

O/0618/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004022845
BY AGSHOPPING CREW LTD TO REGISTER:**

NJoyments

AS A TRADE MARK IN CLASS 3

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 448191 BY
JEAN PATOU**

BACKGROUND AND PLEADINGS

1. On 6 March 2024, AGShopping Crew LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published on 22 March 2024 and registration is sought for the following goods:

Class 3: Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils.

2. On 21 June 2024, the applicant’s mark was opposed by Jean Patou (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both grounds, the opponent relies on the following trade mark:

JOY

UK registration no. 910596047¹

Filing date 17 June 1997; registration date 16 February 1999

Seniority dates: 26 January 1953, 20 October 1965 and 4 December 1995 (all UK)

Relying on some goods only, namely:

Class 3: Perfumery; perfumery and beauty products, hair products, soap, perfume, eau de toilette, non-medicinal preparations and lotions for skin care, hair care products and lotions, cosmetics; deodorants for personal use.

(“the opponent’s mark”).

¹ The opponent’s 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.

3. The opponent's position under section 5(2)(b) is that the marks at issue are similar and that the goods are identical and/or highly similar. As such, it is claimed that there exists a likelihood of confusion on the part of the public, including a likelihood of association.
4. Turning to the section 5(3) ground, the opponent claims that its mark enjoys a reputation for the goods I have underlined above. The opponent claims that this reputation, together with the similarities of the marks and goods at issue will lead the relevant public into making a link. It is claimed that use of the applicant's mark, without due cause, would take unfair advantage of, or be detrimental to the repute and/or distinctive character of the opponent's mark.
5. The applicant filed a counterstatement wherein it denied all of the claims against it, though it did accept that there was possibly some conceptual similarity between the marks. In addition, it did acknowledge that there was reputation for perfume in respect of 'JOY by Jean Patou' and 'JOY by Dior', a point I will address in detail below. Lastly, the applicant sought to put the opponent to proof of use for its mark.
6. The applicant is unrepresented and the opponent is represented by Williams Powell. Both parties filed evidence in chief with the opponent also filing evidence in reply. No hearing was requested and while neither party filed written submissions in lieu of the same, they both filed submissions during the course of the proceedings. This decision is taken after careful consideration of the papers.
7. 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

8. The opponent's evidence in chief was provided in the form of the witness statement of Mr Lionel Darolles dated 20 November 2024. Mr Darolles is the Legal Manager of the opponent, a position he has held since 2018. His evidence is accompanied by 30 exhibits, being LD1 to LD30, and was adduced in order to prove that the opponent's mark has been genuinely used and that it enjoys a reputation. This evidence was accompanied by written submissions.
9. The applicant's evidence came in the form of the witness statement of Alin Alecu dated 3 February 2025. Mr Alecu is the Legal Director of the applicant, a post he has held since 2023. His statement is accompanied by three exhibits, being AA1 to AA3, and was adduced to discuss the reputation of the opponent and to introduce two previous decisions of this Tribunal wherein the opponent brought actions against third parties.² This evidence was accompanied by written submissions.
10. In reply, the opponent filed evidence in the form of the witness statement of Nicola Harrison dated 31 March 2025. Ms Harrison is an attorney at the opponent's representative firm. Her statement is accompanied by two exhibits, being NH1 and NH2, and was adduced in order to prove the existence of similarity between perfumes and essential oils. This evidence was accompanied by written submissions.
11. I do not intend to summarise the parties' evidence (or submissions, for that matter) 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.

² It is noted that the evidence pertaining to the reputation of the opponent's mark comes from a Google Trends printout. This is noted but has no real probative value as it is not confirmed what territory it relates to. As such, I have no way to determine how it can be said to relate to the present case.

PRELIMINARY ISSUES

12. Before continuing, I am of the view that there are a number of issues raised by the parties that warrant discussion as preliminary issues. These are set out below.

Lack of intention to use the applicant's mark on perfumery.

13. At paragraph 2 of the witness statement of Mr Alecu, he states that:

“My Company aims to use the trademark to build novel products which it intends to offer to customers on ecommerce platforms. Despite perfumery being one of the types of goods applied for, my company never had, does not at the moment, nor does it intend in the near or distant future to offer any perfumes to customers.”

14. In response to this point in its submissions, the opponent argued that in accordance with section 32(2) of the Act, an application must include a statement wherein an applicant confirms that they have a bona fide intention to use the mark. It is argued that because of the applicant's admissions, these goods should be deleted from the application on the basis that these goods were applied for in bad faith. While such an argument is suitable to a claim under bad faith in accordance with section 3(6) of the Act, that ground is not at issue in these proceedings. Therefore, these comments of the applicant have no impact on the assessments I must make under section 5(2)(b) and 5(3) of the Act. As a result, I will say no more about them.

Earlier decisions of the Tribunal and the EUIPO

15. In its notice of opposition, the opponent makes reference to a decision of the EUIPO dated 27 September 2019 wherein it found that the opponent enjoys a reputation and well-known character for 'JOY' in respect of perfumery and perfumes in the UK. In addition, the applicant has sought to introduce two decisions

of this Tribunal wherein the opponent failed in its oppositions against third parties which included grounds identical to those relied upon here. While all of these decisions are noted, they are not binding on me.

16. In respect of the EUIPO decision mentioned in the opponent's notice of opposition, I will say that the assessments I am required to make in the present proceedings are to be based on the evidence of use before me, not the previous decisions of the EUIPO. In any event, the EUIPO decision is one that was issued in 2019, being some four and a half years prior to the relevant date in these proceedings (6 March 2024, being the filing date of the application at issue). Therefore, even if the decision of the EUIPO was relevant, it would not be appropriate to adopt a finding from 2019 here. As for the previous decisions of this Tribunal, they relate to entirely different marks and have no bearing on the outcomes I am required to determine here.

17. As a result of the above, I will say no more about the additional decisions referred to by the parties.

DECISION

Proof of use

18. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

19. Section 6A is also relevant. It reads:

“(1) This section applies where:

(a) an application for registration of a trade mark has been published,

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20. Section 100 of the Act is also relevant. It reads:

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

21. As the opponent’s mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

22. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration process more than five years prior to the filing date of the applicant’s mark. As above, the applicant requested proof of use meaning that the opponent’s mark is subject to the use provisions.

23. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer*

Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

24. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 6 March 2024. The relevant period is, therefore, 7 March 2019 to 6 March 2024 ("the relevant period"). For the avoidance of doubt, the relevant territory for genuine use prior to 31 December 2020 ("IP Completion Day") includes the EU at large but, thereafter, it is the UK only.

25. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"³ because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

Evidence of use

26. The evidence covers use of the 'JOY' brand by two different undertakings. One being by the opponent itself prior to 2018 and the other being use by Parfums Christian Dior ("Dior") from 2018 onwards. It is explained in the evidence that Dior became a licensee of the JOY mark from the opponent on 24 July 2018.⁴ Given the relevant period, it is only the use by Dior that is relevant here. There are screenshots taken from Harrods's website showing how the 'JOY' brand was utilised by Dior.⁵ The first screenshot shown does not appear to be dated and the second screenshot shows a capture date of 11 October 2024. The narrative evidence confirms that they were taken in January 2021 and while this may be the case for the first screenshot, it is clearly not correct in respect of the second. Regardless, there is an article from The Times dated 6 December 2019 which shows a perfume bottle which is consistent with the aforementioned screenshots.⁶ For illustrative purposes, the product appears as follows:

³ *Jumpman* BL O/222/16

⁴ A copy of the agreement is provided at LD21

⁵ LD14

⁶ LD15



27. In respect of the awards stemming from use of 'JOY' by Dior, I note that in 2019, it was named a finalist in several categories, including Reader's Choice for Women (as voted for by readers of the Evening Standard), People's Choice – Women (as voted for by users of the retail website 'boots.com'), Best New Fragrance – Women and Ultimate Launch. It is confirmed that JOY won the latter award. Evidence in support of these nominations is provided in evidence.⁷ In addition, the JOY perfume won the Best New Women's Fragrance at the Style Beauty Awards in 2020, compiled by the Sunday Times.⁸ It is confirmed that this award was one that was voted by the public.

28. There is a screenshot provided taken from 'dior.com' showing the 'JOY' perfume.⁹ It shows a total of 25 reviews from customers across the UK. The screenshot is undated but the reviews are listed as being posted between '2 months ago' to '1 year ago'. While the screenshot is undated, I consider it likely that it was obtained around the time that the evidence was filed in November 2024. Therefore, any reviews from between '2 months ago' and '5 months ago' are likely to be from after the relevant period so are not relevant here. As for the ones posted '1 year ago', I

⁷ LD16

⁸ LD17

⁹ LD18

consider it likely that they were from the relevant period. However, of these there are only 10 reviews. While only 25 reviews are shown, there are a total of 107 reviews for this product. However, it is not clear how many of these reviews are from UK consumers or were posted during the relevant period. Therefore, I can only proceed in consideration of the 10 that are shown.

29. While on the topic of reviews, I note that one from 'chattychums.com' is provided.¹⁰ However, it is dated 14 September 2018 and is not, therefore, relevant to the present assessment.

30. The opponent has not provided any turnover for use made of JOY by Dior. It has, however, provided a number of invoices from the relevant period that the narrative evidence explains as covering the sale of perfumes, shower gels, body lotions and deodorant sprays to a number of well-known UK stockists such as Debenhams, Boots, The Perfume Shop, Selfridges and Harvey Nichols, amongst others. The invoices cover 47 pages of evidence but it is noted that each page includes 4 invoices (save for the last one, which only shows 2 invoices) condensed to fit on one. As such, there are a total of 186 invoices to consider.¹¹ The opponent has not provided any breakdown for the goods shown in the invoices. Put simply, I do not intend to go through the invoices and calculate each and every transaction in order to determine how many units were sold. To do so would result in me assisting the opponent by formulating the evidential picture on its behalf. This is not something I am willing to do as it is not only inappropriate in the circumstances but prejudicial to the applicant.¹² What I have done, however, is go through the invoices generally and I note that while there are sporadic appearances for shower gel and lotions, the invoices feature mainly perfumery goods, including those sold in higher quantities. That being said, it does not appear to me that the invoices cover a vast

¹⁰ LD19

¹¹ Counting the invoices in this way means that the totality of the opponent's evidence exceeds the prescribed 300-page limit set out in Tribunal Practice Notice 1/2015. The opponent did not seek permission to file evidence in excess. However, as this was not picked up by the Tribunal upon the filing of the evidence, I must consider it in full.

¹² Especially when considering that the burden of genuine use lies solely on the opponent.

volume of sales. Lastly, and for the avoidance of doubt, these entries include the word 'JOY' in their description columns.

31. In respect of advertising efforts, it is noted that the opponent has provided evidence of its advertising campaign that shows its adverts for 'JOY by Dior' displayed in various locations throughout the UK.¹³ This campaign includes images of banners displayed in shopping centres in Birmingham, London, Manchester and Bluewater. This evidence also includes images of adverts located on bus stops throughout London and Edinburgh as well as appearing in various locations (such as within the retailer Boots and in train stations) in Leeds, Edinburgh and Glasgow. As the only date referred to on this document is '4 March', it is not clear what year these advertisements ran. There is a subsequent document provided regarding a campaign that appears identical to the one referenced here which confirms that the campaign ran from 3 September to 23 September 2018, being prior to the relevant period.¹⁴ As such, I consider it reasonable to infer that any evidence pertaining to this campaign is from 2018 and is, therefore, not relevant to the present assessment.

32. In addition to the above, there are subsequent images of posters/adverts for the same campaign.¹⁵ All images are undated and the narrative evidence does not confirm when the photographs were taken so, to me, it appears likely that they are from prior to the relevant date. Also to this point, I note that evidence of a brief to 'Boots' is provided regarding this same campaign but, again, this is undated and refers to the new JOY perfume by Dior which, as above, was launched in 2018.¹⁶ Consistent with my findings above, I am not willing to infer that these campaigns ran during the relevant period.

¹³ LD24

¹⁴ LD24

¹⁵ LD27 to LD29

¹⁶ LD30

33. The above being said, there is another advertising campaign provided that is dated September 2019 that shows banners in Birmingham and Gateshead.¹⁷ While noted, this represents just one advertising campaign at the start of the relevant period.

Assessment of the evidence

34. Before assessing whether the use shown is sufficient, I will briefly touch upon the form of the mark. While the invoices use 'JOY' in a word only format, the perfume products covered by the evidence predominantly show use in the way I have reproduced at paragraph 26 above. The branding on the product is the word 'JOY' and within the letter O is the word 'DIOR'. In considering this example, it is clearly use of 'JOY' as part of a composite mark. While 'DIOR' is noted, I consider that 'JOY' continues to be perceived as an indicator of the origin of the goods at issue. In accordance with *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, this is use of a mark as registered and, as such, the opponent is permitted to rely on it.

35. Turning to the evidence, I am of the view that insofar as it relates to the relevant period, it is extremely limited. As set out above, the advertising campaign evidence mostly relates to activities from 2018, with only one campaign shown as being run in 2019. Further, there is no evidence as to the opponent's turnover or actual advertising spend during the relevant period. The only evidence I have in terms of actual sales is via 186 invoices. I set out above that I do not intend to calculate how many unit sales they demonstrate. However, that being said, the invoices do feature a consistent level of sales in respect of perfume goods, though I do appreciate that the unit sales shown are not particularly intensive. Further, the awards for 2019 and 2020, whilst not significant, do cover those voted on by the

¹⁷ LD26

general public so, clearly, there must have been some use at a reasonable scale during that time in order to warrant such awards.

36. Taking all of the evidence into account, while I remain critical of the opponent's approach to seeking to prove its use, I am willing to conclude that it has genuinely used its mark during the relevant period. That being said, given the significant focus on JOY being a perfume and the lack of any evidence supporting use for the other goods relied upon,¹⁸ I consider that the present opposition may only proceed in respect of the term "perfume".

Section 5(2)(b): legislation and case law

37. Section 5(2)(b) states that:

"(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 or association with the earlier trade mark."

38. Section 5A of the Act states as follows:

¹⁸ Again, I appreciate that other goods do feature in the invoices but these are sparing and no breakdown has been provided to assist me. Further, it is reasonable to expect more sufficiently solid evidence to be provided in order to support use for such goods.

“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.”

39. 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

40. The competing goods are as follows:

The opponent's goods	The applicant's goods
<u>Class 3</u> Perfume.	<u>Class 3</u> Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils.

41. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

42. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

43. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

Perfumery.

44. While worded slightly differently, the above term describes the same goods as the opponent’s “perfume”. As such, these goods are self-evidently identical.

Essential oils.

45. As set out above, the opponent has filed evidence (in the form of the EUIPO’s Similarity Tool and a decision of this Tribunal)¹⁹ attempting to demonstrate that the above goods are similar to the opponent’s “perfume”. This evidence is not binding on me but neither is it necessary because I consider that similarity between these goods can be reached without the need for evidence. As far as I understand the term, essential oils cover concentrated oils that contain the essence of a plant.

¹⁹ NH1 and NH2

They have a myriad of uses, one of which includes being used as a perfume wherein a user dilutes the oil and applies to their skin to give off a nice scent. In this context, I find that they are identical to the opponent's "perfumes" under the principle outlined in *Meric*. Failing that, the goods are similar to at least a medium degree on the basis that they overlap in method of use, purpose, trade channels and user. Further, in the context described above, there is a degree of competition between them.

Non-medicated cosmetics and toiletry preparations.

46. The above goods do not cover the opponent's "perfumes" so are not, therefore, identical. The natures of these goods differ but there is a slight overlap in method of use as all of the goods will be applied to the user's skin. In terms of purpose, the above goods will be to improve the look of the skin (for cosmetics) or to clean the skin (for toiletries) whereas the opponent's goods will be to improve scent. In terms of trade channels, I find that it is common in the trade for undertakings that produce and sell perfume to also produce and sell a range of cosmetic/toiletry goods. Therefore, I find that the trade channels for these goods overlap. In respect of user, this will also overlap because someone looking to buy perfume is likely to also buy cosmetics/toiletries. Lastly, I do not consider that the goods are complementary to one another and neither are they in competition. Overall, I find that these goods are similar to a medium degree.

Non-medicated dentifrices.

47. The above term covers goods such as toothpaste, tooth gel or tooth powder. They clearly differ in nature, method of use and purpose with the opponent's "perfume" goods. In addition, I see no reason why they would overlap in trade channels because whilst the goods may be sold via the same retailers, they would not be found in similar locations of stores or sections of websites. Further, undertakings that produce perfumes are unlikely to also produce dentifrices and I have no

evidence to suggest otherwise. The user overlaps because both terms will be sought by the general public at large. Lastly, the goods are not complementary and neither are they in competition. Overall, I do not consider that an overlap in user is sufficient by itself to give rise to any meaningful similarity between these goods. They are, therefore, dissimilar.

Conclusion of the goods comparison.

48. Under the present ground, a likelihood of confusion can only exist where there is at least some similarity between the parties' goods.²⁰ This means that as a result of my findings above, the present ground fails against "non-medicated dentifrices". It will, however, proceed in respect of all remaining goods.

The average consumer and the nature of the purchasing act

49. 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.

50. 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;

²⁰ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

(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.

51. The goods at issue will be selected by members of the general public at large. The goods will be available via general physical retailers where they will be placed on shelves and self-selected by the consumer. Alternatively, the goods will be available online where they will be viewed on webpages. As such, the purchasing process will be primarily visual, although I do not discount an aural component playing a part.

52. The goods at issue will range in price but are, for the most part, likely to be fairly inexpensive. As for the frequency at which the goods will be purchased, I am of the view that, for the most part, they will be selected on a regular basis. The average consumer is likely to consider factors such as ingredients, sustainability, whether they are fit for purpose and scent (for perfume or other goods that may be scented). These factors are fairly ordinary and I, therefore, find that the average consumer will pay a medium degree of attention during the selection process for the goods. For the avoidance of doubt, this finding applies even where the goods are of low cost on the basis that they are all to be used on the human body.

Comparison of the marks

53. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

54. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

55. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
JOY	NJoyments

57. I have submissions from the opponent regarding the similarity of the marks. While these are noted, I do not intend to reproduce them here but, for the avoidance of doubt, can confirm that I have given them due consideration.

Overall impression

58. The applicant's mark is a word only mark that consists solely of the word 'NJoyments'. The opponent argues that 'Joy' is the dominant, distinctive and memorable element of the applicant's mark and that the additional letters have no independent distinctive value. While 'Joy' does sit within 'NJoyments', the addition of the letters 'N' and 'm-e-n-t-s' either side of 'Joy' creates the impression of a single word and I see no reason why consumers would simply view the word 'Joy' as being a separate, dominant element of the applicant's mark. Such a finding would, in my view, be a result of an artificial dissection of the mark and, as above, this is not something consumers do. As a result, I disagree with the opponent's position and find that the overall impression of the applicant's mark lies in the word 'NJoyments' as a whole.

59. The opponent's mark is a word only mark that consists solely of the word 'JOY'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

Visual comparison

60. Visually, both marks include the letters 'JOY'. This forms the entirety of the opponent's mark and sits within the applicant's mark. The marks differ in the presence of the letter 'N' at the start of the applicant's mark and the letters 'm-e-n-t-s' after the shared 'Joy' element. While the shared letters will be noticed, they are subsumed in the body of the applicant's mark and, further, the points of difference outnumber the points of similarity. Overall, I consider that the marks are visually similar to between a low and medium degree.

Aural comparison

61. The opponent's mark is one syllable in length and will be pronounced in the ordinary way. The applicant's mark consists of three syllables and whilst it is spelt as 'NJoyments', it will be pronounced identical to the word 'enjoyments'. The second syllable of the applicant's mark is identical to the sole syllable of the opponent's mark whereas its first and third syllables have no counterparts in the opponent's mark. In considering the aural similarity, I remind myself that there is no special test which applies to the comparison of 'short' marks.²¹ However, I am of the view that in the present case, the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Overall, I consider that the marks are aurally similar to between a low and medium degree.

Conceptual comparison

62. In its counterstatement, the applicant conceded that there might possibly be some degree of conceptual similarity between the marks, though it did not specify to what degree.²² The concept of the opponent's mark clearly lies in the word 'JOY', which

²¹ See paragraph 44 of *BOSCO*, BL O/301/20

²² It was argued that this can be disregarded because of the lower degree of distinctiveness of the word 'JOY'

means ‘*a deep feeling or condition of happiness or contentment*’.²³ As for the applicant’s mark, being ‘NJoyments’, this would be plainly understood as a deliberate misspelling of, or a play on, the word ‘enjoyments’. ‘Enjoyments’ is the plural form of the word ‘enjoyment’ which means ‘*the act or condition of receiving pleasure from something*’.²⁴ That being said, the spelling of the applicant’s mark is unusual and, in my view, is a unique quirk that will be noticed by consumers when confronted with the mark (even though the conceptual meaning of the word will remain the same).

63. In comparing these marks, I do not consider that the concept of ‘enjoyments’ is identical to the concept of ‘joy’. That being said, I do appreciate that the meanings of the marks derive from the same conceptual source, being the feeling of joy. As a result, I find that the marks are conceptually similar to a high degree.

Distinctive character of the opponent’s mark

64. 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 <https://www.collinsdictionary.com/dictionary/english/joy>

²⁴ <https://www.collinsdictionary.com/dictionary/english/enjoyment>

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).”

65. 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 or services, 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, and I note that the opponent has filed evidence of use. I will, therefore, consider whether the opponent’s evidence is sufficient to give rise to a finding that the distinctiveness of its marks has been enhanced through use. Before doing so, I will consider the inherent position.

66. The opponent’s mark is the word ‘JOY’. As above, this will be understood as ‘a *deep feeling or condition of happiness or contentment*’. On perfume goods, this has a laudatory meaning on the basis that consumers will identify the idea that using the opponent’s perfume would bring them joy. While this is not so direct that it results in the opponent’s mark being outright low in distinctive character, it does mean that it sits towards the lower end of the scale. Ultimately, I find that the opponent’s mark is, inherently, distinctive to between a low and medium degree.

67. Before considering the issue of enhanced distinctiveness, I wish to discuss the fact that the applicant has conceded that there exists a reputation in ‘JOY by Patou’

prior to 2018 and 'JOY by Dior' from 2018 onwards. Firstly, I accept that the concession was made in respect of reputation and while the tests for reputation and enhanced distinctiveness are not the same, the factors are. As such, it is often the case that if there is a reputation, there is an enhanced distinctive character, and vice versa. As such, I am of the view that it is logical to proceed on the basis that the concession as to a reputation equally applies to the issue of enhanced distinctive character. Secondly, I appreciate that the argument was made on the basis that the reputation lay in those marks and not 'JOY' solus. However, I am of the view that if a reputation is conceded in 'JOY by Patou' and 'JOY by Dior', then it can equally apply to 'JOY' solus. I say this because use of the brands 'JOY by Patou' and 'JOY by Dior' will, in my view, still impart a reputation on 'JOY', solus. Therefore, I am of the view that this concession can be taken as being equally comparable to the opponent's mark.

68. In light of the above, I consider it reasonable to proceed on the basis that there does exist a degree of enhanced distinctive character. However, to determine to what degree, I must turn to the evidence.

69. I remind myself that the evidence from 2019 (and, to some extent, 2018) onwards has been summarised at paragraphs 26 to 33 above. In terms of the evidence prior to this, I note that the opponent confirms that the 'JOY' perfume was initially created in 1930. The narrative evidence makes a range of claims relating to the 'prestige' and 'desirability' of the brand as well as 'JOY' being a 'symbol of positivity'. It is also claimed that, over time, the 'JOY' perfume became the second best-selling perfume of all time. While this is noted, it is not particularly supported across the evidence as a whole. I say this because prior to 2013, no evidence of turnover is provided in order for me to accurately determine the scale of the brand historically. What is shown is that in 2013 and 2014, the opponent estimates (based on a percentage of its EU figures) that it sold €225,354 worth of JOY branded perfume in the UK. In addition, between 2015 and 2019, the opponent sold £171,036.16 worth of JOY branded perfume in the UK. Clearly, these figures represent a low

volume of sales when compared to the likely size of the perfume market at large.²⁵ On this point of the figures provided, it is noted that they are claimed to be wholesale figures and that the retail value would be much higher (typically four times as much). While this is noted, I do not consider this statement to be particularly concrete and, without anything sufficiently solid to guide me on exact figures, I am unable to determine what the retail value for these goods would actually be and I am not willing to speculate. In any event, even if I were to multiply these figures by the maximum amount stated in the narrative evidence, it would amount to approximately €900,000 for 2013 and 2014, and £684,000 for the years 2015 to 2018. Even then, the figures remain low.

70. There is a range of additional evidence from prior to 2018. While I can confirm I have given the evidence due consideration, I will only summarise it insofar as I deem it relevant to the present decision.

71. A number of articles are provided from 2013 to 2018,²⁶ as well as a range of perfumery books from 1983 to 2015,²⁷ all of which feature the JOY brand. Some of the publications shown include well-known publications such as 'you', 'Good Housekeeping', 'VOGUE' and 'GLAMOUR'.²⁸ For these articles, given the well-known nature of the publications, I can accept that they would have attracted a reasonable readership across the UK. However, there are a range of other articles that come from publications that I am not aware of, such as 'Fragrantia.com', Imperfkt and a range of perfume books by authors unknown to me. While I do not suggest that the publication or author must be known to me, I do consider it reasonable to suggest that it is for the opponent to provide information as to the readership of these publications or books. Without such, I am unable to determine

²⁵ I appreciate that I have no evidence of the size of the market but I consider it reasonable to find that it is likely to be a very large one with very high turnover and unit sales figures.

²⁶ See LD2, LD4 and LD5

²⁷ LD3

²⁸ These articles appear in LD5

their potential reach across the UK consumer base (being the relevant consumer base for this assessment).

72. In respect of its claim to global renown, the opponent has provided evidence of the 'JOY' perfume being inducted into the Fragrance Foundation's Hall of Fame in 1990.²⁹ The supporting evidence for this is a screenshot from 'fragrance.org' and there is nothing before me to suggest how well known this 'Hall of Fame' is across the UK consumer base. Further, the opponent's JOY perfume was named the 'Scent of the Century' at the UK FIFI awards in 2000. There is no direct evidence of the award but the opponent has sought to support it by including a third-party source, being a screenshot of the website 'Highbeam Business'.³⁰ The top article shown does make reference to the award but it does not specify which publication it came from. As such, I have no way of determining how (if at all) the knowledge of this award spread across the UK consumer base and, without such, it is not possible for me to determine whether consumers would have been aware of this award. There are other articles cited in this screenshot but they do not appear to cover the award. For example, the first article is from the South Wales Echo (a UK publication) but discusses someone named Walker 'jumping for joy' after a record run. In addition, this same exhibit includes printouts of the 'Jean Patou' entry on the Fashion Encyclopedia, the Wikipedia entry for Jean Patou, an article from 'Scentury' and an article from 'eatlovesavour.com'. Firstly, online encyclopedias are capable of being edited by anyone who visits them and, as such, they are not particularly reliable from an evidential standpoint. Even ignoring that point, there is nothing to suggest the UK readership for such entries. The same point regarding the lack of any UK readership figures for the other publications, being from 'Scentury' and 'eatlovesavour', also applies.

73. In terms of its claims to advertise, the opponent has provided a number of invoices for tester display units, gift boxes, gift bags and business cards together with an

²⁹ LD6

³⁰ LD7

illustration used of the gift boxes/bags.³¹ While noted, there is nothing to suggest the actual reach of the items covered by the invoices. For example, there is nothing before me to demonstrate the spread of the display units across the UK and neither is there anything to suggest that the business cards ordered generated any actual sales. There is also some social media evidence provided but this is of no real assistance.³² I say this because the first range of screenshots shown are from the 'Jean Patou' profile and the posts shown have very low levels of engagement. Further, this evidence also includes a number of third-party retweets, but it is not clear where the party who posted about the 'JOY' perfume was based and what their reach across the UK. In any event, these posts all show very low levels of engagement. A number of screenshots from the opponent's website (taken in December 2015) are provided and while these are noted, they come from the opponent's '.com' website. It is therefore not possible for me to determine whether they were targeted at the UK consumer. Even if they were, they are merely screenshots showing descriptions of the perfume products offered and provide no information as to sales or anything upon which I can determine that there has been an enhancing of the distinctive character of the mark.

74. Taking all of the above into account, whilst I have my issues with the evidence, the concession of the applicant is such that I consider it appropriate to proceed on the basis that there exists some degree of enhanced distinctive character. That being said, the evidence, even at its best case, is not reflective of a high level of use. I do not doubt the opponent's narrative evidence and accept that, at some point from 1930 onwards, the opponent's perfume became the second highest selling perfume of all time. However, I have nothing to suggest when this was or whether it was still the case as at the relevant date. On this point, I note that the evidence of sales from 2013 to 2018 is very limited. Further, there is nothing sufficiently solid from 2019 onwards that allows me to determine the level of use for 2019 to 2024. This means that in the 11 years prior to the relevant date, the evidence reflects a

³¹ LD8

³² LD9

low level of use so does not support the narrative that 'JOY' was a high selling perfume at that time. As I have discussed above, the supporting evidence regarding advertising or press coverage is not particularly compelling to the point that I can say that the opponent's mark has been enhanced to a high degree, especially given its relatively weak inherent distinctiveness. Therefore, I am only content to conclude that the opponent's mark's distinctiveness has been enhanced from between a low and medium degree to a medium degree.

Likelihood of confusion

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

76. I found the goods at issue to be either identical or similar to a medium degree. The average consumer base for the goods at issue will be members of the general public who will select the goods via primarily visual means (though I do not discount an aural component) whilst paying a medium degree of attention. I have found the marks at issue are visually and aurally similar to between a low and medium degree

and conceptually similar to a high degree. Lastly, I concluded that the opponent's mark enjoys between a low and medium degree of inherent distinctive character but that this has been enhanced to a medium degree.

77. When discussing the issue of a likelihood of confusion in its notice of opposition, the opponent sets out that:

"The dominant, distinctive and memorable element of the Applicant's mark is JOY, which is identical to the Opponent's Marks. The similarity and conceptual identity mean that the additional letters have no independent distinctive value and can therefore be seen to identify that the Applicant's goods are a spin-off or associated products from the Opponent's Mark."

78. In its submissions filed during the evidence rounds, the opponent's case in respect of confusion is that:

"11. [...] The Opponent has not asserted that the Applicant's Mark will be seen as a "spin-off" based purely on appearance. The Opponent has asserted that because of the visual, aural and conceptual similarity of the marks, in addition to the identity and similarity of the goods, there will be a resultant likelihood of confusion, whereby consumers will believe there is an economic link between the parties."

79. And that:

"12. [...] As a result of the clear similarity of marks, and the identity and similarity of the Applicant's Goods with the Opponent's Goods and Services, there is a clear likelihood of confusion on the part of the relevant public."

80. In its submissions in lieu of a hearing, the opponent did not really expand upon its case for confusion. It did, however, raise the point that it needed only to prove a likelihood of confusion, not actual confusion, which is correct.

81. Taking all of the above factors into account, I do not consider that the marks at issue will be misremembered or inaccurately recalled for one another. Whilst the shared use of the letters 'JOY' letters is noted, this is not, as the opponent claims, the dominant element of the applicant's mark to the point that the letters 'N' and 'm-e-n-t-s' would have no independent distinctive value. Instead, the common element is subsumed into the body of a different word in the applicant's mark. While I appreciate that there is a high degree of conceptual similarity between 'JOY' and 'NJoyments', the marks are visually and aurally similar to between a low and medium degree. This, in my view, offsets the higher degree of conceptual similarity. Further, the conceptual similarity derives from a connection to a laudatory word so its shared use is not particularly remarkable. As such, I see no reason why a consumer would inaccurately recall one party's mark for the other. Put simply, consumers would not seek to pin their recollection of the applicant's mark on the shared use of the word 'Joy' but, instead, would simply recall it in full, as 'NJoyments'. Consequently, I do not consider that there exists a likelihood of direct confusion, even where the marks are viewed on identical goods.

82. I will now proceed to consider indirect confusion. In doing so, I remind myself 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)".

83. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

84. 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.

85. As set out above, the opponent initially pleaded that the applicant’s mark would be viewed as a spin-off of the opponent’s brand. However, in its submissions, it said that it would not be viewed in this way. It is unclear whether this is a typographical error and despite having the chance to further its position in its submissions in lieu of a hearing, it did not do so. However, for the purpose of these proceedings, I will assume that the submissions included an error and that the opponent’s position remains that there is a likelihood of indirect confusion because the applicant’s mark will be viewed as a spin-off. To me, this is the only argument that the opponent has actually raised that would constitute a ‘proper basis’ for indirect confusion in light of there being no direct confusion.

86. Taking all of the above into account, I do not consider that consumers would consider ‘NJoyments’ to be a spin-off of ‘JOY’. While the opponent’s mark sits wholly within the applicant’s mark, the indicator of origin of the applicant’s mark vests in that mark as a whole. As above, this would be seen as a deliberate misspelling of, or a play on, the word ‘enjoyments’. The shared use of ‘Joy’ across the marks would not be seen as a shared indicator of origin but, instead, a laudatory connection to the goods at issue bringing the user a sense of joy. I say this even despite the enhancing of the distinctive character of the opponent’s mark. As such, the shared connection to this would be viewed as coincidental as opposed to leading to a belief that the marks shared the same (or economically linked) undertaking.

87. Further to the above, I do not consider that the points of difference, being the addition of a letter 'N' before 'Joy' and the letters 'm-e-n-t-s' after it constitute additional elements that consumers would believe to be logical indicators of a brand extension of sub-brand (being what I consider the opponent means by reference to a 'spin-off'). Put simply, I see no reason why a brand using the 'JOY' mark would add the letters 'N' and 'm-e-n-t-s' either side of it to create a different word to indicate a sub brand or brand extension. On this point, I appreciate that the conceptual meanings of the marks at issue are highly similar but other than a connection to a laudatory word, there is nothing to suggest what the 'spin-off' brand would cover. Consequently, I do not consider that there exists a likelihood of confusion, even bearing in mind that the marks will be viewed on some goods that are identical.

Final remarks under section 5(2)(b)

88. For the avoidance of doubt, even if it was the case that the evidence of the opponent warranted a finding that its mark enjoyed a high degree of distinctive character, I do not consider that it would alter the findings made above. Even at a higher end of the scale, the distinctiveness of 'JOY' is not so striking (given its inherent laudatory nature) that consumers would believe that only one undertaking would use it, especially given the fact it is subsumed into the body of a different word. Further, the position remains that the additional elements of the applicant's mark do not indicate a sub-brand or brand extension. Therefore, I find there exists no direct or indirect confusion between the marks even where the opponent's mark enjoys a high degree of enhanced distinctive character.

89. The section 5(2)(b) ground fails and I will now proceed to consider the section 5(3) ground.

Section 5(3)

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

“5(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

91. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, 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'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder 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*).

92. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks at issue are 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 pleaded 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.

93. Under the present ground, the opponent relies on the term "perfume, eau de toilette" only. As genuine use is equally applicable to section 5(3) grounds as it is to 5(2)(b), I will proceed on the basis that I have above in that the present ground is only able to proceed in respect of "perfume".

Reputation

94. I can deal with the issue of reputation swiftly. This is on the basis that, as set out above, the applicant has conceded that there exists a reputation in 'JOY by Patou' prior to 2018 and 'JOY by Dior' thereafter in respect of "perfumes". For the same reasons given when considering an enhanced distinctive character above, I consider that this concession can be deemed as being applicable to 'JOY' solus. In terms of the level of reputation, I again refer to the comments made when considering enhanced distinctiveness above in that the evidence is not particularly compelling and, in my view, is only sufficient to demonstrate a reputation of moderate strength.

Link

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

The degree of similarity between the conflicting marks.

96. The marks are visually and aurally similar to between a low and medium degree and are conceptually similar to a high degree.

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.

97. The comparison of the goods I conducted under the section 5(2)(b) ground above was based solely on the opponent's "perfume" term. As such, those findings apply here. This means that the "perfumery, essential oils" are identical to the opponent's reputed goods, with "non-medicated cosmetics and toiletry preparations" being

similar to a medium degree and, lastly, “non-medicated dentifrices” being dissimilar. In respect of the dissimilar goods, I find that they will be selected by the same relevant section of the public as the opponent’s reputed goods and, therefore, have a degree of closeness.

The strength of the earlier mark’s reputation

98. The opponent’s mark enjoys a moderate reputation.

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

99. The opponent’s mark is inherently distinctive to between a low and medium degree. However, this has been enhanced to a medium degree.

Whether there is a likelihood of confusion

100. I have found there to be no likelihood of confusion between the marks.

Conclusion on link

101. I appreciate that the requirement for a link under the present ground is less onerous than the assessment for a likelihood of confusion. However, this does not automatically mean that there exists a link between the marks at issue just because the earlier mark enjoys a reputation. I must, instead, take all of the relevant factors into account.

102. Taking all of the above into account, I do not consider that the reputation of the opponent’s mark is at a sufficient degree to lead the relevant public into believing that there is a link between the marks. I say this because whilst the goods at issue are identical, similar or share a degree of closeness, the marks are not at a similar

enough degree to result in consumers believing them to be linked. Even bearing in mind the shared conceptual hook, it would not result in a member of the relevant public (who is aware of the opponent's mark) viewing the applicant's mark as being one that is linked to the 'JOY' brand or one that brings the 'JOY' brand to mind. I say this because while the applicant's mark includes the letters 'JOY', it adds additional letters to form its own uniquely spelt and slightly quirky word, separate from 'JOY' (albeit still having a similar meaning). Bearing in mind the overall differences between the marks, I do not consider that members of the relevant public would view any use of 'JOY' as part of a different composite word as being connected to the opponent. As a result, I find that there exists no link. Even if there were, it would only be fleeting and insufficient to give rise to any damage.

Final remarks under section 5(3)

103. Similarly to my conclusion under the section 5(2)(b) ground, I consider it necessary to point out that, for the avoidance of doubt, even if it was the case that the opponent's mark enjoyed a strong reputation (or a high degree of enhanced distinctive character, for that matter), I do not consider that it would alter the findings made above. Even with a stronger reputation, the visual and aural differences between the marks would prevent consumers from believing that the marks were linked. Even with a shared conceptual hook, the connection to 'JOY' as an inherently laudatory phrase in respect of perfumes is such that it would prevent consumers from being caused to wonder whether 'NJoyments' was connected to 'JOY'. As a result, I find that the present ground would have failed even if it were the case that the opponent's mark's reputation was strong.

104. The section 5(3) ground fails.

CONCLUSION

105. The opposition fails and, subject to any successful appeal against my decision, the applicant's mark may proceed to registration for all of the goods applied for.

COSTS

106. The applicant has succeeded in defending the application in its entirety. The applicant would, therefore, in the ordinary course of these proceedings, be entitled to a contribution towards its costs. However, the applicant is unrepresented meaning that, in order to claim its costs, it was required to file a completed costs pro-forma. It did not do so. On this point, I note that a blank costs pro-forma was provided to the opponent under the cover of a letter from the Tribunal dated 18 May 2025. This letter set out that:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

107. As no costs pro-forma was filed and the applicant incurred no official fees arising from this action, I make no order as to costs. Therefore, both parties are to bear their own costs of these proceedings.

Dated this 17th day of July 2026

A COOPER

For the Registrar