

JANSPORT VS. JOYSPORT: Trademark and “Trade Dress” confusion.

Background

JANSPORT is a trademark of U.S. origin, pioneer in the manufacturing of backpacks, bags and school products since 1967, considered nowadays one of the major manufacturers of backpacks in the world.

Client	JANSPORT
Trademark	Mix N°. 346.280. 
Granting Authority	TMO

Trademark infringement by possible confusion with joy sport products

In february 2018, we became aware that there were available for sale in an important supermarket chain JOYSPORT backpacks infringing JANSPORT intellectual property rights due to the notorious possibility of confusion and impact regarding trade dress.



After the performance of an examination, it was detected that both trademarks have the same amount of letters and ending: “Sport” and as well as sounding phonetically similar. Phonetics is a key aspect regarding possible confusion evaluation.

Moreover, between JANSPORT and JOYSPORT it exists a graphic similarity, being the trademark’s designs, and even the font style similar. The handle in both cases is black, and the front pocket and fastener are placed similarly. Being similar furthermore the place, color and shape of the front label that advertises the brand.

Other aspect that has an influence refers to the means of sale. Being presented the products in supermarket shelves or in a retail market where the trader often selects the trademark taking into account its entrepreneurial origin, increasing the risk of confusion. The above

mentioned elements prove the existence of “trade dress”, considered as the visual appearance of the product as a whole.

Trademark confusion: Jansport vs Joysport case in the trademark office

In case dated in 2002, JANSSPORT was able to demonstrate the possibility of confusion of the trademarks JANSSPORT and JOYSPORT.

In the same year the company K S.A. requested by record N°. 341.329 the registry of the trademark JOYSPORT (Word mark) at the National Industrial Property Office (DNPI) in order to protect the products under international class 18. JANSSPORT APPAREL CORP., filed opposition, based on the possibility of confusion with the trademark JANSSPORT previously registered with number N°. 258.112 and the notoriety of this trademark. The DNPI as well opposed ex officio, based on the same previous registry.

The applicant, K S.A., based its defense in the inexistence of possible confusion between the trademarks and the possibility of pacific coexistence of the trademarks in the market.

However, the DNPI was categorical in the review report presented, indicating that it was not even necessary to initiate the probatory period of the case, being that it clearly referred to a matter of confusion between trademarks.

By resolution dated in December, 4 of 2003, the DNPI rejected the registry of the trademark JOYSPORT requested by K S.A. for the products under the international 18 class, expressing:

“The opinion of the subscribed is that both the individual and the ex officio opposition need to be accepted. Indeed, according to the subscribed, the sign which registration is intended, “JOYSPORT” does not present regarding the precedent “JANSSPORT”, previously registered by record 258.112, and renewed according to record 346.280, the distinct differences required by current regulations being possible risk of confusion by the coincidence of the products regarding the international class required.”

The matter was analysed and confirmed in the second instance by the DNPI and the Ministry of Industry, Energy and Mines, in virtue of the the presentation of administrative appeals by K S.A.

**Original
Backpack
JANSSPORT**



**Infringed
backpack
JOYSPORT**



In addition, K S.A. presented a nullity action at the Administrative Contentious Court (TCA), being the action as well rejected, considering again that the possibility of confusion between JOYSPORT y JANSSPORT exists. In this respect, TCA affirmed:

“Well, it is the institution’s opinion, after performing the comparative study of the pre-registered “JANSSPORT” and the rejected “JOYSPORT” to conclude that between both it is not possible to ascertain the distinct differences referred in art. 6 of law 17.011. Particularly because a spelling, phonetic and conceptual identity of such significance is noticed, that enables to foresee, reasonably, the confusion effect that may be produced in the consumer public regarding the product origin. In this context, the prepositions “JOY” “JAN” demonstrate to be inadequate in order to endow peculiarity and originality to the rejected trademark. Such characteristics are suitable for misleading the consumer, producing the disappearance, or severely compromising the individualizing role intrinsic to every trademark.”²

In December 26 of 2005, K S.A. based on record No. 367.683 requested again the registry of the trademark JOYSPORT in international class 18, but presenting this time as well a logo, as shown in Picture 1.



JANSSPORT APPAREL CORP. opposed to the mentioned request based on the possibility of confusion with its registered trademark JANSSPORT (see Picture 2), the advantage of their prestige and the trademark’s notoriety.



K S. A. presented as defence argument this time, among other evidence the statement of the company “R IMPORTADORA Y EXPORTADORA”, which expressed:

- ▶ To commercialize since 1997, in Panama and for several countries, backpacks and bags under the trademark JOYSPORT; that said commercialization has been performed peacefully, without conflicts with other trademarks of worldwide circulation such as JANSSPORT and similar.
- ▶ That JOYSPORT trademark is properly registered under I.O. S.A. name (related company) in international class 18 in Panama, Dominican Republic, Mexico, El Salvador, Peru and Honduras.
- ▶ To sell to K S.A. backpacks and bags with the trademark JOYSPORT for many years.

In spite of the applicant’s intent to demonstrate the absence of possible confusion, the DNPI maintained its analysis criterion and dismissed by resolution dated April 28 of 2010, the registry of JOYSPORT trademark (with logo), based on confusion possibility between the trademarks, indicating in their report:

2. TCA judgement dated September 2 of 2008. “K.S.A. vs. STATE. MINISTRY OF INDUSTRY, ENERGY AND MINING AND. Invalidation Action” (Fa. N°. 86/05).

“... the mixed trademark proposed for registry “JOY SPORT” in order to protect international class 18 and the pre-registered mixed trademark “JANSPORT” with the intention to distinguish the products included in said international class, present as significant aspect of their groups, the word element, which in the trademark proposed for registry adopts a grammatical structure that is strongly related to the one in the protected trademark, which is more likely to mislead the consumer public in the claimed international class, confusion that does not disappear regarding spelling and colors included. This may produce the idea of association in the consumer public, that as well might prevent the real distinction of the requested trademark, leading them to believe that the confronted signs constitute a brand family and thus have a common origin.”³

Actions

Considering the previous trademark precedent and in light of the sale of merchandise using the trademark JOYSPORT in the Uruguayan market, in 2018 JANSPORT notified through notary the infringing business, requesting the cease of use and commercialization of the products, their immediate withdrawal from sell, the hand over of the products for destruction, as well as the reimbursement of the expenses and liquidated damages caused.

Subsequently, representatives of the business made contact with the purpose to reach an amicable settlement in this respect, informing that the backpacks had been acquired from an importing company in the local market, who had as well the intention to resolve the issue the same way. The signing of an extrajudicial settlement was possible, after several negotiations with the business and the backpack importer as well.

In the mentioned settlement, JANSPORT priority rights over its trademarks are recognized, both the business and the importer declared that they will not commercialize in the future this JOYSPORT backpacks or any similar, they will hand on their remaining stock for the purpose of its destruction and reimburse all the expenses and liquidated damages caused.

Destruction

Months ago, the destruction of the backpacks infringing JANSPORT Industrial Property rights was performed, removing all the logos and labels of the referred products.

3. Technical advice report dated March 16 of 2010. DNPI. JOYSPORT N°. 367.683.

Infringing backpacks destroyed



Conclusions

There is no specific regulation in Uruguay regarding “trade dress” figure. However, it has been increasingly used by doctrine and case law in order to provide full protection to the affected industrial property rights.

The present case is a clear example of direct confusion inasmuch as the trademarks identify the same products, so that the consumer purchases the backpack thinking that it is actually purchasing an item of the other trademark (purchases JOYSPORT thinking that it is JANSPORT).

The prescribed protection prevents customer acquisition or deviation by means of using a similar trademark, in order to distinguish similar products. Consumer protection is a key aspect of Trademark Law N°. 17.011.

It constitutes a great step regarding industrial property rights defense, preventing to take advantage of others prestige, always prevailing loyalty and good commercial will in favor of consumer rights.

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