

O-096-05

**TRADE MARKS ACT 1994
and
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF DESIGNATION NO 776555 IN THE NAME OF
INLINE UNTERNEHMENSBERATUNG FUR FREIZEITANLAGEN GMBH**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 71042 IN THE NAME OF
THE PROCTOR & GAMBLE COMPANY**

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The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF Designation No 776555
in the name of Inline Unternehmensberatung fur Freizeitanlagen GmbH**

And

**IN THE MATTER OF Opposition thereto under No 71042
in the name of The Proctor & Gamble Company**

Background

1. On 6 November 2001, Inline Unternehmensberatung fur Freizeitanlagen GmbH sought under the Madrid Protocol to extend protection for their registered trade mark INJOY to the United Kingdom for the following specification of goods and services:

- Class 03:** Cosmetics.
- Class 25:** Clothing, footwear, headgear.
- Class 28:** Gymnastic and sporting articles (included in this class); hand operated implements for fitness, building of muscles, cardio-implements.
- Class 32:** Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
- Class 35:** Advertising; business management; business administration.
- Class 42:** Hygienic and beauty care.

2. On 12 September 2003, The Proctor & Gamble Company filed notice of opposition against Classes 3, 25 and 42 of this designation, the grounds being in summary:

Under Section 5(2)(b) because they have made extensive use of the trade mark JOY in relation to perfumery products and related goods and have established a substantial goodwill and reputation in the name. The designation is in respect of a similar mark and is sought to be registered in respect of goods that are either identical or similar to the opponents-earlier marks such that there exists a likelihood of confusion.

3. Details of the earlier marks relied upon by the opponents can be found as an annex to this decision.

4. The applicants filed a Counterstatement in which they deny the ground on which the opposition is based.
5. Both sides request that costs be awarded in their favour.
6. Both sides filed evidence in these proceedings. Neither took up the offer of an oral hearing electing to file written submissions. After a careful study of the papers and the written arguments I now go on to give my decision in these proceedings.

Opponents= evidence

7. This consists of a Witness Statement dated 17 March 2004, from Robert Kunze-Concewitz, Marketing Director of The Proctor & Gamble Company. Mr Kunze-Concewitz says that in his capacity as Global Marketing Director Jean Patou Fine Fragrances he is responsible for the sale and marketing of the perfume Jean Patou Perfume JOY in the United Kingdom, and that the information contained in his statement comes from either his own knowledge, or information available to him from the records of the company.

8. Mr Kunze-Concewitz confirms that Jean Patou launched the JOY perfume in the United States and France in 1930, and that it has been available in the UK since that date although he does not say how this was the case. He says the perfume is world-renowned and has the reputation of being the worlds most expensive. Exhibit A consists of a brief history of the perfume extracted from the website of Fascination Perfumery on 8 March 2004. Apart from showing the website to be owned by a company in Lancashire there is nothing to link the use of JOY in respect of the UK at any time prior to the relevant date. Exhibit B consists of a table showing sales figures, inter alia, for JOY and another product sold under the name ENJOY in 2003, which is after the relevant date. Mr Kunze-Concewitz gives details of the opponents' advertising spend on promoting JOY in the period January to December 2003, again after the relevant date. Exhibit C is said to be a sample of the advertising material used in this period.

9. Mr Kunze-Concewitz states that the JOY perfume and its range of derived toiletries are available throughout the UK through a number of retailers, details of which he gives as Exhibit D. The Exhibit consists of a list of retailers and the towns and cities in which they operate. There is no indication of when the list was compiled or the dates from which these retailers have been stocking JOY products. Exhibits E, F and G consist of images of packaging for JOY perfume that Mr Kunze-Concewitz says has been used since September 2002 and 1950 to September 2002 respectively. All show the word JOY prominently on perfume in a vapouriser bottle, and the packaging for the bottle, in all cases placed above the words Jean Patou. Only Exhibit F pre-dates the relevant date

10. Mr Kunze-Concewitz says that in his experience in the perfumery trade it is extremely common for brand extension, listing various examples in relation to fragrance products and clothing. He says that given this, the opponents' extension from JOY to ENJOY and their considerable reputation in the JOY fragrance, the public would assume INJOY was another fragrance in the JOY range. He says that confusion is more likely because of the way that perfume products, particularly expensive ranges are purchased, being commonly displayed

behind counters and only available on request. Mr Kunze-Concewitz states that fragrance products are often bought as presents by third parties who are more likely to mis-remember or confuse JOY, ENJOY and INJOY.

Applicants' evidence

11. This consists of a Witness Statement from David Cedric Franklyn Gilmour, a partner in Potts Kerr & Co, the applicants' representatives in these proceedings.

12. Mr Gilmour confirms that his company is authorised to act for the applicants, and refers to Exhibit DG1, which he says consists of details of the applicants' business, which appears to be in health and fitness. There is nothing that shows they have any interests in the UK. The pages show the word INJOY with the letters "IN" depicted in a bolder text than JOY, apparently highlighting the traders use of INLINE as a business name, this name also often being used with the letters IN separated from LINE.

Opponents' evidence in reply

13. This consists of a Witness Statement dated 20 September 2004, from Angela Clare Thornton-Jackson, a trade mark attorney with D Young & Co, the opponents' representatives in these proceedings.

14. Ms Thornton-Jackson refers to the evidence filed by the applicants, noting that it relates to the promotion of fitness clubs in Germany and provides no information relating to use of the mark applied for in the UK.

Applicants' further evidence

15. This consists of a Witness Statement dated 3 September 2004, from David Cedric Franklyn Gilmour.

16. Mr Gilmour refers to Exhibit DG1 to his previous Witness Statement, saying that the applicants' company was previously known as Inline Unternehmensberatung fur Friezeitanlagen GmbH, Exhibit DG2 consisting of a copy of the Companies Register. He goes on to say that INJOY Quality Cooperation GmbH has been an exclusive licensee of the trade mark INJOY. Exhibit DG3 consists of a further extract from the Companies Register, Mr Gilmour highlighting that the two companies have the same Director and business addresses.

17. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

18. The opposition is under Section 5(2)(b). That section reads as follows:

“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.”

19. An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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”.

20. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki*

Kaisha v Metro-Goldwyn-Mayer Inc,

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

21. Whilst the above guidance indicates that marks should be compared as a whole, in any comparison it is inevitable that reference will be made to the individual elements of which marks are composed in order to determine their relative dominance and contribution to the distinctiveness of the marks as a whole.

22. The opponents rely on eight earlier marks. Four of these are for the mark JOY, a word that is wholly contained within the word INJOY, so if only to that extent there is a visual similarity with the opponents' earlier trade marks. The "IN" syllable is comparatively soft in its pronunciation, with most emphasis being on JOY, making the marks sound similar when spoken. The word INJOY could be seen as a combination of the words "IN" and "JOY" but this is not a meaningful combination. If anything, I consider it more likely that the word will be regarded as a miss-spelling or phonetic variant of "ENJOY", an ordinary English word meaning, inter alia, "to receive with pleasure from; take joy in." As can be seen from this definition, "JOY" is also an ordinary English word, having the meanings, inter alia, "a deep feeling or condition of happiness or contentment; something causing such feeling; an outward show of pleasure or delight-rejoicing". It is apparent from these meanings that the conceptual message sent to the consumer by INJOY and JOY is likely to be very much the same. I do not see that there is an element in the word INJOY that stands out as being any more dominant or distinctive than any other.

23. The remaining marks relied upon by the opponents are for the mark COLLECTION JOY JEAN PATOU. Whilst the word JOY is an element, it is somewhat lost in the totality to the extent that I would say that these marks are not visually, aurally or conceptually similar to the mark for which registration is sought.

24. Turning first to the opponents earlier marks for the word JOY. All four are registered for goods in Class 3, two, Nos. 2047390 and CTM 570341 specifically listing “cosmetics” so in respect of Class 3 of the designation there are identical goods involved. None of the respective specifications are limited in any way that would separate them so in these classes the identity extends to the market, from manufacture to retailer, and also the end consumer.

25. In determining the question of whether goods in Class 3 would be regarded as being similar to the goods and services of Classes 25 and 42 of the designation I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. With this case in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used;
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the 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.

26. Quite clearly, cosmetics, toiletries etc, and clothing are different in nature, and also the uses to which they are put. I see no reason why they should not have the same end-user; both types of goods are used by men and women, although I accept that such goods can be gender specific. I do not see that they can be regarded as being competitive; you would hardly wear a fragrance in place of clothing. I can see an argument for considering cosmetics/fragrances and clothing to be complementary; for example, contributing to the synergy of dressing up for a night out or special occasion. I have no specific evidence but it seems to me that in the general trade such goods come from different and distinct market sectors.

27. Mr Kunze-Concewitz says that in the perfumery trade it is not uncommon for brand extension into clothing, although apart from mentioning some names he provides no evidence in support. I am aware that brand extension does happen in the designer end of the fragrance market, where an established name may extend into other areas, and not uncommonly, clothing. That said, I am not convinced that this is as commonplace as Mr Kunze-Concewitz claims.

28. Whilst the word JOY could be regarded by some as a laudatory exhortation relevant to a perfume or indeed any other product or service, it is somewhat allusive referring more to a potential effect resulting from the use rather than a characteristic of the goods themselves. In my opinion it is a distinctive mark in relation to the goods for which it is registered. The evidence shows the mark to have been used in relation to perfumery products, although there

is an almost complete absence of the facts necessary to assess the likely reputation established through use. At its best the claim rests on the JOY perfume being world famous, in particular for having the reputation as the most expensive. Apart from this there is no evidence that prior to the relevant date the opponents ever sought, let alone actually did extend the use of their JOY trade mark beyond perfumery products.

29. Mr Kunze-Concewitz says that perfume products, particularly expensive ranges are commonly displayed behind counters and only available on request. Clothing on the other hand is usually displayed in racks for self-selection. Both products may be found in some retail outlets, particularly department stores, supermarkets and the like, but in distinct areas. I would say that taking all factors into account, cosmetics and clothing should not to be regarded as similar goods.

30. The specification in Class 42 of the designation covers hygienic and beauty care services, which are self-evidently different in nature to cosmetics, toiletries, etc. I see no reason why the end users of the respective goods and services would be different. The user will go to the service provider for the beauty treatment which may well include the application of cosmetic products, whereas having purchased such goods the consumer will apply the product themselves. These goods and services are not strictly in competition; the consumer primarily uses the service for the skill and knowledge of the beautician or hygienist rather than as an alternative to purchasing and applying the goods themselves; they are, if anything, complementary. I have no evidence to assist me, but in general I would say that the providers of beauty services do not also trade in cosmetic and toiletry products; these are separate markets. Whilst cosmetic and toiletry products may be found in beauty salons and the like, the two generally reach the consumer by different trade channels and obtained by different means. On my assessment, the provision of hygienic and beauty care services are not similar to goods found in Class 3.

31. The opponents' earlier registrations for COLLECTION JOY JEAN PATOU are registered in a number of classes. One is in Class 9 in respect of eyewear and part for such goods. I see these goods as being very different in nature, purpose, channels of trade and market to the goods and services of Classes 3, 25 and 42 of the designation. Another, in Class 18 covers, inter alia, purses, handbags and the like, which although seemingly different in nature and purpose to clothing, are very much fashion accessories that complement clothing, and accordingly, should be regarded as similar goods to Class 25 of the designation, but not Classes 3 or 42. A third registration is in Class 24, which, apart from being textile goods are different in nature, purpose, channels of trade and market to the goods and services of the designation. The final earlier mark is registered in Class 25 in respect of clothing, and self-evidently, identical goods to Class 25 of the designation. But for the reasons I have already given, I do not consider such goods to be similar to the goods of Class 3 of the designation, nor can I see that this would be the case in respect of the services set out in Class 42.

32. Taking all of the factors into account and adopting the "global" approach advocated, I come to the position that in relation to the opponents' earlier marks, should the mark INJOY be used in relation to goods in Class 3, there is a likelihood of confusion, particularly bearing in mind the potential for imperfect recollection. In relation to the remaining classes of the designation I consider the differences to be such that the consumer to be unlikely to wrongly

believe that the respective goods and services come from the opponents or some economically linked undertaking.

33. If the applicants file a Form TM21 within one month from the end of the appeal period requesting the deletion of all goods listed in Class 3 of the designation, I will, in the event of no appeal, allow this designation to proceed to registration. If the applicants fail to file a TM21 within one month from the end of the appeal period the designation will be refused.

34. The opposition having been successful, albeit only in part, the opponents are entitled to an award of costs. I order the applicants to pay the opponents the sum of , 750 as a contribution towards their costs. This sum reflects the fact that the opposition may have been successful, but only in relation to one class of the designation. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of April 2005

**Mike Foley
for the Registrar
the Comptroller General**