

O/1061/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003686975
BY GUANGZHOU ZHONGSHANG DAILY CHEMICALS CO., LTD
TO REGISTER THE TRADE MARK:**

BODY IN JOY

IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 428121 BY
JEAN PATOU**

BACKGROUND AND PLEADINGS

1. On 27 August 2021, Guangzhou Zhongshang Daily Chemicals Co., LTD (“the applicant”) applied for the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 24 September 2021 and registration is sought for the following goods:

Class 3 Beauty masks; Hair dyes; Essential oils; Make-up; Shampoos; Hair conditioners; Body glitter; Lipsticks; Cosmetics; Perfumes.

2. On 10 November 2021, the application was opposed by Jean Patou (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), the opponent relies on the following trade marks:

JOY

UKTM no. 714290

Filing date 26 January 1953; registration date 26 January 1953

Relying on some goods for which the mark is registered, namely:

Class 3 Perfumes.

(“the First Earlier Mark”)



UKTM no. 917895714

Filing date 4 May 2018; registration date 19 March 2019

Relying on all goods for which the mark is registered, namely:

Class 3 Perfume; Eau de parfum; Toilet water; Cologne; Cosmetic creams; Body gels; Oils for cosmetic purposes; Beauty milk; Beauty lotions; Personal deodorants; Cosmetic masks;

Cosmetics; Hair lotion; Make-up preparations; Cleansing milks and Make-up removing lotions; Shaving soap; Aftershave lotions and balms.

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

("the Second Earlier Mark")

3. The opponent claims that the marks are similar and the goods are identical or similar, with the result that there is a likelihood of confusion.

4. Under section 5(3) of the Act, the opponent relies upon the First Earlier Mark only. The opponent claims that it has a reputation for "perfumes" and that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or repute of the First Earlier Mark.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. The applicant is represented by Vicky Zhang and the opponent is represented by Williams Powell.

7. Only the opponent filed evidence. Neither party requested a hearing, and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief consisting of:

- a) The witness statement of Lionel Darolles dated 28 November 2022, which is accompanied by 20 exhibits (LD1 to LD20). Mr Darolles is the legal manager of the opponent. His evidence goes to use of the earlier marks.

b) The witness statement of Valérie Dorey dated 31 January 2023, which is accompanied by 2 exhibits (Exhibits 1 and 2). Ms Dorey is the EU representative for the opponent. The purpose of her evidence is to translate exhibit LD10.

9. The opponent's evidence was accompanied by written submissions dated 24 November 2022.

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

RELEVANCE OF EU LAW

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

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act 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.”

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

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

14. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. Although the First Earlier Mark is subject to the use provisions of section 6A of the Act, the applicant did not request that the opponent provide evidence of use and, consequently, the opponent can rely upon the full breadth of the specifications for both its First and Second Earlier Marks.

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods

16. Although the opponent's full specifications can be seen above, I have included only those terms that I consider represent the opponent's best case in the table below. With that in mind, the competing goods are as follows:

Opponent's goods	Applicant's goods
The First Earlier Mark <u>Class 3</u> Perfumes.	<u>Class 3</u> Beauty masks; Hair dyes; Essential oils; Make-up; Shampoos; Hair conditioners; Body glitter; Lipsticks; Cosmetics; Perfumes.
The Second Earlier Mark <u>Class 3</u> Perfume; Oils for cosmetic purposes; Cosmetic masks; Cosmetics; Hair lotion.	

17. When making the comparison, all relevant factors relating to the goods 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:

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. 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 for 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.”

Beauty masks.

20. These goods will overlap in trade channels and user with “perfumes” in the specification of the First Earlier Mark, as they are both likely to be sold by pharmacies and beauty retailers and would be purchased by the same customers. The nature, method of use and purpose of the goods clearly differ. There is no competition or complementarity. In my view, they are similar to between a low and medium degree.

21. These goods are identical on the principle outlined in *Meric* to “cosmetic masks” in the specification of the Second Earlier Mark.

Hair dyes; shampoos; hair conditioners.

22. In my view, the same applies with regard to trade channels and user when compared with “perfumes” in the specification of the First Earlier Mark, as identified above. Consequently, they are similar to between a low and medium degree.

23. These goods will overlap in trade channels with “hair lotion” in the specification of the Second Earlier Mark, as the same businesses that produce and sell hair dyes, shampoos and hair conditioners are also likely to produce a range of other goods for use on the hair. The method of use and nature is likely to overlap. There is some overlap in purpose. I consider these goods to be similar to between a medium and high degree.

Essential oils.

24. These goods will overlap in nature with “perfumes” in the specification of the First Earlier Mark, as they are both liquids. The method of use and purpose may also overlap, as both could be applied to the body for fragrancing purposes. However, I consider it unlikely that there would be any real overlap in trade channels, but the users may overlap. In my view, these goods are similar to between a medium and high degree.

25. I consider these goods to be identical on the principle outlined in *Meric* to “oils for cosmetic purposes” in the specification of the Second Earlier Mark, because essential oils are often used for cosmetic purposes. If I am wrong in that finding, then the goods will overlap in nature, method of use, user and purpose and will be similar to at least a medium degree.

Make-up; body glitter; lipsticks; cosmetics.

26. The same will apply to the comparison between these goods and “perfumes” in the specification of the First Earlier Mark, as identified in paragraph 20 above. They are similar to between a low and medium degree.

27. These goods are either self-evidently identical or identical on the principle outlined in *Meric* to “cosmetics” in the specification of the Second Earlier Mark.

Perfumes.

28. These goods are self-evidently identical to “perfumes” in the specification of the First Earlier Mark and “perfume” in the specification of the Second Earlier Mark.

The average consumer and the nature of the purchasing act

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

30. The average consumer for the goods will be a member of the general public or a professional user (such as beautician or hair dresser). The cost and frequency of the purchase is likely to be relatively low, but various factors will be taken into

consideration such as ingredients, scent and aesthetics. Consequently, I consider that a medium degree of attention is likely to be paid during the purchasing process.

31. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalents. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

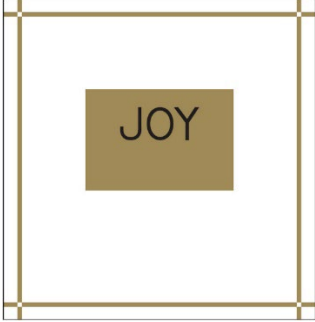
Comparison of trade marks

32. It is clear from *Sabel* 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. 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.”

33. 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.

34. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="333 309 655 398">JOY (the First Earlier Mark)</p>  <p data-bbox="311 813 678 851">(the Second Earlier Mark)</p>	<p data-bbox="995 309 1203 338">BODY IN JOY</p>

Overall Impression

35. The applicant's trade mark consists of the words BODY IN JOY. The overall impression of the mark lies in the combination of these words. The First Earlier Mark consists of the word JOY, in which the overall impression resides. The Second Earlier Mark consists of the word JOY presented in a gold rectangular background, surrounded by a thin gold border. The word JOY plays the greater role in the overall impression as the eye is naturally drawn to the element of the mark that can be read. The background and border play a much lesser role.

Visual Comparison

36. The First Earlier Mark is replicated entirely in the applicant's mark. However, the words BODY IN are present in the application and have no counterpart in the First Earlier Mark. I bear in mind that the beginnings of marks tend to make more of an impact than the end. I consider the marks to be visually similar to a medium degree.

37. The same applies to the Second Earlier Mark and the applicant's mark, albeit the gold background and border act as additional points of difference. I consider the marks to be visually similar to between a low and medium degree.

Aural Comparison

38. The word JOY in both the First Earlier Mark and the applicant's mark will be pronounced identically. However, the words BODY IN act as a point of aural difference. In my view, there is a medium degree of aural similarity between the marks.

39. As the background and border in the Second Earlier Mark will not be articulated, the same comparison will apply. The marks are aurally similar to a medium degree.

Conceptual Comparison

40. The word JOY will be given its ordinary dictionary meaning, which will be identical in both the First Earlier Mark and the application. However, the words BODY IN act as a point of conceptual difference. The applicant suggests the application will be understood as meaning "to enjoy body happiness and happy life". I am not convinced that this meaning will be immediately apparent to the average consumer, but even if it is, there will still clearly be a conceptual overlap with the dictionary meaning of JOY. In my view, the marks are conceptually similar to a medium degree.

41. As no conceptual message will be conveyed by the background and border, the same comparison applies to the Second Earlier Mark. Consequently, they are conceptually similar to a medium degree.

Distinctive character of the earlier trade marks

42. 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-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

44. The First Earlier Mark is an ordinary dictionary word meaning a feeling of great happiness.¹ In my view, there is a laudatory allusion i.e. that the goods will bring great happiness to the user. I consider the First Earlier Mark to be inherently distinctive to between a low and medium degree. The same will apply to the Second Earlier Mark. I do not consider that the background and border raise the inherent distinctiveness of the Second Earlier Mark to any meaningful degree.

¹ <https://www.collinsdictionary.com/dictionary/english/joy>

45. The opponent has filed evidence to demonstrate use of its marks. Consequently, I must consider whether the distinctiveness of the First and Second Earlier Marks has been enhanced as a result of the use made of them. In that regard, and bearing in mind that the relevant jurisdiction for establishing enhanced distinctiveness is the UK market, I note the following from the opponent's evidence:

- a) The opponent acquired the rights to the earlier marks in 2017. This evidence is not challenged.
- b) The mark JOY was first used in relation to fragrance in 1930.
- c) The mark JOY has been advertised in UK publications such as *Good Housekeeping* (2013), *Glamour* (2014) and *Cosmopolitan* (2014).²
- d) Mr Darolles' unchallenged evidence is that JOY was awarded "Scent of the Century" in the UK FIFI awards in 2000.
- e) The UK wholesale figures for JOY are as follows:

2015-2016	£47,296.01
2016-2017	£46,468.74
2017-2018	£49,011.67

Mr Darolles' unchallenged evidence is that the retail sales would have been approximately four times this amount.

- f) Mr Darolles' unchallenged evidence is that the JOY mark was licensed to Parfums Christian Dior in 2018. This launch was covered by well known magazines such as *Vogue* and featured Hollywood actress, Jennifer Lawrence.³

² Exhibit LD5

³ Exhibit LD13

- g) Mr Darolles' unchallenged evidence is that JOY is a brand known for luxury and is sold in luxury retailers such as Harrods.
- h) *The Times* identified JOY by Dior as being a suggested Christmas gift in 2019.⁴ The bottle appears as follows:



- i) In 2019, JOY by Dior perfume was a finalist for “Reader’s Choice for Women” as voted for by readers of the *Evening Standard* and “People’s Choice – Women” as voted for by users of the retail website Boots.com.
- j) JOY by Dior won “Best New Women’s Fragrance” in the Style Beauty Awards 2020, as compiled by *The Sunday Times*.⁵ The article states: “The nation has spoken! With almost 1.6million reader votes cast in the UK’s biggest luxury consumer beauty awards, we reveal the gold-standard products you need now”.

46. I am satisfied that use of JOY by Dior contributes to the enhancement of the distinctiveness of the First and Second Earlier Marks as the word JOY retains an independent and distinctive role when used in that way. I note that there is also evidence of use of marks such as JOY FOREVER and LACOSTE JOY OF PINK. I am not convinced that use of these marks is sufficient to demonstrate enhanced distinctiveness of the earlier marks, because the word JOY forms a unit in those marks and any distinctiveness would lie in the combination of the words in those units.

⁴ Exhibit LD15

⁵ Exhibit LD17

47. Even aside from this, there are clearly issues with the opponent's evidence. Firstly, I have no overall marketing and advertising expenditure. Secondly, I have no evidence of turnover/sales figures following the launch of JOY by Dior. Thirdly, I have no information regarding market share in the UK. However, it is important to look at the evidence as a whole. It is not clear when use in the UK commenced, but it must have been prior to 2000 because in that year the opponent won a "Scent of the century" award in the UK. Further, the opponent's mark has been a finalist in awards voted for by users of a national retailer and a well known newspaper. Consequently, there must have been levels of use of the mark prior to those awards being won (in 2019). The same is true of an award won in 2020 which was voted for by 1.6million readers of *The Times*. Use is clearly long-standing and geographically widespread within the UK. Whilst I have no evidence of the extent of the use since 2018, it must have been significant to have resulted in such an awareness amongst user bases of such wide-circulation publications. Consequently, I consider that the distinctiveness of the First Earlier Mark has been enhanced through use to between a medium and high degree. As the dominant element of the Second Earlier Mark is also the word JOY, the same will apply to that mark.

Likelihood of confusion

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

49. I have found as follows:

- a) The goods vary from being similar to between a low and medium degree to identical.
- b) The average consumer for the goods is a member of the general public or a professional user (such as a beautician or hairdresser) who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The First Earlier Mark and the applicant's mark are visually, aurally and conceptually similar to a medium degree.
- e) The Second Earlier Mark and the applicant's mark are visually similar to between a low and medium degree, and aurally and conceptually similar to a medium degree.
- f) The earlier marks are inherently distinctive to between a low and medium degree, which has been enhanced to between a medium and high degree through use.

50. I do not consider it likely that the marks will be mistakenly recalled or misremembered as each other, given that the key difference (being the words BODY IN) is at the beginning of the applicant's mark. However, I do consider that the average consumer would assume that all of the marks originate from the same undertaking. This is because the words BODY IN, when added to the mark JOY are likely to be seen as a non-distinctive addition indicating goods for the body which are scented in the JOY fragrance, which is entirely consistent with a sub-brand or brand extension. I consider there to be a likelihood of indirect confusion in respect of all goods covered by the applicant's specification.

51. The opposition based upon section 5(2)(b) succeeds in its entirety.

Section 5(3)

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

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

53. Section 5(3A) of the Act states:

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

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

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.

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

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

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

55. As noted above, under this ground, the opponent relies upon the First Earlier Mark only. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the First Earlier Mark and the applicant's mark are similar. Secondly, the opponent must show that the First Earlier Mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the First Earlier Mark being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage pleaded will occur. It is unnecessary for the purposes of section 5(3) that the goods 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.

Reputation

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

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

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

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

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

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

58. I have summarised the opponent's evidence of use above. In my view, for the same reasons set out above, the evidence (whilst far from complete) is sufficient to demonstrate at least a moderate reputation for perfume.

Link

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

The degree of similarity between the conflicting marks

The First Earlier Mark and the applicant's mark are visually, aurally and conceptually similar to a medium 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

The goods vary from being similar to between a low and medium degree to identical.

The relevant public will include both members of the general public and professional users (such as beauticians and hair dressers) who will pay a medium degree of attention during the purchasing act.

The strength of the earlier mark's reputation

I have found the First Earlier Mark to have at least a moderate reputation in relation to perfumes.

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

The First Earlier Mark is inherently distinctive to between a low and medium degree, which has been enhanced through use to between a medium and high degree.

Whether there is a likelihood of confusion

I have found there to be a likelihood of indirect confusion.

60. Taking all of the above factors into account, I am satisfied that a link would be made in the mind of the relevant public. In my view, this would be the case even if I

had found there to be no likelihood of confusion, given the similarity between the marks and the goods (as well as the reputation of the opponent).

Damage

61. I must now consider whether any of the types of damage pleaded will arise.

62. In its Notice of opposition, the opponent states:

“9. Use of the Application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the Opponent’s Mark. The Application, if registered, will take unfair advantage of the repute of the Opponent’s Mark by riding on the coat-tails of the prestigious reputation the Opponent has generated in almost a century of use and through significant financial investment during that time. The Application will inevitably benefit from the prestige of the Opponent’s Mark without paying any financial compensation for such advantage.”

63. I bear in mind that unfair advantage has no effect on the consumers of the earlier marks’ goods. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

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

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

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

65. To the extent that the relevant public believe that the goods of the applicant originate from the opponent, there will clearly be unfair advantage. However, even if they do not consider that the goods originate from the same undertaking, I consider that the applicant will still gain an unfair advantage. This is because the First Earlier Mark is associated with luxury and the applicant will benefit from the transfer of this image. In addition, or alternatively, the applicant will benefit from the opponent’s marketing efforts (which appear to have been widespread in recent years given the commentary upon the launch of JOY by Dior), without having to incur any costs itself. Consequently, I consider that damage is made out.

66. As the opponent has been successful in demonstrating unfair advantage, I do not consider it necessary to assess the other claimed heads of damage.

67. The opposition based upon section 5(3) of the Act succeeds in its entirety.

CONCLUSION

68. The opposition succeeds, and the application is refused.

COSTS

69. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,750**, calculated as follows:

Preparing a Notice of opposition and considering	£350
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the applicant's counterstatement

Preparing evidence	£850
Written submissions	£350
Official fee	£200
TOTAL	£1,750

70. I therefore order Guangzhou Zhongshang Daily Chemicals Co., LTD to pay Jean Patou the sum of £1,750. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 8th day of November 2023

S WILSON
For the Registrar