O/0938/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003806413

BY ISLESTARR HOLDINGS LIMITED TO REGISTER:

JOYPHORIA

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000436232

BY JEAN PATOU

BACKGROUND AND PLEADINGS

1. On 5 July 2022, Islestarr Holdings Limited ("the applicant") applied to register, in the UK, the trade mark shown on the cover page of this decision ("the applicant's mark"). The applicant's mark was published in the Trade Marks Journal for opposition purposes on 22 July 2022 in respect of the following goods

> Class 3: Cosmetics, make up; non-medicated skin care preparations; lipsticks; lip gloss; make-up powder and foundation; skin moisturisers; beauty care cosmetics; body care preparations; essential oils for personal use; preparations for removing make-up; lotions, creams and conditioners for the face, hands and body; beauty masks; abrasive cloth; abrasive paper; abrasives preparations for the skin; adhesives for affixing false hair; adhesives for cosmetic purposes; after-shave lotions; almond milk for cosmetic purposes; almond oil for cosmetic purposes; almond soap for the skin; aloe vera preparations for cosmetic purposes; alum stones being astringents for cosmetic purposes; amber being perfume; antiperspirant soap; antiperspirants; aromatics being essential oils; astringents for cosmetic purposes; lip and body balms other than for medical purposes; bath salts, not for medical purposes; cosmetic preparations for baths; beard dyes; bergamot oil; bleaching preparations for cosmetic purposes; breath freshening sprays; breath freshening strips; cakes of toilet soap; essential oils of cedarwood; essential oils of citron; cleansing milk for toilet purposes; hair colorants for toilet purposes; color-removing preparations being nail polish removers; colour-brightening chemicals for household purposes; cosmetic kits comprising of makeup; cosmetic kits comprising of skincare; cosmetic preparations for slimming purposes; cosmetics for animals; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; cosmetic creams; skin whitening creams ; dental bleaching gels; deodorant soap; deodorants for human beings or for animals; depilatories; depilatory preparations; douching preparations for personal sanitary or deodorant purposes; dry shampoos; cosmetic dyes; eau de cologne; emery paper and cloth; ethereal essences; essential oils; ethereal oils; extracts of flowers being perfumes; eyebrow cosmetics; eyeshadow; eyebrow pencils; adhesives for affixing false eyelashes; cosmetic preparations for eyelashes; false eyelashes; adhesives for

affixing false hair; false nails; essential oils being bases for flower perfumes; extracts of flowers being perfumes; soap for foot perspiration; greases for cosmetic purposes; hair colorants; hair dyes; hair lotions; hair spray; hair waving preparations; hydrogen peroxide for cosmetic purposes; incense; ionone being perfume; jasmine oil being an essential oil; javelle water being toilet water; petroleum jelly for cosmetic purposes; joss sticks; cosmetic kits featuring cosmetics; lavender oil being an essential oil; lavender water; essential oils of lemon; lotions for cosmetic purposes; tissues impregnated with cosmetic lotions; make-up preparations; make-up removing preparations; mascara; massage gels other than for medical purposes; cleansing milk for toilet purposes; mint essence being essential oils; mint oil being an essential oil; musk being perfume; moustache wax; nail art stickers; nail care preparations; nail polish; nail varnish; hair neutralizers for permanent waving; oils for cosmetic purposes; oils for perfumes and scents; oils for toilet purposes; cosmetic pencils; perfumery; perfumes; denture polishes; pomades for cosmetic purposes; make-up powder; pumice stone for personal use; rose oil being an essential oil; shampoos; shaving preparations; shaving soap; cosmetic preparations for skin care; skin soap; antiperspirant soap; cakes of skin soap; deodorant soap; sunscreen preparations; sun-tanning preparations; talcum powder, for toilet use; terpenes being essential oils; toilet water; toiletries, namely, face wash and body wash solutions; decorative transfers for cosmetic purposes; varnish-removing preparations; depilatory wax; haircare preparations.

2. On 13 September 2022, JEAN PATOU ("the opponent") opposed the application based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").[1]

3. The opponent relies upon the following trade marks:

[1] 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.

i) **JOY**

("the first earlier mark")

UK registration no. 714290

Filing date: 26 January 1953

Registration date: 26 January 1953

Relied upon under sections 5(2)(b) and 5(3)

Goods relied upon:

Class 3: Perfumes

ii) 

("the second earlier mark")

UK registration no. 917895714[2]

Filing date: 4 May 2018

Registration date: 19 March 2019

Relied upon under section 5(2)(b) only

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

[2] The opponent's second earlier mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

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.

4. The opponent's marks qualify as earlier trade marks in accordance with section 6 of the Act. As the first earlier 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 second earlier 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 identical or 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 earlier 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 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 opponent's claims and putting the opponent to proof of use and reputation in respect of its first earlier mark.

8. Both parties filed evidence in chief during these proceedings, with the opponent's evidence being accompanied by written submissions. In addition, I note that the opponent also filed evidence in reply which, again, was accompanied by written submissions. A hearing took place before me on 28 January 2026, by video

conference. The opponent was represented by Ms Nicola Harrison of Williams Powell, who have represented the opponent throughout these proceedings. The applicant was represented by Mr Philip Harris of Abion UK Limited,[3] who have represented the applicant throughout these proceedings.

EVIDENCE

9. The opponent's evidence in chief came in the form of a witness statement from Lionel Darolles dated 17 April 2023. His witness statement is accompanied by 20 exhibits (being those labelled exhibits LD1-LD20). Mr Darolles is a Legal Manager for the opponent, a position he has held since 2017. His evidence serves to show that the opponent's mark has been genuinely used and that it enjoys a reputation. This evidence was accompanied by written submissions.

10. The applicant's evidence came in the form of the witness statement of Steven John Lane dated 27 August 2024. Mr Lane is a Chartered Trade Mark Attorney and Managing Partner of the applicant's representative, a position he has held since 2012. Mr Lane's evidence was adduced in defence of the applicant's position and is accompanied by 18 exhibits, being SJL1-SJL18.

11. In reply, the opponent filed the witness statement of Nicola Harrison dated 14 November 2024. As set out above, Ms Harrison is a trade mark attorney employed by Williams Powell, the opponent's representative and is, therefore, duly authorised to file evidence on its behalf. Ms Harrison's evidence is accompanied by three exhibits, being NH1-NH3. The evidence is also accompanied by written submissions.

12. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

[3] Previously Lane IP

DECISION

13. Given the opponent's length of use and its claimed reputation, the 'JOY' brand having been established in the 1920s, I will begin with my assessment under section 5(3). As noted above, the first earlier mark had completed its registration process more than five years before the application date of the mark in issue and therefore it is subject to proof of use pursuant to section 6A of the Act. However, for reasons that will become apparent later in this decision, I do not consider that the issue of proof of use will be determinative in these proceedings, and I will conduct my assessment on the basis that the opponent can rely upon the full breadth of its specification for its first earlier mark being perfumes in class 3.

Section 5(3)

14. 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".

15. Section 5(3A) of the Act 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".

16. The relevant case law can be found in the following judgments of the Court of Justice of the European Union ("CJEU"): Case C-375/97, *General Motors,* Case C-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 C-383/12P, *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; G*eneral 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) 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. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) 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).*

17. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are identical or similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be 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.

18. Under the present ground, the opponent relies on its first earlier mark for the term "perfume" only. The relevant date for the assessment under section 5(3) is the filing date of the applicant's mark i.e., 5 July 2022.

Reputation

19. 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."

20. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

The opponent's evidence of reputation

21. I note the following from the opponent's evidence:

a) Mr Darolles states that the trade mark 'JOY' was first used in 1930 for a fragrance created by Jean Patou, a famous Parisian fashion designer. He goes on to state 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 in some form." Examples of the mark displayed on packaging are shown in exhibit LD1 and are as follows:





b) Jean Patou acquired the rights to 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.

c) The mark 'JOY' has been advertised in relation to perfumes in several well-known UK publications between the years 2013 to 2018. These include *Good Housekeeping* (2013), *Glamour* (2014) and *Cosmopolitan* (2014).[4]

d) Further, evidence of other advertising activities connected with the 'JOY' perfume has been provided. This comprises two invoices from a third party for tester display units for 'Jean Patou' or 'JOY FOREVER' perfumes in 2013 (totalling approximately £40,000), invoices from a third party for brochures and business cards; and an invoice from a third party for illustrations for gift boxes and bags in 2018.[5] There is also an invoice that mentions 'JOY' dated 2014 for 400 'JOY' business cards for a total of £65.

e) An article from UK magazine *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).

f) The following figures by SA Designer Perfumes (the opponent's distributor) in the EU have been provided:

[4] Exhibit LD5
[5] Exhibit LD8

	2013	2014	2015	2016	2017	2018
JOY	387,581	425,831	319,029	268,788	185,231	143,272
JOY FOREVER	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

g) Mr Darolles estimates that UK sales would have accounted for around 20% of the above figures. A selection of invoices relating to sales of 'JOY' perfumes between June 2013 and December 2020 has been provided.[6] Although the invoice totals include products sold under other trade marks and some of the quantities are not visible, the invoices nevertheless show that 'JOY' perfumes were sold to UK undertakings before the relevant date.

h) Mr Darolles provides the following UK wholesale figures for 'JOY' perfumes:

	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**

i) The 'JOY' mark was licensed to Parfums Christian Dior in 2018. The collaboration was reported in *Vogue* magazine[7] and was accompanied by an advertising campaign featuring the Hollywood actress Jennifer Lawrence.

j) 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

[6] Exhibit LD12
[7] Exhibit LD13

shows a 90ml bottle of 'JOY by DIOR' being retailed for £112.[8] Mr Darolles says that this puts the perfume in the "prestige category".

k) In 2019, *The Times* newspaper recommended 'JOY by Dior' as a Christmas gift idea.[9] I note that the publication states the price as being £83. The perfume is shown as follows:



l) 'JOY by Dior' was named "Best New Women's Fragrance" in the 2020 Style Beauty Awards, compiled by *The Sunday Times*. The awards were based on almost 1.6 million reader votes, with *The Sunday Times* describing them as "the UK's biggest luxury consumer beauty awards".[10]

m) In 2019, 'JOY by Dior' perfume was a finalist for "Reader's Choice for Women" as voted for by readers of the *Evening Standard* and "People's Choice Women" as voted for by users of the retail website Boots.com.

n) Mr Darolles states that 'JOY' was awarded "Scent of the Century" at the UK FIFI awards in 2000.[11] "…beating its longstanding rival Chanel No. 5 (widely regarded as the most famous perfume of all time)".

[8] Exhibit LD14
[9] Exhibit LD15
[10] Exhibit LD17
[11] Exhibit LD7

My conclusions on reputation

22. The opponent's evidence shows that 'JOY' perfume was first launched in 1930. It is not precisely clear when use of the mark commenced in the UK. However, the fragrance received a "Scent of the Century" award in the UK in 2000, indicating that the mark was known in the UK by that date.

23. The opponent has not provided evidence concerning the market share in the UK, however, the applicant has filed evidence indicating that revenue generated in the UK fragrances market[12] amounted to €2.15 billion in 2024.[13] Whilst I accept that this post-dates the relevant date, it reflects that the market for perfumes in the UK is very large. In this context, the turnover figures provided by the opponent, whilst not negligible, are not particularly remarkable. I consider that turnover or sales figures relating to the period following the launch of 'JOY' by Dior would have been useful. I also note that no overall advertising expenditure figures have been provided and the evidence in relation to advertising shows a relatively small amount of investment in the UK (approximately £40,000).

24. Nevertheless, those deficiencies must be considered alongside the evidence as a whole. The evidence shows that 'JOY' perfume has received coverage in a number of well-known UK publications, that it has been recognised through industry and consumer awards, and that the JOY brand was subsequently licenced to a well-known company (Dior) which was accompanied by an advertising campaign featuring a Hollywood actress. Since that launch, I note that 'JOY by Dior' was a finalist for "Reader's Choice for Women" as voted for by readers of the *Evening Standard* and "People's Choice Women" as voted for by users of the retail website Boots.com (which is a national retailer). Further, in 2020, the mark won an award based upon votes cast by almost 1.6 million readers of *The Sunday Times*. I consider these awards demonstrate a notable degree of recognition amongst UK consumers.

[12] The article states that this includes Eau de Toilette and any fragrances which cover normal body odour. It does not include room fragrances or deodorant.
[13] Exhibit SJL5

25. While the evidence falls short of demonstrating a particularly strong or extensive reputation across the UK perfume market, I am satisfied that it establishes that the earlier mark was known to a significant part of the relevant public and therefore held a moderate reputation in the UK for perfume at the relevant date.

26. For the avoidance of doubt, whilst I bear in mind that not all of the evidence shown above would be relevant to the question of proof of use (which is limited to use within a five year period), I am satisfied that it does satisfy the use requirements of section 6A of the Act in relation to perfumes.

Link

27. As I 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

28. In *Intra-Presse SAS v OHIM*,[14] the CJEU stated that:

> "72…The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make

[14] Joined cases C-581/13P & C-582/13P

a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero* v *OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited)."

29. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.

30. The similarity of marks under sections 5(2) and 5(3) of the Act is assessed in the same way.[15]

31. The first earlier mark comprises the word 'JOY' without any additional elements and the applicant's mark consists of the word 'JOYPHORIA'. Visually, both marks contain the letters 'JOY'. This forms the entirety of the earlier mark and forms the first three letters of the applicant's mark. I bear in mind that beginnings of marks are where the average consumer tends to pay more attention. However, I note that this is a rule of thumb, rather than a rule of law. A point of difference lies in the presence of the letters 'PHORIA' in the applicant's mark; this has no counterpart in the first earlier mark. I also note that one mark has three letters whereas the other has nine, so it is noticeably longer. Considering these factors and noting that the common 'JOY' element is replicated exactly at the beginning of the applicant's mark, I find there is a medium degree of visual similarity.

32. The word 'JOY' is a well-known dictionary-defined word and will be pronounced in the ordinary way. This syllable is identically reproduced in both marks. It is the entirety of the first earlier mark and the first aural element of the applicant's mark. The marks differ aurally by way of the additional three syllables from the 'PHORIA'

[15] See the principles established 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

element in the applicant's mark. Overall, I consider the marks to be aurally similar to a low to medium degree.

33. The opponent submits that the competing marks are conceptually identical because the 'PHORIA' element of the applicant's mark is clearly intended to refer to "euphoria" which is conceptually identical to 'JOY'.

34. The marks clearly share the concept of 'JOY', which means "a deep feeling of happiness or contentment."[16] However, the later mark consists of the coined term 'JOYPHORIA', which is likely to be perceived as a combination of the words 'JOY' and 'EUPHORIA' which, to my mind, will convey an intensified sense of joy or "a feeling of great elation."[17] Consequently, while the marks are conceptually similar to a high degree, they do not convey precisely the same concept and are therefore not conceptually identical.

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

35. At the hearing, Ms Harrison submitted that the applicant's goods are all cosmetic preparations or toiletry products contained within class 3. Consequently, these goods are identical or highly similar.

36. In its skeleton arguments, the applicant accepted that there was some overlap in relation to the core goods, although it did not identify those goods. Following the hearing, Mr Harris provided a list of the specific goods which the applicant maintained were dissimilar to the goods relied upon by the opponent. These were as follows:

> Abrasive cloth; abrasive paper; abrasives preparations for the skin; adhesives for affixing false hair; adhesives for cosmetic purposes; antiperspirants; bath

[16] https://www.collinsdictionary.com/dictionary/english/joy
[17] https://www.collinsdictionary.com/dictionary/english/euphoria

salts, not for medical purposes; breath freshening sprays; breath freshening strips; colour-brightening chemicals for household purposes; cosmetics for animals; dental bleaching gels; douching preparations for personal sanitary or deodorant purposes; emery paper and cloth; adhesives for affixing false hair; joss sticks; massage gels other than for medical purposes; nail art stickers; denture polishes; sunscreen preparations; sun-tanning preparations; decorative transfers for cosmetic purposes.

37. I bear in mind that dissimilarity is a relative concept and that section 5(3) is not limited to situations in which the competing goods are similar. The relevant question is the degree of proximity between the respective goods and the extent to which the circumstances are such that the earlier mark may be brought to mind.

38. The opponent's reputation has been established in relation to *perfume*. I have grouped the applicant's goods below according to their degree of proximity to those goods. In reaching these findings, I have considered the nature, purpose, method of use, users and trade channels of all of the goods in the application.

Identical goods

39. The applicant's *perfumery; perfumes; amber being perfume; extracts of flowers being perfumes; ionone being perfume; musk being perfume; eau de cologne; toilet water; javelle water being toilet water; oils for perfumes and scents* are identical to, or fall within, the opponent's *perfume.*

Goods similar to a medium to high degree

40. The following goods fall within the cosmetics, beauty, fragrance or personal-care sectors: *cosmetics; make up; non-medicated skin care preparations; lipsticks; lip gloss; make-up powder and foundation; skin moisturisers; beauty care cosmetics; body care preparations; essential oils for personal use; preparations for removing make-up; lotions, creams and conditioners for the face, hands and body; beauty masks; after-shave lotions; almond milk for cosmetic purposes; almond oil for cosmetic purposes; almond soap for the skin; aloe vera preparations for cosmetic*

purposes; alum stones being astringents for cosmetic purposes; antiperspirant soap; antiperspirants; aromatics being essential oils; astringents for cosmetic purposes; lip and body balms other than for medical purposes; bath salts, not for medical purposes; cosmetic preparations for baths; bergamot oil; bleaching preparations for cosmetic purposes; cakes of toilet soap; essential oils of cedarwood; essential oils of citron; cleansing milk for toilet purposes; cosmetic kits comprising of makeup; cosmetic kits comprising of skincare; cosmetic preparations for slimming purposes; cosmetic creams; skin whitening creams; deodorant soap; deodorants for human beings or for animals; dry shampoos; cosmetic dyes; ethereal essences; essential oils; ethereal oils; eyebrow cosmetics; eyeshadow; eyebrow pencils; cosmetic preparations for eyelashes; essential oils being bases for flower perfumes; greases for cosmetic purposes; petroleum jelly for cosmetic purposes; hair lotions; hair spray; incense; jasmine oil being an essential oil; cosmetic kits featuring cosmetics; lavender oil being an essential oil; lavender water; essential oils of lemon; lotions for cosmetic purposes; tissues impregnated with cosmetic lotions; make-up preparations; make-up removing preparations; mascara; cleansing milk for toilet purposes; mint essence being essential oils; mint oil being an essential oil; oils for cosmetic purposes; oils for toilet purposes; cosmetic pencils; pomades for cosmetic purposes; make-up powder; rose oil being an essential oil; shampoos; shaving preparations; shaving soap; cosmetic preparations for skin care; skin soap; cakes of skin soap; sunscreen preparations; sun-tanning preparations; talcum powder, for toilet use; terpenes being essential oils; toiletries, namely, face wash and body wash solutions; haircare preparations. Although their precise nature and method of use differ from perfume, they are directed at the same broad consumer base, commonly share trade channels and may be offered under the same brands. Some may also be fragranced or used as part of the same personal-care regime. I find them similar to perfume to degrees ranging from medium to high.

Goods similar to a low degree

41. The applicant's *abrasive cloth; abrasive paper; abrasives preparations for the skin; emery paper and cloth; pumice stone for personal use; adhesives for affixing false hair; adhesives for cosmetic purposes; hair colorants for toilet purposes;*

color-removing preparations being nail polish removers; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; depilatories; depilatory preparations; adhesives for affixing false eyelashes; false eyelashes; false nails; soap for foot perspiration; hair colorants; hair dyes; hair waving preparations; hydrogen peroxide for cosmetic purposes; joss sticks; massage gels other than for medical purposes; moustache wax; nail art stickers; nail care preparations; nail polish; nail varnish; hair neutralizers for permanent waving; decorative transfers for cosmetic purposes; varnish-removing preparations; depilatory wax; beard dyes; cosmetics for animals; and *douching preparations for personal sanitary or deodorant purposes* are further removed from perfume in their nature, purpose or method of use. Nevertheless, they remain cosmetic, beauty, grooming or personal-care goods, or goods used in connection with those activities. They may be sold through overlapping trade channels and purchased by the same broad category of consumer. I therefore find them similar to perfume to a low degree.

Dissimilar goods

42. *Breath freshening sprays; breath freshening strips; dental bleaching gels; denture polishes;* and *colour-brightening chemicals for household purposes* differ from perfume in nature, intended purpose and method of use. Any overlap in users or general retail channels is insufficient, and the goods would not ordinarily be sold alongside one another. I find these goods dissimilar.

43. The relevant public for both parties' goods consists primarily of members of the general public. Even in respect of the more distant goods identified above, there remains at least some overlap in the relevant public. The goods are likely to be selected predominantly by visual means, although I do not discount an aural component arising through recommendations or discussions with retail staff.

<u>The strength of the earlier mark's reputation</u>

44. For the reasons I have already given, at the relevant date, the first earlier mark had a moderate reputation in the UK for *perfume.*

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

45. The first earlier mark consists solely of the word 'JOY'. This is an ordinary dictionary word which will be understood by the average consumer as meaning a deep feeling of happiness, pleasure or contentment. Although it is not descriptive of perfumes in class 3, it alludes to a desirable emotion that such goods may be intended to evoke. I therefore consider that the word has some laudatory connotations. Taking these factors into account, I find that the earlier mark has a low to medium degree of inherent distinctive character. In making this finding, I have taken the applicant's evidence regarding the use of the word 'JOY' in the fragrance sector into account. Whilst that evidence supports my finding that the earlier mark has a low to medium degree of inherent distinctive character, I must also assess whether the distinctive character of the earlier mark has been increased through use.

46. At the hearing, Mr Harris highlighted that the opponent had not pleaded that its earlier marks had achieved a level of enhanced distinctiveness. I do not consider the opponent's failure to specifically plead enhanced distinctiveness to be fatal to its case. This is because enhanced distinctiveness is a relevant factor in the assessment before me. As evidence of use has been filed by the opponent, it is incumbent on me to factor it into my assessment of the overall distinctiveness of the earlier mark.

47. Whilst I bear in mind that the tests for enhanced distinctiveness and reputation are not the same, the same factors are relevant to both assessments. Consequently, for the reasons already given in my assessment of reputation, I find that the first earlier mark's distinctiveness has been enhanced to a medium to high degree through the use made of it.

Whether there is a likelihood of confusion

48. I have not yet conducted my full assessment under section 5(2)(b) of the Act and I will return to that issue later in this decision. However, the existence of a likelihood of confusion is one of the factors identified in *Intel* and must therefore be taken into account at this stage.

49. In considering this factor, I bear in mind that the assessment under section 5(3) is different from the assessment under section 5(2)(b). A finding that there is no likelihood of confusion for the purposes of section 5(2)(b) would not, of itself, preclude the public from making the necessary link under section 5(3). Equally, the existence of a reputation does not automatically mean that a likelihood of confusion arises.

50. The first earlier mark enjoys a moderate reputation in relation to *perfume* and I have found that its distinctive character has been enhanced through use to a medium to high degree. I have also found that a substantial proportion of the applicant's specification consists of goods which are identical or closely related to the goods for which that reputation exists. In particular, the applicant's specification includes perfumes, perfumery, toilet waters, essential oils, cosmetics, skin care preparations, soaps, deodorants, toiletries and other personal care products which consumers are accustomed to encountering under the same or economically linked brands.

51. Having considered the relevant factors, I do not find that there is a likelihood of confusion. Whilst the applicant's mark incorporates the earlier mark in its entirety, I have found that it will be perceived as the single word 'JOYPHORIA' which will be seen as a portmanteau of 'JOY' and 'EUPHORIA'. Although the marks are conceptually similar to a high degree, the applicant's mark creates a different overall impression. Consumers are likely to notice the differences and will not mistake one mark for the other. Nor do I consider that the applicant's mark would be perceived as a logical brand extension or sub-brand. However, I do not regard the absence of confusion as determinative. I am now required to determine whether the relevant public would bring the earlier mark to mind when confronted with the applicant's mark, thereby creating the necessary link.

Conclusions on link

52. Taking account of all the factors set out above, it is my view that, where 'JOY' enjoys a reputation for perfume and the applicant's mark combines the earlier mark with the element 'PHORIA', consumers are likely to be reminded of the earlier mark when encountering 'JOYPHORIA' on perfumes, cosmetics and related beauty products. I therefore consider that a link will be made in the mind of the relevant public in relation to the goods that I have found to be identical or similar, namely:

> Cosmetics, make up; non-medicated skin care preparations; lipsticks; lip gloss; make-up powder and foundation; skin moisturisers; beauty care cosmetics; body care preparations; essential oils for personal use; preparations for removing make-up; lotions, creams and conditioners for the face, hands and body; beauty masks; abrasive cloth; abrasive paper; abrasives preparations for the skin; adhesives for affixing false hair; adhesives for cosmetic purposes; after-shave lotions; almond milk for cosmetic purposes; almond oil for cosmetic purposes; almond soap for the skin; aloe vera preparations for cosmetic purposes; alum stones being astringents for cosmetic purposes; amber being perfume; antiperspirant soap; antiperspirants; aromatics being essential oils; astringents for cosmetic purposes; lip and body balms other than for medical purposes; bath salts, not for medical purposes; cosmetic preparations for baths; beard dyes; bergamot oil; bleaching preparations for cosmetic purposes; cakes of toilet soap; essential oils of cedarwood; essential oils of citron; cleansing milk for toilet purposes; hair colorants for toilet purposes; color-removing preparations being nail polish removers; cosmetic kits comprising of makeup; cosmetic kits comprising of skincare; cosmetic preparations for slimming purposes; cosmetics for animals; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; cosmetic creams; skin whitening creams; deodorant soap; deodorants for human beings or for animals; depilatories; depilatory preparations; douching preparations for personal sanitary or deodorant purposes; dry shampoos; cosmetic dyes;

eau de cologne; emery paper and cloth; ethereal essences; essential oils; ethereal oils; extracts of flowers being perfumes; eyebrow cosmetics; eyeshadow; eyebrow pencils; adhesives for affixing false eyelashes; cosmetic preparations for eyelashes; false eyelashes; adhesives for affixing false hair; false nails; essential oils being bases for flower perfumes; extracts of flowers being perfumes; soap for foot perspiration; greases for cosmetic purposes; hair colorants; hair dyes; hair lotions; hair spray; hair waving preparations; hydrogen peroxide for cosmetic purposes; incense; ionone being perfume; jasmine oil being an essential oil; javelle water being toilet water; petroleum jelly for cosmetic purposes; joss sticks; cosmetic kits featuring cosmetics; lavender oil being an essential oil; lavender water; essential oils of lemon; lotions for cosmetic purposes; tissues impregnated with cosmetic lotions; make-up preparations; make-up removing preparations; mascara; massage gels other than for medical purposes; cleansing milk for toilet purposes; mint essence being essential oils; mint oil being an essential oil; musk being perfume; moustache wax; nail art stickers; nail care preparations; nail polish; nail varnish; hair neutralizers for permanent waving; oils for cosmetic purposes; oils for perfumes and scents; oils for toilet purposes; cosmetic pencils; perfumery; perfumes; pomades for cosmetic purposes; make-up powder; pumice stone for personal use; rose oil being an essential oil; shampoos; shaving preparations; shaving soap; cosmetic preparations for skin care; skin soap; antiperspirant soap; cakes of skin soap; deodorant soap; sunscreen preparations; sun-tanning preparations; talcum powder, for toilet use; terpenes being essential oils; toilet water; toiletries, namely, face wash and body wash solutions; decorative transfers for cosmetic purposes; varnish-removing preparations; depilatory wax; haircare preparations.

53. Where the parties' goods are not similar, I consider the similarity between the marks is not sufficient to create a link. The greater the distance between the applicant's goods and those for which the opponent has a reputation, the less likely it is that the opponent's mark will be brought to mind. In those circumstances, even if the earlier mark came to the mind of the relevant public, it

would only be a fleeting link, of such kind not to give rise to any damage. As a result, the opposition under section 5(3) fails for the following goods:

> Breath freshening sprays; breath freshening strips; dental bleaching gels; denture polishes; and colour-brightening chemicals for household purposes.

Damage

Unfair advantage

54. Unfair advantage means that consumers are more likely to buy the goods of the applicant's mark than they would otherwise have been if they had not been reminded of the earlier mark. Unfair advantage can be taken of an earlier mark where there is no likelihood of confusion between it and the later mark. In these circumstances, the unfair advantage is usually the result of the transfer of the image of the earlier mark, or of the characteristics it projects, to the goods identified by the later mark: see *L'Oréal v Bellure*, paragraph 41.

55. 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."

56. I have found that the opponent's mark possesses a moderate reputation in relation to perfume and that its distinctive character has been enhanced through use. I have also found that, for a substantial proportion of the applicant's goods, the relevant public will establish a link between the marks and that the earlier mark will be brought to mind when consumers encounter the applicant's mark.

57. Whilst I have found that consumers would not assume that the goods originate from the same or economically linked undertakings, I still consider that the applicant's mark would benefit from the attractive force and recognition attached to the opponent's mark. The evidence presents JOY as a prestige fragrance. It is sold through luxury retailers such as Harrods at a comparatively high price point, and Mr Darolles describes it as belonging to the 'prestige category'. The mark has also received industry and consumer recognition through a number of fragrance awards, one of which was described as "the UK's biggest luxury consumer beauty awards". These are the characteristics and associations which consumers are likely to call to mind when encountering the applicant's mark.

58. In my view, there is a serious likelihood that the luxury and prestige image associated with the earlier mark would transfer to the applicant's goods. The applicant would thereby obtain a commercial benefit without paying financial compensation for the marketing effort expended in creating and maintaining the earlier mark's image. I therefore find a serious likelihood that use of the applicant's mark for the goods in respect of which I have found a link would take unfair advantage of the reputation of the earlier mark.

59. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the other types of damage pleaded by the opponent.

Due cause

60. In *Leidseplein Beheer BV v Red Bull*, Case C-65/12,[18] the CJEU confirmed that where the proprietor of the earlier mark has established one of the forms of injury referred to in section 5(3), the burden shifts to the third party using the later mark to establish that it has due cause for doing so.

61. Due cause was not pleaded in the applicant's counterstatement and, as a starting point, it is therefore unnecessary for me to consider it. In any event, even if the point had been properly pleaded, it would not assist the applicant. At the hearing, Mr Harris submitted that the applicant has due cause because 'JOYPHORIA' is a neologism. Whilst I accept that consumers are likely to perceive 'JOYPHORIA' as a coined word, that fact does not, without more, provide a justification for the unfair advantage obtained from the reputation of the earlier mark. No evidence has been filed explaining the commercial rationale for selecting the applicant's mark or otherwise establishing a legitimate basis capable of amounting to due cause. Accordingly, even if the point had been open to the applicant, due cause would not have been established.

Conclusion

62. The opposition under section 5(3) is partially successful. Having found the opposition successful under section 5(3) in respect of all goods other than *breath freshening sprays; breath freshening strips; dental bleaching gels; denture polishes;* and *colour-brightening chemicals for household purposes*, I will proceed to consider the opposition under section 5(2)(b) in relation to those remaining goods only.

Section 5(2)(b)

63. Section 5(2)(b) of the Act reads as follows:

[18] At paragraph 44.

"5(2) A trade mark shall not be registered if because –

(a)…

(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."

My approach

64. As previously stated, the opposition under section 5(3) has already succeeded in respect of all goods save for *breath freshening sprays; breath freshening strips; dental bleaching gels; denture polishes;* and *colour-brightening chemicals for household purposes*. It is only necessary for me to consider the section 5(2)(b) ground in relation to those goods.

65. For the purposes of that assessment, I will proceed on the basis of the opponent's second earlier mark only. This is because it is not subject to the proof of use provisions and benefits from a wider specification than the first earlier mark. Accordingly, it represents the opponent's strongest case.

Section 5(2) case law

66. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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

67. In *Canon*, Case C-39/97, 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 are complementary."

68. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

69. The goods to be compared are as follows:

Opponent's goods and services	Applicant's goods
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.	Class 3: Breath freshening sprays; breath freshening strips; dental bleaching gels; denture polishes; colour-brightening chemicals for household purposes.

70. I consider the applicant's *breath freshening sprays; breath freshening strips; dental bleaching gels* and *denture polishes* to be goods concerned with dental care and oral hygiene. Their primary purpose is to freshen the breath, whiten teeth or maintain dentures. Therefore, they differ from the opponent's *cosmetics* in nature, purpose and method of use. However, I acknowledge that the competing goods are similarly directed towards personal grooming and appearance. Whilst the goods may be sold through the same trade channels, I do not consider they would be sold on the same shelves. There is no competition nor any complementarity between the same. Overall, I find these goods to be similar to a low degree.

71. Turning to the applicant's *colour-brightening chemicals for household purposes,* these are household cleaning goods or laundry products for domestic use. Compared to the opponent's earlier goods, they differ in terms of nature, purpose and method of use. There is no competition between the goods, nor is there any complementarity. Whilst there may be a broad overlap in user and trade channels if the goods are all sold in supermarkets, I do not consider this to be sufficient to find the goods to be similar. Accordingly, I consider these goods to be dissimilar.

72. If there is no similarity between the goods, there can be no likelihood of confusion under section 5(2)(b): see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49. The opposition therefore fails under section 5(2)(b) with respect to *colour-brightening chemicals for household purposes.*

The average consumer and the purchasing act

73. As the case law above indicates, it is necessary to determine who the average consumer is for the goods at issue. I must then determine the manner in which the goods are likely to be selected by the average consumer.

74. 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.

75. In *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer’s level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

76. The average consumer for the goods at issue will be the general public. The goods are likely to be selected from physical retail premises, where they will be displayed and self-selected by consumers, or from online retailers, where they will be viewed on webpages. Consequently, the purchasing process will be predominantly visual in nature, although I do not discount an aural component arising, for example, through word-of-mouth recommendations.

77. 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.

Comparison of the marks

78. The respective trade marks are shown below:

The second earlier mark	The applicant's mark
	**JOYPHORIA**

Overall impression

79. The second earlier mark comprises the word 'JOY' presented in a gold rectangular background, surrounded by a thin gold border. As the eye is naturally

drawn to elements of the mark that can be read, I find the word 'JOY' plays the greater role in the overall impression with the background and border playing a lesser role.

80. The applicant's mark consists solely of the word 'JOYPHORIA'. Whilst I have already accepted that most consumers will perceive the mark as a portmanteau of the words 'JOY' and 'EUPHORIA', I consider that the overall impression of the mark resides in the single word created by the combination of those elements.

Visual comparison

81. Earlier in this decision I found the applicant's mark to be similar to the first earlier mark to a medium degree. The same reasoning applies to the comparison between the second earlier mark and the applicant's mark, although the gold background and border provide further points of difference. Consequently, I find the second earlier mark is similar to the applicant's mark to a low to medium degree.

Aural comparison

82. Previously in this decision I found the opponent's first earlier mark to be aurally similar to the applicant's mark to a low to medium degree. As the second earlier mark will also be pronounced 'JOY', I consider that this mark will also be similar to the applicant's mark to a low to medium degree.

Conceptual comparison

83. The background and border of the second earlier mark do not convey any conceptual message. This means that my findings in relation to the first earlier mark also apply to the second earlier mark. The marks are conceptually similar to a high degree.

Distinctive character of the earlier mark

84. 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)."

85. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use.

86. For the reasons already given under section 5(3), I consider that the second earlier mark possesses a low to medium degree of inherent distinctive character. The word 'JOY' is an ordinary dictionary word which alludes to a desirable

emotion that the goods may be intended to evoke and therefore possesses some laudatory connotations. I do not consider that the decorative elements materially increase the mark's inherent distinctiveness.

87. I have also considered whether the distinctive character of the second earlier mark has been enhanced through use. Although the opponent's evidence is capable of contributing to the distinctive character of the second earlier mark, that evidence relates principally to the use and reputation of the mark in relation to perfume. The goods which remain under consideration in these proceedings are different. In the absence of evidence demonstrating that the enhanced recognition enjoyed by the mark for perfume extends to the broader cosmetics and beauty goods relied upon under the second earlier mark, I am not prepared to find that the second earlier mark enjoys an enhanced degree of distinctive character for the purposes of the present comparison.

Likelihood of confusion

88. 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. 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 trade 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 marks, 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 trade marks and must instead rely upon the imperfect picture of them that he or she has retained in their mind.

89. I have found as follows:

- The goods are similar to a low degree.
- The average consumer will comprise members of the general public. Those consumers will pay a medium degree of attention during the purchasing process. I found that the purchasing process will be predominantly visual in nature, although I do not discount an aural aspect.
- The second earlier mark is visually similar to the applicant's mark to a low to medium degree and aurally similar to a low to medium degree. The second earlier mark is conceptually similar to the applicant's mark to a high degree.
- The second earlier mark possesses a low to medium degree of inherent distinctiveness in relation to cosmetics.

90. Taking all of the above factors into account, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other. The purchasing process will be predominantly visual and, when the marks are considered as wholes, the applicant's mark is noticeably longer than the second earlier mark. Although there is a high degree of conceptual similarity between 'JOY' and 'JOYPHORIA', the marks are visually and aurally similar only to a low to medium degree. Further, their conceptual similarity arises from the shared use of an ordinary word with laudatory connotations which, in the absence of enhanced distinctiveness for the goods now under consideration, is not particularly remarkable. Even allowing for imperfect recollection and the low degree of similarity between the goods, the differences between the marks are sufficient to enable the average consumer, paying a medium degree of attention, to distinguish between them. I do not find a likelihood of direct confusion.

91. I will now consider whether there is a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr 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)".

92. These examples are not exhaustive but provide helpful focus.

93. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

94. Reflecting upon my findings, I can identify no proper basis for concluding that the average consumer would believe the competing marks identify goods originating from the same or economically linked undertakings, particularly given the distance between the relevant goods. Whilst the marks share the word 'JOY', I have found that element to possess no more than a low to medium degree of distinctive character. Further, the applicant's mark will be perceived as the single word 'JOYPHORIA'.

95. Consequently, even allowing for imperfect recollection, I do not consider that the average consumer would conclude that the competing marks represent different product lines from the same undertaking or economically linked undertakings. Taking all of the relevant factors into account, I do not find there to be any likelihood of indirect confusion.

Conclusion

96. The section 5(2)(b) ground fails. For the avoidance of doubt, the first earlier mark would not have put the opponent in any stronger position under section 5(2)(b). This is because, whilst that mark benefits from enhanced distinctiveness for perfume, the distance between those goods and the goods considered under this ground would be sufficient to avoid a likelihood of confusion. I would therefore have reached the same conclusion in any event.

CONCLUSION

97. The opposition has partially succeeded under section 5(3) of the Act and failed under section 5(2)(b) of the Act. Subject to any appeal against this decision, the application will be refused for the following goods:

> Cosmetics, make up; non-medicated skin care preparations; lipsticks; lip gloss; make-up powder and foundation; skin moisturisers; beauty care cosmetics; body care preparations; essential oils for personal use; preparations for removing make-up; lotions, creams and conditioners for the face, hands and body; beauty masks; abrasive cloth; abrasive paper; abrasives preparations for the skin; adhesives for affixing false hair; adhesives for cosmetic purposes; after-shave lotions; almond milk for cosmetic purposes; almond oil for cosmetic purposes; almond soap for the skin; aloe vera preparations for cosmetic purposes; alum stones being astringents for cosmetic purposes; amber being perfume; antiperspirant soap; antiperspirants; aromatics being essential oils; astringents for cosmetic purposes; lip and body balms other than for medical purposes; bath salts, not for medical purposes; cosmetic preparations for baths; beard dyes; bergamot oil; bleaching preparations for cosmetic purposes; cakes of toilet soap; essential oils of cedarwood; essential oils of citron; cleansing milk for toilet purposes; hair colorants for toilet purposes; color-removing preparations being nail polish removers; cosmetic kits comprising of makeup; cosmetic kits comprising of skincare; cosmetic preparations for slimming purposes; cosmetics for animals; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; cosmetic creams; skin whitening creams; deodorant soap; deodorants for human beings or for animals; depilatories; depilatory preparations; douching preparations for personal sanitary or deodorant purposes; dry shampoos; cosmetic dyes; eau de cologne; emery paper and cloth; ethereal essences; essential oils; ethereal oils; extracts of flowers being perfumes; eyebrow cosmetics; eyeshadow; eyebrow pencils; adhesives for affixing false eyelashes; cosmetic preparations for eyelashes; false eyelashes; adhesives for affixing false hair; false nails; essential oils being bases for flower perfumes; extracts of flowers being perfumes; soap for foot perspiration; greases for cosmetic purposes; hair colorants; hair dyes; hair lotions; hair spray; hair

waving preparations; hydrogen peroxide for cosmetic purposes; incense; ionone being perfume; jasmine oil being an essential oil; javelle water being toilet water; petroleum jelly for cosmetic purposes; joss sticks; cosmetic kits featuring cosmetics; lavender oil being an essential oil; lavender water; essential oils of lemon; lotions for cosmetic purposes; tissues impregnated with cosmetic lotions; make-up preparations; make-up removing preparations; mascara; massage gels other than for medical purposes; cleansing milk for toilet purposes; mint essence being essential oils; mint oil being an essential oil; musk being perfume; moustache wax; nail art stickers; nail care preparations; nail polish; nail varnish; hair neutralizers for permanent waving; oils for cosmetic purposes; oils for perfumes and scents; oils for toilet purposes; cosmetic pencils; perfumery; perfumes; pomades for cosmetic purposes; make-up powder; pumice stone for personal use; rose oil being an essential oil; shampoos; shaving preparations; shaving soap; cosmetic preparations for skin care; skin soap; antiperspirant soap; cakes of skin soap; deodorant soap; sunscreen preparations; sun-tanning preparations; talcum powder, for toilet use; terpenes being essential oils; toilet water; toiletries, namely, face wash and body wash solutions; decorative transfers for cosmetic purposes; varnish-removing preparations; depilatory wax; haircare preparations.

98. Subject to any appeal against this decision, the applicant's mark may proceed to registration for the following goods:

Breath freshening sprays; breath freshening strips; dental bleaching gels; denture polishes; and colour-brightening chemicals for household purposes.

COSTS

99. Both parties have enjoyed a degree of success in these proceedings. However, the opponent has succeeded in relation to the majority of the goods at issue and is therefore the overall successful party. I consider it appropriate to award the

opponent a contribution towards its costs, reduced to reflect its partial success. Awards of costs in proceedings commenced before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award the opponent the sum of £1,900, calculated as follows:

Official fee:	£200
Preparing the statement of grounds and considering the counterstatement:	£300
Filing evidence and considering the other side's evidence:	£700
Preparing for and attending a hearing:	£700
Total:	**£1,900**

100. I therefore order Islestarr Holdings Limited to pay JEAN PATOU the sum of £1,900. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of October 2026

Catrin Williams
For the Registrar