



IN THE MATTER OF APPLICATION NO. 61,838

BY FITZ A. JACKSON

TO REGISTER THE TRADE MARK



IN CLASSES 3 AND 25

AND IN THE MATTER OF OPPOSITION NO. 184/TM2013

BY CHANEL SARL

**IN THE MATTER OF APPLICATION NO. 61838
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DECISION AND REASONS FOR DECISION

The Application

1. On the 15th of January, 2013, Fitz A. Jackson, ‘the Applicant’ applied on Form TM1 under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) to the Jamaica Intellectual Property Office (JIPO) for registration of the trade mark:



2. The Application relates to classes 3 and 25 in respect of “soaps, perfumery, essential oils, cosmetics, hair lotions and dentifrices” and “clothing, footwear and headgear” respectively. The Applicant indicated his *bona fide* intention to use the mark in the course of trade.
3. On the 12th of April, 2013 JIPO accepted the mark for publication. The balance of fees was paid on the 5th of July, 2013 and the application was subsequently published in the Trade Marks Journal, Volume 0029, No. 0001, dated August 20, 2013.

Grounds of Opposition and Counterstatement

4. Notice of Opposition (Form TM 4) accompanied by the Statement of Grounds of Opposition was filed on October 18th, 2013 by Myers, Fletcher & Gordon, Attorneys-at-Law, on behalf of Chanel Sarl, of Burgstrasse 26, CH-8750 Glarus, Switzerland (hereinafter referred to as the “Opponent”).
5. According to the Statement of Grounds (hereinafter “the Opponent’s Grounds”) filed, the Opponent opposes the proposed registration of the trade mark on the following grounds:

- i) The Opponent is the proprietor of the internationally well-known trade mark COCO which is registered in Jamaica under the following registration numbers: 19,253 and 53,752 in class 3 and 21,682 in class 25.
- ii) The COCO trade mark has been used in Jamaica for numerous years and through such use, enjoys widespread popularity in the local market. The Opponent's COCO trade mark has a reputation in Jamaica.
- iii) The Applicant has applied for the registration of the trademark COCOS & Logo in classes 3 and 25. This mark is aurally, visually and conceptually similar to the Opponent's COCO trade mark. The differences between the COCOS & Logo trade mark and the COCO trade mark are not adequate to make the two distinguishable for the purpose of trade mark registration.
- iv) The trade mark that the Applicant has applied to register is similar to the Opponent's earlier COCO trade mark and the registration thereof is being sought for goods which is similar to those for which the Opponent's trade mark is registered. The Applicant's proposed trade mark COCOS & Logo should, therefore, be refused registration in accordance with section 13 (2) (b) of the Trade Marks Act as the use of the same would likely result in confusion on the part of the public, including likelihood of association with the Opponent's earlier COCO trade mark.
- v) Further and/or in the alternative the Applicant's proposed trade mark COCOS & Logo, is similar to the Opponent's earlier COCO trade mark and in accordance with section 13 (3) of the Trade Marks Act the application for the trade mark COCOS & Logo should not be allowed as the Opponent's COCO trade mark has a reputation in Jamaica and the use of the Applicant's similar trade mark, would take unfair advantage of and/or be detrimental to the distinctive character or reputation of the Opponent's COCO trade mark.
- vi) Any current use of the trade mark COCOS & Logo by the Applicant would amount to an act of infringement of the Opponent's registered trade mark as provided in section 9 (3) of the Trade Marks Act. This infringing status of the Applicant's trade mark should not be ratified by a grant of the registration of the trade mark.
- vii) Further and/or in the alternative, use of the proposed trade mark by the Applicant may constitute the tort of passing off of the Opponent's goods marketed under its previously registered trade mark. Therefore, in accordance

with section 13 (4) (a) of the Trade Marks Act, the Applicant's trade mark should not be registered.

viii) The use and proposed registration of the Applicant's mark would prejudice the Opponent's lawful use of its registered trade mark in the normal course of business, would amount to the tort of passing off and would otherwise prejudice the proprietary rights of the Opponent in its trade mark. This being so, the application for registration of the mark COCOS & Logo in classes 3 and 25 ought, in the discretion of the Registrar, to be refused having regard to the stated grounds of opposition.

6. Form TM 5 and Grounds in Support of Counterstatement were filed by Fitz A. Jackson, the Applicant, on the 17th of December 2013.

7. The Applicant denied all the statements and allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant's Grounds state that:

i) The Opponent's claim that its trade mark is popular and well known in Jamaica is baseless and without merit and without any support to such claim.

ii) Both trade marks by any pronunciation bear no similarities.

iii) The Opponent's trade mark is by words only, while the Applicant's is a combination of three (3) separate marks, namely the image of a "Coconut", "COCOS" and "Live Life." When each is taken singularly or by any combinations, the mark does not bear any resemblance to that registered.

iv) The objection if accepted would deny the Applicant the opportunity to properly and appropriately promote the intended products in Jamaica, and will not be keeping with the intent of the Trade Marks Act.

Evidence

Opponent's Evidence

8. On the May 16, 2014, the Opponent filed Statutory Declaration of Vanessa Riviere in support of the Opposition.

9. Ms. Vanessa Riviere is an authorised representative of the Opponent company. In her Declaration made on May 9th, 2014 she states *inter alia* that:

- i) The Opponent is affiliated with the famous House of Chanel, a world leader in beauty, fragrance and fashion with a rich history and excellent reputation for the high quality of its products. It was founded in France almost a century ago by Miss Gabrielle “Coco” Chanel, who is widely recognized as one of the most famous and influential people of the 20th Century, throughout the world and Jamaica.
- ii) Over the past several decades, Miss Coco Chanel has been the subject of numerous books, films and plays, seen and published throughout the world.
- iii) Chanel Sarl and its affiliated companies (hereinafter referred to as Chanel) has become a global leader of fashion and beauty with worldwide sales exceeding USD 4 Billion per year from 2008 to 2012 inclusive, and with yearly advertising and promotional expenses exceeding 600 million in those same years.
- iv) Derived from the name of Chanel’s founder, the COCO trademark is among Chanel’s most valuable marks and was first registered in 1954 under International Registration No. 17573. It has since been registered by Chanel in nearly every country that has a trademark registry.
- v) The COCO trademark has been registered in Jamaica for over 35 years.
- vi) Chanel first launched the famous COCO fragrance as a tribute to Miss Coco, thirty years ago. It became and has remained one of the top selling women’s fragrances worldwide. COCO MADEMOISELLE was launched in 2001, followed by COCO NOIR in 2012. All three fragrances were supported by significant advertising campaigns featuring prominent celebrities.
- vii) Chanel’s COCO mark is used on fragrances and beauty products as well as ready-to wear clothing, shoes and fashion accessories.
- viii) The COCO and COCO MADEMOISELLE lines are Chanel’s bestselling fragrances. Total global sales of COCO products have exceeded 300,000,000.0 (USD 300 Million) per year from 2008 to 2012 inclusive. Global advertising and promotional expenditure for COCO during those years exceeded USD 30 Million per year.

- ix) Chanel's COCO products are advertised in major international publications such as ELLE, VOGUE, HARPER'S BAZAAR and others. They are also advertised in various inflight magazines from international airlines that have regular service to and from Jamaica.
- x) In Jamaica, the COCO products are sold at the following locations:
- Dufry Jamaica-Falmouth Cruise Port (1)
Daswani-The Royal Shop Rosehall (1)
Aldeasa Jamaica- Airport/Central Perfumery & Store Walkthrough (2)
- xi) Over the years, Chanel's COCO fragrances have consistently remained among the most popular and top selling fragrances worldwide and they have won numerous awards from international industry organizations.
- xii) Chanel diligently enforces its intellectual property rights and has successfully opposed the registration of various COCO marks throughout the world. The reputation of Chanel's COCO trademark has been recognised by courts and trademark offices in various countries.
- xiii) The applicant has applied for the registration of the trade mark COCOS & Logo in classes 3 and 25 under Application No. 61,838. This mark wholly incorporates Opponent's COCO mark and is aurally, visually and conceptually similar to it. The differences between the COCOS & Logo trade mark and the COCO trade mark are not adequate to make the two distinguishable for the purpose of trade mark registration, particularly as the application covers identical goods. Thus it is likely that if the registration of the Applicant's mark is allowed, consumers will associate this mark with the Opponent's.
- xiv) The Opponent's COCO trade mark is very popular throughout the world, including Jamaica and it is verily believed that the Applicant intends to and has tried to piggy-back on the reputation of the Opponent in the market for Class 3 and 25 goods.

10. Attached to Ms. Riviere's Declaration were the following exhibits:

- i. Evidence of Miss Gabrielle "Coco" Chanel's recognition as one of the most famous and influential people by various articles and magazine clippings as well as books, films and plays published throughout the world (Exhibits A and B);
- ii. Evidence of Chanel's registration of their various marks (Exhibits C and D);
- iii. Evidence of Chanel's various advertisements and the types of products the COCO mark is used to advertise, as well as prizes received for their fragrances (Exhibits E, F,G and H); and
- iv. Evidence of courts recognising the distinctive nature of the COCO mark and press clippings further recognising the well-known reputation of the COCO trademark (Exhibits I and J).

Applicant's Evidence

11. By letter dated August 11th, 2014, the Applicant indicated that he did not wish to file a declaration or other evidence, as he has no record of use to declare and that the reasons he previously provided for objecting to the opposition remain, notwithstanding the declarations submitted in opposition.

The Opposition Hearing

12. The hearing of the Opposition was held on Wednesday April 8, 2015 at 2:00pm. The Opponent was represented by Miss Kerry-Ann Heavens and Miss Samantha Moore, instructed by Myers, Fletcher and Gordon and the Applicant represented himself.

13. Based on the Notice of Opposition and Statement of Grounds filed by the Opponent, the Applicant's mark is opposed on the following grounds:

- i. likelihood of confusion with the Opponent's well-known mark, pursuant to s. 13(2)(b) of the Act;
- ii. the Opponent's COCO trade mark has a reputation in Jamaica and use of the Applicant's similar trade mark would take unfair advantage of and or

be detrimental to the distinctive character or reputation of the Opponent's trade mark, pursuant to s. 13(3) of the Act;

- iii. any proposed use of the trade mark by the Applicant may constitute the tort of passing off and the Applicant's trade mark should not be registered, pursuant to s. 13(4)a) of the Act; and
- iv. any current use of the trade mark COCOS and logo by the Applicant would amount to an act of infringement of the Opponent's registered trade mark, pursuant to s. 9(3) of the Act.

At the hearing however, the Opponent sought to rely only upon the first two grounds above.

Does there exist a likelihood of confusion of the Applicant's mark with the Opponent's mark, such that the Applicant's mark should be refused registration pursuant to section 13(2)(b) of the Trade Marks Act?

14. Section 13(2)(b) states: "*(2) A trade mark shall not be registered if-*

(b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected, and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark."

15. It stands from the reading of the provision that for a trade mark to be refused registration under this subsection, the Registrar must be satisfied that:

- (i) the Opponent's trade mark is an earlier trade mark;
- (ii) the Applicant's mark is similar to the Opponent's mark;
- (iii) the goods of the respective marks are identical or similar;
- (iv) there is a likelihood of confusion between the marks.

Earlier mark

16. Section 14 (1) defines an "earlier trade mark" as:

- (a) *A registered trade mark; or*
- (b) *A trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application was entitled to protection,*

under the Paris Convention or the World Trade Organization Agreement, as a well-known trade mark; or

(c) 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 paragraph (a), subject to its being so registered.

17. The Opponent is the proprietor of the trade mark COCO which is registered in Jamaica under the following registration numbers: 19, 253 and 53, 752 in class 3 and 21,682 in class 25. Therefore, the Opponent's mark is clearly an earlier trade mark in relation to the Applicant's mark, for the purposes of section 13(2)(b).

Identical or similar marks

18. The case of **Sabel v Puma [1998] R.P.C. 199** sets out the generally accepted test on the comparison of trade marks to determine whether they are similar, where it was stated that what is required is "a global appreciation of the visual, aural, or conceptual similarity of the marks in question, bearing in mind, in particular, their distinctive and dominant components" (at paragraph 23). The court went on further to note that the marks must be looked at as a whole.

19. The emphasis is on the dominant and distinctive components. In assessing the dominant and distinctive elements of the mark, the case of **Lloyd Shuhfabrik v Klijsen Handel [1999] E.T.M.R. 690** states: "In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global 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" (paragraph 22). The identification of the distinctive features of the mark is part of the global appreciation and the Tribunal is not required to give each part of the mark the same weight or significance (**Coco de Mer Limited v Chanel Limited [2004] EWHC 992 (Ch)**).

20. In support of its Opposition, the Opponent at the hearing cited the case of **Deutsch v Credit Lyonnais SA [2007] E.T.M.R. 4** in which "LION Bau" was refused registration as a result of the earlier mark "LION EURO" on the basis that the "Bau" and "EURO"

elements of the mark were less significant than the “LION” which was the dominant element in both mark and as a result, the marks were visually, aurally and conceptually similar. The Tribunal reasoned that the dominance of the word “LION” in both marks was underscored by its positioning at the beginning, where it tends to grab the attention of consumers more than the elements that follow.

21. The Opponent also relied on the case of **Coco de Mer Limited v Chanel Limited [2004] EWHC 992 (Ch)**, in which the Applicant had a stylized representation of the seed of the Coco de Mer plant, along with the words ‘COCO DE MER’. The court noted that the drawing of the seed would not be recognizable to most persons as they would not be familiar with it. The Court found that the coconut appeared on the mark as a small green ball. The court also found that the word ‘COCO’ was the dominant feature of that mark and the words ‘DE MER’ would not have been understood by most consumers. The court noted that the visual and aural qualities of the mark, centring as they do on the word COCO, made that word the most distinctive feature of the mark and therefore held that the mark was similar to the Opponent’s COCO mark and likely to cause confusion.
22. Similarly, the Opponent cited the case of **Senso Di Donna’s Trade Mark [2001] E.T.M.R. 38**, where the Court refused registration of the mark “SENSO di DONNA” due to its visual, aural and conceptual similarity to the earlier “SENSO” trade mark, despite the former being stylized and accompanied by a diamond design, on the basis that the dominant element of both marks was the word “SENSO”.
23. Lastly the Opponent also cited the case of **Mulhens GmbH v The Hearst Corporation**, R-552/2000-4, July 26, 2001 (the Cosmopolitan case), specifically in relation to section 13(3) of the Act, in which the Court held that the trade mark COSMOPOLITAN COSMETICS for cosmetics would take unfair advantage of the trade mark COSMOPOLITAN for women’s magazines.
24. At the hearing, the Applicant agreed that the dominant feature of his mark was COCOS. He however disagreed that it was identical to the Opponent’s mark and argued that it neither sounds nor looks similar to the Opponent’s COCO. He also shared that the concept behind his mark was based on the scientific name of the coconut - *cocos nucifera* – and that the coconut is what his mark represents. In response to the **Coco de mer case**, and the **Senso di Donna case** cited by the Opponent, the Applicant submitted that the

operative word in each mark was identical, whereas in the instant case, the operative words are “COCO” and “COCOS” respectively, which are not visually identical and which do not convey the same sound or meaning. He submitted that although one could say that there is an element of similarity in the spelling of both words, there was no similarity when both marks were read or said. In response to the **Cosmopolitan case**, he accepted that there was great similarity there and said that he would not challenge it, but submitted that it does not apply in the instant case. The Applicant summarised his submissions as follows:

- (i) “COCO” and “COCOS” are not identical;
- (ii) when read, they do not sound the same;
- (iii) when written, his mark is very distinct; and therefore
- (iv) confusion would not arise.

25. In response, the Opponent drew my attention to the case of **Laboratorios RTB v OHIM, Judgment of 9.7.2003, Case T-162/01** (the Giorgio case), in which the GIORGIO BEVERLEY HILLS mark was accepted for registration despite the earlier marks GIORGI, GIORGI LINE and MISS GIORGI, in relation to identical and similar goods in Class 3. The Opponent also dismissed the Applicant’s explanation of his concept for his mark and again referred to the **Coco de mer case** and argued that the public would not be aware of the scientific name or meaning. Alternatively, the Opponent argued that if the Applicant’s mark is descriptive, it would have another issue regarding registrability.

26. The Applicant’s mark bears the image of a large green coconut at the top, followed thereunder by the word ‘COCOS’ in capital letters, with the letters ‘O’ being stylized to look like a mini coconut with three holes at the top of each ‘O’ and each ‘O’ slightly tilted at the top toward the central ‘C’ in “COCOS” and thereunder the words ‘live life’ in common letters. It is clear that the dominant element, aurally, in the Applicant’s mark is the word “COCOS”. The only aural difference between the words COCOS and COCO is the letter ‘s’ at the end. As was stated in the **Decision of the Registrar of JIPO in the ‘WIDES’ trade mark opposition (decision dated July 20, 2012)**, in relation to the words “wide” and “wides”, there is practically no additional mental effort required to make the obvious connection between the two words. The ‘s’ at the end of the “COCOS”

in the Applicant's mark, without more, would not make a significant difference in the pronunciation or aural perception of the marks.

27. I would also agree with the Opponent that consumers and retailers may shorten the proposed name of 'COCOS live life' to solely 'COCOS', as it is the first word, in bold lettering and therefore will grab the attention of consumers more than the words that follow. Both marks have capital letters 'COCO'. The Court in the **Giorgio case** also did a phonetic comparison of the conflicting marks (para. 46). When applied in the instant case, we see that the Opponent's mark has two syllables (co-co), while the Applicant's mark has four syllables (co-cos-live-life), of which the first two are very similar. The marks are therefore phonetically similar. I therefore find that the word "COCOS" is the dominant aural feature in the Applicant's mark and that the Applicant's mark is therefore aurally similar to the Opponent's mark 'COCO'.

28. The several additional elements of the Applicant's mark, the device of a coconut and the words 'live life', would not be of any significant help in distinguishing the Applicant's mark from the Opponent's aurally, but must be considered in assessing the visual similarity of the marks. Indeed, it was said in the **Giorgio case** that "the fact that the earlier marks and the mark claimed contain the words 'giorgi' and 'giorgio', which bear a certain resemblance to one another, is of little consequence in the context of a global comparison and is not in itself sufficient to justify the conclusion that the conflicting signs are visually similar." (para. 42). The same applies in the instant case, that is, the fact that the earlier marks and the mark claimed contain the words "COCO" and "COCOS" which bear a certain resemblance to one another, is not in itself sufficient to justify the conclusion that the conflicting signs are visually similar.

29. In that respect, the image of a large green coconut at the top of the Applicant's mark, followed thereunder by the word 'COCOS' in capital letters, with the letters 'O' being stylized to look like a mini coconut with three holes at the top of each 'O' and each 'O' slightly tilted at the top toward the central 'C' in "COCOS" and thereunder the words 'live life' in common letters, cannot be ignored. It is clear that the dominant element, visually, in the Applicant's mark is the large green coconut at the top of the Applicant's mark which, upon a rough estimation, takes up about 60% of the mark as applied for, in relation to the size of the words underneath it. The colour of the coconut is a bright green, with bright sheen on the left side of the coconut and shadow on the top centre,

right lower side and beneath the coconut as well. The only similarity therefore between the marks is the “COCO” element. As a result of there being far more differences than similarities in visual appearance of the marks, I therefore find that the marks have a low (below average) degree of visual similarity. As concluded in the **Giorgio case**, the similarities between them are negligible by comparison with the differences (para. 45).

30. Conceptually, the marks are clearly dissimilar, as the Opponent’s mark is inspired by and named after its founder, Coco Chanel, which is what is communicated to the public by the mark by the Opponent, while the Applicant’s mark is inspired by and seemingly named after the coconut fruit, which is what the Applicant says he intends to communicate to the public by his mark. Even without the Applicant’s explanation of the concept at the hearing, the coconut concept behind the mark is plain to see upon an examination of the mark. Unlike the relevant public in the **Coco de Mer case**, which was said to not be likely to know anything about the coco de mer plant and concept, the coconut, especially as how it is represented in the Applicant’s mark, with bright green depiction and stylized ‘O’s, is readily recognisable by the general and relevant public in Jamaica and would therefore be readily recognisable as the concept being communicated by the Applicant’s mark, as distinct from that communicated by the Opponent’s mark.
31. I therefore cannot accept the argument, implicitly made by the Opponent, that since consumers ask for the goods by identifying them phonetically, the verbal element in the earlier marks (“COCO”), predominates over the graphic elements in the Applicant’s mark. In fact, that argument and approach was expressly rejected in the **Giorgi case**.
32. Therefore, considering the marks as a whole and the overall impression given by the marks, upon a global appreciation of the visual, aural and conceptual similarity of the marks in question, bearing in mind in particular their distinctive and dominant components, I find that the Applicant’s mark is neither identical nor very similar to the Opponent’s mark and that it is more dissimilar than similar. Recognising however that it is possible that even aural similarity alone between trade marks may create a likelihood of confusion (**Lloyd Schuhfabrik Meyer**, para.28), the identity and similarity of the goods must be assessed.

Identical or similar goods

33. In **Canon v Metro-Goldwyn Mayer Inc [1999] R.P.C. 117**, the court was of the view that all relevant factors concerning the goods or services should be considered or taken into account when assessing the similarity of goods. The court stated that “those 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” (paragraph 23).
34. In his submissions at the hearing, the Applicant argued that it was presumptuous for the Opponent to assert that the goods in Class 25 were similar for both marks, as all clothes are clothes, differentiated only by design and as the Applicant had not yet traded in the class, one could not presume similarity. In response, the Opponent asserted that the similarity of goods is based on classification and not on the design of the goods. On that point, the Opponent is eminently correct.
35. The Opponent’s trade marks are registered in Jamaica in class 3 for soaps, perfumes, toilet waters, eau de cologne and talcum powder for toilet use (TM No. 19,253); and for perfumery, after-shave, essential oils; deodorants (for personal use), anti-perspirants; soaps; preparations for the hair, body, nails and face; cosmetics (TM No. 53,752); and in class 25 for women’s clothing (TM No. 21,682). The Applicant applied for the registration of its trade mark, COCOS and Logo in Class 25 for ‘clothing, footwear, headgear’; and in class 3 for ‘soaps, perfumery, essential oils, cosmetics, hair lotions, dentrifices’.
36. It is clear that the goods covered by the Opponent and Applicant are identical in some instances and very similar in others, as both have either registered or applied for registration in the same classes of goods, classes 3 and 25, in respect of soaps, perfumery, essential oils and cosmetics and clothing respectively.
37. As a result, they would cover the same consumers and would likely be in competition with each other. COCO is an international brand, and as such would attract consumers who would either have an appreciation for international brands or foreigners living or visiting Jamaica. It should be noted, that based on what is presented in the Statutory Declaration of Miss Vanessa Riviere, consumers who either have an appreciation for international brands or foreigners living or visiting Jamaica, appear to be the target audience of the Opponent’s brand, as they gave example of their products being advertised in in-flight magazines from international airlines that have regular service to and from Jamaica. Also, the locations given where their products are available are places within or close to tourist

destinations. However, that does not mean that the Applicant's products cannot be sold in a similar location.

38. It is clear from the type of goods involved that their end users and their method of use may be the same and that the goods of both parties would be in competition with each other and may be complementary also. Some persons might therefore view the Applicant's product as a version of the Opponent's brand or a brand that is associated with it.

Likelihood of Confusion

39. The likelihood of confusion is assessed globally taking into account all the relevant factors of the circumstances of the case. This was held in the **Sabel v Puma** case. The case of **Sabel** noted that the appropriate perspective is from the point of view of the average consumer, which perspective plays a decisive role in the global appreciation of the likelihood of confusion (paragraph 23). The average consumer has been said to be 'reasonably well informed and observant and circumspect' (**Lloyd Shuhfabrik v Klijsen Handel** [1999] 2 CMLR 1343 para 26) who nevertheless perceives the mark as a whole and does not analyse it in detail (**3M Company v Manufacturera 3M SA**. [2014] JMISC Civ 90). This however may vary from sector to sector. In respect of the goods covered by classes 3 and 25, I deem the average consumer to be the public at large, in light of the fact that those goods are general everyday goods for personal wear or adornment, which are not limited to any particular class or specialization of persons.
40. Further to this, the court in **Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1998] E.T.M.R. 690** held that, "the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trademarks is sufficient to give rise to the likelihood of confusion." (paragraph 24) The court went further to hold that 'if the association between the marks causes the public to wrongly believe that the respective goods come from the same economically linked undertakings, there is a likelihood of confusion within the meaning of the section' (paragraph 29).
41. The Opponent's COCO mark is widely known worldwide for its products. This is based on the evidence given in the Statutory Declaration of Miss Vanessa Riviere (paragraph 9,

12, 13, 14 and 18 Exhibits H and G). However, based on information presented, the Applicant has not been specific as to which products under the COCO mark specifically are sold here in Jamaica and therefore have a reputation specifically in Jamaica, or the extent of any reputation, sales, promotions or recognition of its mark in Jamaica.

42. For both the Applicant and the Opponent, the dominant feature for the trademarks aurally is the word COCO, which would be pronounced very similarly with very little difference occasioned by the 's' on the end of the Applicant's mark. However the marks are only minimally visually similar, as a result of several additional words and figurative elements in the Applicant's mark. Given the aural similarity of the marks, some consumers (a minority) may be at least likely to stop and scrutinize or examine the Applicant's trade mark to see whether it is connected to the Opponent's or not and even fewer might mistake the Applicant's goods as being associated with the Opponent's. However, based on the extent of visual and conceptual dissimilarity, I do not believe that there is a real likelihood that the average consumer and a significant proportion of the relevant public would believe that the goods under the Applicant's mark are from the Opponent or have some economic connection to the Opponent.
43. The Opponent relied heavily on the **Coco de Mer** case to argue that the additional words in the Applicant's trade mark, 'live life' would not be sufficient to rule out the possibility of confusion. However, again, that is ignoring two pertinent differentiating facts between that case and the instant case: (1) the **Coco de Mer** case concerned identical dominant components of the marks, that is, the word "COCO", which was common to both marks and at the beginning of both marks, whereas in the instant case, it is "COCO" and "COCOS" in comparison which, even though similar, are not identical; and (2) the relevant public in the UK was said in the **Coco de Mer** case to not be likely to identify and distinguish the image and concept being communicated by the plant, whereas the relevant public in Jamaica certainly and undoubtedly would be able to identify and distinguish the image and concept being communicated by the coconut.
44. Indeed, in the **Coco de Mer** case, the hearing officer stated (at paragraph 41) that visual considerations are likely to be of particular importance with products of this kind, that is, perfumery, jewellery and clothing (class 3 and 25 goods). The hearing officer heavily relied on the fact of non-recognition of the coco de mer plant in determining that "a key point of conceptual dissimilarity is lost", thus rendering COCO a strong element which must be

given full weight in the applied for mark. Again, that is not so in the instant mark. It is that reliance on COCO as an identical and strong element in each mark which resulted in the refusal to register the coco de mer mark.

45. When one reads the decisions of the **Coco de Mer** case and the **Giorgio** case, it seems that the analysis of the relative similarities and differences in marks in the **Giorgio** case is more appropriately considered and more relevant to the instant case. In the **Coco de Mer** case, the hearing officer said that it was not an easy case to decide because he believed there was scope for more than one view of the applied for mark, based on. He concluded that had he been persuaded that there was a significant degree of consumer awareness of the underlying meaning of the applicant's mark, then it might have pointed to a different outcome (para. 51). He however went on to conclude that although direct confusion was unlikely, there was still likelihood of confusion based on the mark being applied to identical goods (para. 52-53). However, again, that basis for decision was not operative in the **Giorgio** case which also had identical goods, on the basis that the marks were differentiated by other letters and figurative elements, which overall led to a finding of an unlikelihood of confusion. Therefore, on an assessment of the whole of the mark and a global appreciation of similarity and dissimilarity, the **Giorgio** case is more on point and thus persuasive in the instant case.

46. Therefore, as stated in the **Giorgio** case (at para. 52), even though there is identity and similarity between the goods covered by the conflicting marks in this case, the visual, aural and conceptual differences between the signs constitute sufficient grounds for holding that there is no likelihood of confusion in the mind of the targeted public. For those reasons, I find that there is no likelihood of confusion between the Applicant's mark and the Opponent's mark. Therefore the Applicant's mark is not precluded from registration by section 13(2)(b) of the Trade Marks Act.

Do the COCO trade marks have a reputation in Jamaica and would use of the Applicant's mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the COCO trade marks?

47. The Opponent also submitted that its marks are well-known marks, however it was neither submitted nor argued that the marks are well-known in Jamaica. The Opponents

therefore seemed content to argue that the marks have a reputation in Jamaica and that use of the Applicant's mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or reputation of their earlier "COCO" trade marks.

48. Section 13(3) of the Trade Marks Act states:

"A trade mark which is identical with or similar to an earlier trade mark and is to be registered in relation to goods or services that are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Jamaica and the use of the later mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark."

49. An understanding of this provision is that where the trade mark to be registered is identical or similar to an earlier trade mark, in relation to goods and services which are not similar to those for which the earlier trade mark is already registered, then the new mark would not be registered if the earlier trade mark has a reputation in Jamaica and use of the new mark, would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark, without due cause.

50. The requirements for section 13(3) to be applicable are: (1) the mark applied for must relate to goods or services that are not similar to the earlier trade mark and (2) the marks must be identical or similar. However, in the decision of the European Court of Justice in **Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd [2004] Ch 120** it was held that notwithstanding that article 5(2) of the EC Directive (similar to section 13(3) of our Act) refers expressly only to goods or services which are not similar, the provision is to be interpreted as obligating the member state to also give protection against marks which are intended to be used in relation to identical and similar goods and services. This is based on (1) the overall scheme and purpose of the Act to provide greater protection for marks with a reputation and (2) to avoid the absurdity that is caused by the literal interpretation of the subsection which would result in marks with a reputation having less protection where a sign is used for identical or similar goods or services, than where a sign is used for dissimilar goods or services.

51. According to Pumfrey J. in **DaimlerChrysler AG v Javid Alavi (t/a MERC)** [2001] RPC 813, the following requirements must be satisfied: (1) the claimant's trademark must be found to have a reputation in the jurisdiction; (2) identity with or similarity to the trade mark of repute must be shown, (3) the use of the sign complained of must take advantage of or cause detriment to the distinctive character or repute of the claimant's trade mark, (4) the use of the sign complained of must be without due cause. In light of this, I must examine the reputation of the Opponent's mark in Jamaica.
52. In the case of **General Motors Corporation v Yplon** [1999]3 CMLR 427 the court stated "*a mark would have a reputation where it was known by a significant part of the public concerned by products or services covered by the trade mark....*". The case further elucidates the criteria in respect of reputation, citing factors such as market share, knowledge in a significant part of the public, intensity, geographical extent and duration of use as well as level of promotional investment. A mark with a reputation need not be as well-known as a well-known mark. The threshold for reputation is therefore a relatively low one (Bently & Sherman, Intellectual Property Law, 3rd Ed., 879).
53. As it is stated in the Statutory Declaration of Vanessa Riviere, the Opponent has been using the COCO trade mark for over six decades internationally, which mark has been registered in Jamaica for thirty-five years, of which they would have built up a reputation over the period, presuming that use was made of the trade mark here. Included in the Statutory Declaration are extracts of newspapers and magazines from local and international publishers which featured the COCO brand and a short list of local outlets where products of the COCO brand are available. Also exhibited is a listing of various books, films and plays on Coco Chanel which are indicative of a strong reputation on a global scale.
54. In **L'Oreal v Bellure**, Case C-487/07, it was stated that detriment to the distinctive character of the mark (also called dilution) is caused when the mark's ability to identify the goods or services for which it is registered is weakened; detriment to the repute of the mark (also called tarnishment) is where the mark's power of attraction is reduced; and unfair advantage of the distinctive character or reputation of the mark (also called parasitism or free-riding) occurs where there is transfer of the image of an identical or similar sign or the characteristics which it projects to the goods identified by the sign, resulting in clear exploitation on the coat-tails of the mark with a reputation.

55. Just one of those three types of injury will suffice under s. 13(3). The Opponent need not prove actual and present injury to its mark, or actual change in the economic behaviour of the average consumer, but that there is a serious risk that such an injury will occur and a serious likelihood that such a change in economic behaviour will result. A mere calling to mind is not sufficient without more (**Intelmark v CPM**, Case C-252/07; **Electrocoin Automatics Limited v Coinworld Limited and others** [2004] EWHC 1498).
56. Although the Opponent cited the case of **Mulhens GmbH v The Hearst Corporation**, R-552/2000-4, July 26, 2001 (the Cosmopolitan case), specifically in relation to section 13(3) of the Act, the case is not apposite, as in that case the Court held that the trade mark COSMOPOLITAN COSMETICS for cosmetics would take unfair advantage of the trade mark COSMOPOLITAN for women's magazines, a situation therefore in which there were two very similar marks both consisting of the word 'COSMOPOLITAN', with the Applicant's mark additionally containing a non-distinctive word 'COSMETICS'.
57. In **Premier Brands UK Ltd v Typhoon Europe Ltd** [2000] FSR 767, the UK High Court held that despite the similarity of the claimant's mark and the defendant's sign and the inherent distinctiveness of the claimant's mark, the average customer for kitchenware would not confuse the TYPHOON sign used by the defendant for kitchenware, with the claimant's TY.PHOO mark used for teas (dissimilar goods). Indeed the Court held that the relevant section equivalent to our section 13(3) was "not intended to have the sweeping effect of preventing the use of any sign which was the same as, or similar to, a registered trade mark with a reputation. Nor was it intended to enable the proprietor of a well-known registered trade mark to be able to object, as a matter of course, to the use of a sign which might remind people of his mark." However the degree of similarity of the marks and goods is of critical importance. The stronger the similarity of the marks, the greater the risk of unfair advantage (**Mango Sport System v Diknah** [2005] ETMR 5).
58. The Opponent has not provided any evidence of its market share in Jamaica, or of the geographical extent and duration of use of their goods in Jamaica, or of the level of promotional investment done in Jamaica by them in relation to their COCO marks. It is therefore not easy to assess knowledge of the Opponent's marks in a significant part of the public. Nevertheless, I am prepared to accept that the mark has a reputation in Jamaica, on the basis that the mark has a global reputation over many years, has been

registered in Jamaica for thirty-five years, has been referred to in Jamaica in the local press (see Exhibit A to Ms. Riviere's Statutory Declaration) and is being sold in Jamaica albeit in only four locations. The required degree of knowledge of the mark in the eyes of the public is generally considered reached when the mark is known by a significant part of the public concerned by the goods or services covered by the mark. It is however difficult to assess the extent of that reputation in Jamaica, based on the evidence presented by the Opponent.

59. Having noted the existence of reputation of the COCO brand in Jamaica, the similarity between the Opponent's and the Applicant's marks, and the identical and similar nature of the goods, the question here is whether the Applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's marks. Although I have found that there is no real likelihood of confusion, there nevertheless may be unfair advantage and/or detriment to the distinctive character or reputation of the Opponent's marks (see **Premier Brands UK Ltd v Typhoon Europe Ltd.**).
60. In such a case, unfair advantage may nevertheless be deemed to exist on the basis that the proprietor of the later mark is exploiting the distinctive character or repute of the earlier mark to benefit its own marketing efforts, using the renowned mark as a vehicle for generating consumer interest, while saving on investment in promotion (**Mango Sport System v Diknah** [2005] ETMR 5). This can lead, as submitted on behalf of the Opponent, to a transfer of value or repute from the Opponent to the Applicant's unknown operations, likely resulting in dilution, tarnishment and parasitism of the Opponent's mark.
61. Based on the fact however that I have found that the Applicant's mark is more dissimilar than similar to the Opponent's mark and bearing in mind that the stronger the similarity of the marks, the stronger the risk of unfair advantage, I am unable to find, without more, that the ability of the Opponent's mark in Jamaica to identify the goods or services for which it is registered, would be weakened by use of the Applicant's mark. I therefore am unable to find that there would be dilution of the distinctive character or reputation of the Opponent's mark.

62. Likewise, I am unable to find that the power of attraction of the Opponent's mark in Jamaica would be reduced by use of the Applicant's mark and therefore am unable to find a likelihood of tarnishment of the Opponent's mark. Similarly, I am unable to find that the Applicant's mark would take unfair advantage of the distinctive character or reputation of the Opponent's mark, as I am unable to say that use of the Applicant's mark would cause a transfer of the image of the Opponent's mark (or the characteristics which it projects) to the goods of the Applicant, resulting in clear exploitation by the Applicant on the coat-tails of the Opponent's mark.

63. I remind myself that a mere calling to mind is not sufficient without more. As stated by Kerly, "detriment to and unfair advantage of distinctive character or repute must be provable by real, as opposed to theoretical, evidence and cannot be merely assumed from the fact that the earlier mark has a substantial reputation. It cannot be presumed there is a link merely because the earlier mark is 'unique' and has a 'huge' reputation for specific goods or services" (Kerly's Law of Trade Marks and Trade Names (15th ed.), para. 9-121). There is no evidence upon which I am able to find that there is any such injury caused to the Opponent (dilution, tarnishment and/or free-riding), or a serious risk that any such injury will occur. In that event, there is no need to consider whether the Applicant's use of its mark is 'without due cause'. The Opposition therefore also fails under section 13(3) of the Act.

CONCLUSION

64. Based upon the evidence presented, the Opposition is refused for the following reasons:

- i. there does not exist a likelihood of confusion of the Applicant's mark with the Opponent's mark; and
- ii. use of the Applicant's mark would not take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark.

65. The Application is therefore accepted and the Applicant's mark shall be registered.

66. There is no order as to costs.

February 28, 2017
Marcus Goffe
for Registrar of Industrial Property