inclusion of the letters 'JA' at the beginning of the applicant's mark, which reinforce the words that follow, and the use of colour are likely to be seen as a variation of the 'JOY' brand with additional decorative elements. Even if the goods can only be considered similar to a low degree, it is my view that the average consumer, even if paying more attention, will assume a commercial association between the parties due to the shared use of the word 'JOY' and the nature of the additional elements in the applicant's mark. As a result, I find that there is a likelihood of indirect confusion.

Conclusion

56. The opponent's claim under section 5(2)(b) is successful.

Section 5(3)

Legislation and case law

57. Section 5(3) of the Act states:

> "(3) A trade mark which-
>
> 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".

58. 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".

59. 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'Oréal v Bellure,* 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-Salomon, 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'Oréal 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'Oréal v Bellure).*

60. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark is similar to the applicant's mark.[38] Secondly, the opponent must show that its mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the opponent must establish that the public will make a link between the marks, in the sense of its mark being brought to mind by the applicant's mark. Fourthly, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

61. The relevant date for the assessment under this ground is the filing date of the applicant's mark, that being 23 June 2022.

Reputation

62. 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.

[38] Only the opponent's first mark is relied upon under this ground. Again, for the sake of brevity, I will simply refer to it as "the opponent's mark".

> 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."

63. Within their amended counterstatement, the applicant states as follows:

> "Whether the opponent's earlier registrations have a reputation for the relevant goods and/or services relied upon.
>
> I deny this, my reason for this is due to the opponent's mark not being registered within the goods and services we are trying to register. I do not believe the opponent has a reputation in home fragrance or room scenting sprays."

64. On this basis, the opponent submits that the applicant has not contested that its mark has a reputation for the relevant goods relied upon. Since the opponent claims a reputation in respect of *perfumes*, not home fragrance or room scenting sprays, I agree. Indeed, this seems to have been positively conceded by the applicant in its amended counterstatement, where they state that "[…] I am aware of the opponent's reputation has been built surrounding mainly of Perfumes / aftershaves". However, given that the applicant has not specified how strong they consider the opponent's reputation to be, this must be assessed by reference to the evidence. I have already discussed the opponent's evidence. For the same reasons as given at paragraph 41, I am satisfied that the opponent's mark had a moderate reputation in the UK at the relevant date in respect of *perfumes*.

Link

65. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take into account all relevant factors. The factors are identified in *Intel* at paragraph 42. I take each of these in turn.

The degree of similarity between the conflicting marks

66. I have found that there is a medium degree of visual similarity, and between a medium and high degree of aural and conceptual similarity between the competing marks.

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

67. I have found that *room scenting sprays* and the reputed goods are either identical or similar to at least a low degree. As I have already outlined, the goods will be purchased by the general public. Overall, a medium level of attention will be exhibited during the purchasing process. The goods are likely to be purchased visually, but I have not discounted aural considerations.

The strength of the earlier mark's reputation

68. I have found that the opponent's mark has a moderate reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

69. I have found that the opponent's mark possesses between a low and medium level of inherent distinctive character, which has been enhanced to between a medium and high level for the reputed goods.

Whether there is a likelihood of confusion

70. I have found that there is a likelihood of indirect confusion between the competing marks.

Conclusions on link

71. Taking into account all of these factors, in particular the repute and distinctiveness of the opponent's mark, together with the overall levels of similarity between the competing marks, it is my view that a link will be made in the mind of the relevant public. For the avoidance of doubt, I consider this to be the case even if the parties' goods are only similar to a low degree.

Damage

72. Part of the opponent's case on damage is that use of the applicant's mark will take unfair advantage of the repute of its mark; it will ride on the coat-tails of the prestigious reputation the opponent has generated through almost a century of use and significant financial investment, without paying any financial compensation. The opponent argues that this has not been disputed by the applicant and submits that it should be deemed admitted. However, the applicant's amended counterstatement contains a clear denial of this claim. Therefore, it would clearly be inappropriate to proceed as suggested by the opponent.

73. Taking advantage of the reputation of an earlier trade mark means that consumers are more likely to buy the goods of the later mark than they would have otherwise been if they had not been reminded of it. As a result, the marketing of the later mark will not require as much effort or investment due to the familiarity that the relevant public would already feel with it or the message they are sent about what to expect.

74. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J (as he then was) considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of

> the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

75. I have already found that there is a likelihood of indirect confusion between the competing marks, whereby the applicant's goods may be purchased in the mistaken belief that they are provided by, or economically connected with, the opponent. In such circumstances, it is clearly foreseeable that the applicant will secure an unfair commercial advantage by benefitting from the opponent's repute without paying financial compensation. Instant familiarity amongst the relevant public will make it easier for the applicant to establish their mark and sell their room scenting sprays without incurring the marketing costs that would otherwise be required. The evidence suggests that the opponent's mark is associated with luxury and a popular fragrance. This is clearly an image that could transfer to the applicant. Even if there is no subjective intention on the part of the applicant to take unfair advantage of the opponent's mark, it is my view that this would be the objective effect.

76. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the other pleaded heads of damage.

Conclusion

77. The opponent's claim under section 5(3) is successful.

Overall outcome

78. The opposition under sections 5(2)(b) and 5(3) of the Act has been successful. Subject to any appeal against this decision, registration of the applicant's mark will be refused.

Costs

79. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.[39] In the circumstances, I award the opponent the sum of **£1,300**, which is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£300
Preparing evidence and submissions	£800
Official fees	£200
Total	**£1,300**

80. I order Martin John Moss to pay Jean Patou the sum of **£1,300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 4th day of July 2024

James Hopkins
For the Registrar

[39] The proceedings having commenced after 1 July 2016 but before 1 February 2023.