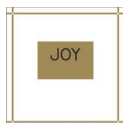


BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2015242
of 5 March 2021

Opponent: **JEAN PATOU, Société par actions simplifiée**
Rue Jean Goujon 24-32
75008 Paris
France

Representative: **IPSILOX BENELUX SA, aussi traitant sous le
nom Distinctive+Ipsilon**
Parc d'activités 77-79
8308 Capellen
Luxembourg

Invoked trademark: **EU trademark 17895714**



Against

Defendant: **United Consortium Netherlands B.V.**
Siriusdreef 17
2132 WT HOOFFDORP
Netherlands

Representative: **Arnold + Siedsma (Amsterdam)**
Postbus 71720
1008 DE Amsterdam
Netherlands

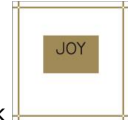
Contested trademark: **Benelux application 1392539**
JO

I. FACTS AND PROCEEDINGS

A. Facts

1. On 21 March 2019 the defendant filed a Benelux trademark application for the word trademark JO for goods in classes 3 and 5. This application was processed under number 1392539 and was published on 12 April 2019.

2. On 6 June 2019 the opponent filed an opposition against this application. The opposition is based



on the earlier European Union trademark 17895714 for the combined word/figurative trademark , filed on 4 May 2018 and registered on 19 March 2019 for goods and services in classes 3 and 35.

3. According to the register the opponent is the actual holder of the trademark invoked.

4. The opposition is directed against all the goods of the contested trademark and is based on the goods in class 3 of the trademark invoked.

5. The grounds for opposition are those laid down in Article 2.14, 2 (a) Benelux Convention on Intellectual Property (hereinafter referred to as: "BCIP").¹

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 12 June 2019. During the administrative phase of the proceedings both parties filed arguments. All the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 17 December 2019.

II. ARGUMENTS OF THE PARTIES

8. The opponent filed an opposition at the Office under article 2.14, 2 (a) BCIP, in accordance with the provisions of article 2.2ter, 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and of the goods or services concerned.

A. Opponent's arguments

9. According to the opponent, the trademarks are visually similar because they coincide in the letters JO which constitute two out of the three letters of the earlier trademark.

10. Aurally, the trademarks have the same number of syllables, the same rhythm and intonation. They coincide in the sound of the letters [DJO] which constitute the whole contested trademark and a large part of the earlier trademark, in which the presence of the last letter [Y] will not be noticed. The opponent concludes that the trademarks are highly similar from an aural point of view.

¹ This decision refers to the laws and regulations applicable at the date of the decision, unless it concerns provisions that have undergone a material change relevant to the decision during the proceedings.

11. The earlier trademark has a meaning, namely "a feeling of great happiness" or "something or someone that makes you feel happy or gives you great pleasure". According to the opponent, the opposed trademark may also have a meaning as it can be perceived as a name or the short form for names such as Joanna, Joseph, John, George, etcetera. Therefore, the trademarks are conceptually different.

12. According to the opponent, the contested goods in class 3 must be considered identical or at least highly similar to the goods of the earlier trademark in the same class. Furthermore, he is of the opinion that the contested goods in class 5 are similar to the goods of the earlier trademark in class 3. Moreover, these goods target the same consumers and can be sold through the same distribution channels.

13. The opponent concludes that there exists a likelihood of confusion and he therefore requests that the Office grants the opposition and rejects the contested trademark.

B. Defendant's arguments

14. According to the defendant, the mere fact that both trademarks are short trademarks, justifies the conclusion that there is no visual nor aural similarity. But even if there would be some visual and aural similarities, these are offset by the clear conceptual differences due to the meaning of the word JOY in the English language. Even people with a very basic knowledge of the English language will be aware of the meaning of the word JOY. Due to the clear meaning of the word JOY, there exists a conceptual difference between the trademarks. This is in fact also admitted by the opponent, who literally concludes that the trademarks are conceptually different.

15. The defendant believes that cleaning preparations are obviously different from cosmetics. Although both products can be used for cleaning purposes, they have a different kind of use and these products are sold in different aisles in supermarkets. Furthermore, the defendant strongly disagrees with the opponent that the goods of the contested trademark in class 5 would be similar to those in class 3 of the trademark invoked. These products are usually sold in different stores and target different consumers. As the defendant says: you do not go shopping for mascara or lipstick to accidentally come home with a sexual lubricant.

16. The defendant concludes that there does not exist a likelihood of confusion because the trademarks are conceptually different and the majority of the goods are dissimilar. Even assuming that the trademarks are similar the conclusion must be that there is no likelihood of confusion due to the short length of both trademarks. Therefore the defendant requests that the Office rejects the opposition in its entirety.

III. DECISION

A.1 Likelihood of confusion

17. In accordance with article 2.14 BCIP, the holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.2ter BCIP.

18. Article 2.2ter, para. 1 BCIP stipulates that "*A trademark shall, in case an opposition is filed, not be registered (...) where because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.*"

19. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

Comparison of the goods

20. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

21. With the comparison of the goods of the trademark invoked and those against which the opposition is filed, the goods are considered only on the basis of what is expressed in the register or as indicated in the contested trademark.

22. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
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 3 Cleaning preparations; Cleaning sprays; Massage oils and lotions; moisturizers; body cream; bath cream; perfumery; cosmetics; anti-aging serums; serums for cosmetic purposes; Cleansers for intimate personal hygiene purposes, non medicated.
	Class 5 Vaginal lubricants; Hygienic lubricants; Personal sexual lubricants; Silicone-based personal lubricants; Water-based personal lubricants; Lubricants for medical use; Sexual stimulant gels; Preparations for facilitating sexual coupling; sanitary preparations and articles; dietary supplements; serums; herbal male enhancement creams.

Class 3

23. The goods *cosmetics* are mentioned *expressis verbis* in both lists of goods and are thus identical.

24. The goods *perfumery* of the contested trademark are synonymous of and therefore identical to the goods *perfume; eau de parfum; toilet water* and *Cologne* of the trademark invoked.

25. The other goods of the contested trademark in this class, *cleaning preparations; cleaning sprays; massage oils and lotions; moisturizer; body cream; bath cream; anti-aging serums; serums for cosmetic purposes* and *cleansers for intimate personal hygiene purposes, non-medicated* belong to the broader category *cosmetics* of the trademark invoked and are therefore identical to them. Indeed, according to established case law, if the goods of the earlier trademark also contain goods that are mentioned in the application for the contested trademark, these goods are considered identical (see EGC, Fifties, T104/01, 23 October 2002, ECLI:EU:T:2002:262; Arthur et Félicie, T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and Prazol, T-95/07, 21 October 2008, ECLI:EU:T:2008:455).

Class 5

26. The goods *vaginal lubricants; hygienic lubricants; personal sexual lubricants; silicone-based personal lubricants; water-based personal lubricants; lubricants for medical use; sexual stimulant gels; reparations for facilitating sexual coupling; herbal male enhancement creams* of the contested trademark are to a greater or lesser extent similar to the goods *cosmetics and body gels* in class 3 of the trademark invoked. The purposes of these products are to increase personal hygiene and health, physical cleanliness and external beauty. Furthermore, these products are applied to the body, to feel more comfortable and self-confident. The products of the contested trademark are more specifically intended to make the experience of sex easier and more enjoyable. Furthermore, cosmetics, as a broad category, include such products as skincare creams and body lotions, which can be used for the same purpose as lubrication and applied on various parts of the human body. Moreover, these products are produced by the same companies. Finally, these goods may be targeted at the same consumers and sold at the same commercial places, for example cosmetic shops.

27. The contested *sanitary preparations and articles, dietary supplements* and *serums* are dissimilar to the opponent's products. Even though some of the goods are used for body care, they have a different nature and purpose. They are not complementary or in competition with each other, they target another public and even though they have the same distribution channels, such as drugstores or pharmacies, they are normally not placed so close to each other. These goods are normally produced by other kinds of undertakings.

Conclusion

28. The goods of the contested trademark are partly identical, partly similar and partly dissimilar to the goods of the trademark invoked.

Comparison of the trademarks


29. The wording of Article 5, 1 (b) of the Directive (compare article 2.2ter, 1 (b) BCIP) according to which "there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark" shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of

confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, *Sabel*, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

30. Global assessment of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (CJEU, *Sabel and Lloyd*, already cited).

31. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, *Limonchello*, C334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, *Matratzen*, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and *El Charcutero Artesano*, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

32. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
	JO

Visual comparison

33. The trademark invoked is a combined word/figurative trademark comprising the word JOY in black letters placed in a brown rectangular. The rectangular is placed in a larger square with a white background. The square is surrounded by thin brown lines, which together form a kind of frame. The contested trademark is a pure verbal trademark, consisting of two letters, JO.

34. Visually, the trademarks coincide in the sequence of the letters "JO". However, they differ in the additional last letter, the letter "Y" and in the figurative elements of the trademark invoked. The trademarks at issue are short trademarks (three versus two letters) and the shorter a trademark the more easily the public is able to perceive all its single elements. Therefore, from the visual point of view, the trademarks will be similar to a low degree.

35. The trademarks are visually similar to a low degree.

Aural comparison

36. With regard to the aural comparison, it must be remembered that, in the strict sense, the phonetic reproduction of a complex trademark corresponds to that of all its verbal elements, regardless of any specific graphic features, which fall more within the scope of the analysis of the trademark on a visual level (EGC, *PC Works*, T-352/02, 25 May 2005, ECLI:EU:T:2005:176 and *Thai Silk*, T-361/0821, April 2010, ECLI:EU:T:2010:152).

37. Although the trademarks have two letters in common, only the first letter J will be pronounced the same way. The right invoked is clearly an English word, whereas the contested trademark has not a clear signification. Therefore, the right invoked will be pronounced as [dzjoj], and the contested trademark can be pronounced [djoo], [szoe] or [joo], depending on the language of the native speaker. Furthermore, the pronunciation differs in the sound of the extra letter of the trademark invoked, the letter Y, which will be clearly pronounced as [j] and which has no counterpart in the contested trademark.

38. Due to their differences, the trademarks are considered aurally similar to a low degree.

Conceptual comparison

39. Conceptually, both parties agree that the trademarks are different. The average consumer in Benelux will understand the trademark invoked as "pleasure, delight, a feeling of great happiness" (see https://www.oxfordlearnersdictionaries.com/definition/american_english/joy). The contested trademark on the other hand has no meaning at all, or refers at the most to a person's name.

40. As the trademark invoked has a clear meaning and the contested trademark has none, the trademarks are conceptually different.

Conclusion

41. Visually and aurally, the trademarks are similar to a low degree, while they differ from a conceptual point of view.

A.2 Global assessment

42. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the trademarks are important factors.

43. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. The present case concerns basic consumer goods which are targeted at the public in general. For these goods the average level of attention of the public concerned may be deemed normal.

44. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors that have to be taken into account, particularly between the level of similarity of the trademarks and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

45. It should also be taken into consideration that the average consumer usually perceives a mark as a whole and does not proceed to an analysis of its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different trademarks and must place their trust in the imperfect picture of those that they have kept in their mind.

46. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). In

the present case, the trademark invoked has a normal distinctiveness, as it is not descriptive of the goods concerned.

47. The trademarks at issue are visually and aurally similar to a low degree. However, it must be stated that the trademarks are short marks facilitating a better perception of all their single elements. The fact that they differ in one letter is a relevant factor to consider when evaluating the likelihood of confusion between the conflicting trademarks. Indeed, small differences may frequently lead to different overall impressions in short words (See EGC, Chufafit, T-117/02, 6 July 2004, EU:T:2004:208; Calpico, T-273/02, 20 April 2005, EU:T:2005:134).

48. Moreover, according to the European case-law, the visual and phonetic similarities may be counteracted by the conceptual differences between the trademarks in question. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. This neutralisation can take place regardless of whether that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made and regardless of whether the other mark does not have such a meaning or only a totally different meaning (EGC, Bass, T-292/01, 14 October 2003, ECLI:EU:T:2003:264; CJEU, Zirh, C-206/04P, 23 March 2006, ECLI:EU:C:2006:194 and Picarro, 12 January 2006, ECLI:EU:C:2006:25). As stated in points 39 and 40, the trademark invoked has a clear meaning and the contested trademark has none.

49. The trademarks at hand are visually and aurally similar to a low degree. However, it concerns very short trademarks which makes the differences stand out more. In addition, the trademark invoked has a clear and immediately comprehensible meaning, while the contested trademark has none. Therefore, the conceptual difference between the trademarks neutralizes the few points of similarity.

50. Based on the aforesaid, and taking into account all factors to be considered, the Office comes to the conclusion that the relevant public will not believe that the goods in question come from the same undertaking or from economically linked undertakings.

B. Conclusion

51. Based on the foregoing the Office is of the opinion that there exists no likelihood of confusion.

IV. CONSEQUENCE

52. The opposition with number 2015242 is not justified.

53. The Benelux application with number 1392539 will be registered for all the goods applied for.

54. The opponent shall pay the defendant 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is not justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 5 March 2021

Willy Neys
rapporteur

Tineke van Hoey

Tomas Westenbroek



Administrative officer:

Guy Abrams