O/1077/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003833379
BY INSANE BRANDS LTD
TO REGISTER:

INSANE
PERFUMES

AS A TRADE MARK IN CLASSES 3, 4 & 21

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 439613 BY
LEROY SANÉ

BACKGROUND AND PLEADINGS

1. On 26 September 2022, Insane Brands LTD[1] ("the applicant") applied to register the trade mark on the cover page of this decision in the UK ("the applicant's mark"). The application was published for opposition purposes on 9 December 2022 and registration is sought for the following goods:

Class 3: Perfumes; Perfume; Perfume oils; Perfumed soap; Amber [perfume]; Perfumed water; Perfumed powder; Perfumed creams; Perfume water; Perfumed soaps; Perfumed sachets; Perfuming sachets; Perfumed potpourris; Solid perfumes; Perfumed tissues; Liquid perfumes; Perfumed powders; Perfumed toilet waters; Perfumes for ceramics; Room perfume sprays; Fumigation preparations [perfumes]; Extracts of perfumes; Aromatics for perfumes; Perfumes for cardboard; Flowers (Extracts of -) [perfumes]; Perfumed lotions [toilet preparations]; Perfumes for industrial purposes; Sachets for perfuming linen; Linen (Sachets for perfuming -); Extracts of flowers [perfumes]; Natural oils for perfumes; Perfumes in solid form; Room perfumes in spray form; Cushions impregnated with perfumed substances; Perfumed body lotions [toilet preparations]; Perfumed powder [for cosmetic use]; Cushions filled with perfumed substances; Extracts of flowers being perfumes; Oils for perfumes and scents; Perfuming preparations for the atmosphere; Perfumed powders [for cosmetic use]; Perfumed oils for skin care; Essential oils as perfume for laundry purposes; Perfume oils for the manufacture of cosmetic preparations.

Class 4: Perfumed candles; Candles (Perfumed -).

[1] It is noted that the applicant's mark was originally applied for in the name of Vapour Supplies LTD but this was altered by way of a Form TM21A to Insane Brands LTD.

Class 21: Perfume bottles; Perfume atomisers; Burners (Perfume -); Perfume sprayers; Perfume burners; Perfume vaporizers; Perfume atomizers [empty]; Perfume sprays, sold empty; Perfume bottles sold empty; Perfume sprayers [sold empty]; Perfume burners [other than electric]; Vaporizers for perfume sold empty; Perfume burners, electric and non-electric.

2. On 9 March 2023, the applicant's mark was opposed b**y** Leroy Sané ("the opponent") under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is reliant upon the following trade mark:

inSané
UK registration no. 801390918[2]
Filing date 18 October 2017; registration date 5 July 2019
Relying on some goods, namely:

Class 3: Perfumery.

Class 21: Glassware, porcelain and earthenware, included in this class; busts, figures, statues and/or statuettes of porcelain, ceramic, earthenware or glass; containers for household and kitchen use (not of precious metal or coated therewith); mugs, not of precious metal; drinking bottles for sports; beer mugs; brushes and brush goods, included in this class; butter dishes; buckets; coolers (ice pails); bottles; bottle openers, electric and non-electric; combs and/or sponges; comb cases; pitchers and/or decanters, not of precious metal; cookie jars; ceramics for household purposes; corkscrews, electric and non-electric; vacuum jugs; heat-insulated containers, insulating flasks, in particular isothermic bags; cups of paper; cups of plastic; plates of paper; plates of

[2] The opponent's mark is a comparable mark based upon an International Registration designating the EU ("IR"). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IRs designating the EU. This comparable mark enjoys the same filing and registration dates as their European counterparts.

plastic; lunch boxes; signboards of porcelain or glass; soap boxes; soap brackets; soap racks; soap dispensers; non-metal coin banks; toothbrushes.

("the opponent's mark")

3. The opponent claims that the marks are highly similar and cover identical and similar goods, such that there is a clear likelihood of both direct and indirect confusion and/or association between them.

4. In filing its counterstatement, the applicant made a series of denials in respect of the claim against it. Further, the applicant argues that, despite not being registered for five years prior to the filing date for its own mark, the opponent should be required to prove that it has genuinely used its mark. I will deal with this point as a preliminary issue below.

5. The opponent is represented by Abion UK Limited (formerly Lane IP) and the applicant is unrepresented. Only the applicant filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

7. The applicant's evidence came in the form of the witness statement of Rida Azeem dated 1 December 2023. Rida Azeem is the director of the applicant. Their statement is accompanied by four exhibits, being RA1 to RA4, and was adduced to demonstrate its own use of its mark.

8. I do not intend to summarise the applicant's evidence (or submissions of the opponent, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUES

9. Before proceeding to the substance of my decision, I consider it necessary to address a number of points that the applicant has raised throughout these proceedings. I will deal with these in turn below.

Proof of use

10. As alluded to above, the applicant contends that the opponent should be required to prove that it has genuinely used its mark, despite it not being registered for five years prior to the filing date of its own mark. On this point, I note that the applicant has relied upon sections 6A(2), (3) and (4) of the Act which state as follows:

> "(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
> (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
>
> (4) For these purposes –
>
> (a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the

mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes."

11. The applicant goes on to state in its counterstatement that the bare reading of the foregoing sections of the Act clarifies that the earlier mark must have a good reputation, recognition, goodwill and usage in the UK to enjoy the status of an earlier mark. Plainly, this is incorrect. Firstly, the sections of the Act cited by the applicant require genuine use, not the existence of a reputation or goodwill.[3] Secondly, and perhaps more importantly, the applicant has omitted sections 6A(1) and (1A) of the Act, which state as follows:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application."

[3] The tests for reputation and goodwill, while similar to the issue of genuine use, are different and are based upon different legislation and case law. Neither of which are relevant here as they relate to section 5(3) and 5(4)(a) grounds, which are not at issue here.

12. Section 6A(1) and (1A) of the Act are clear in that section 6A applies only in circumstances where the earlier mark has completed its registration procedure *before* the start of the relevant period which is defined as being the five-year period that ends of the date of the application for a contested mark. In the present case, the relevant date is 26 September 2022 meaning that for the opponent's mark to be subject to the proof of use provisions, it would need to have been registered prior to 27 September 2018. As set out above, the registration date for the opponent's mark is 5 July 2019.

13. Plainly, the applicant's position in respect of this point is entirely misguided and I will say no more about it.

Other comments in the applicant's counterstatement

14. I note that, briefly, the applicant's counterstatement refers to the trade marks register and the claims that there are several live trade marks registered with the UK IPO that have the main word 'INSANE', being a prefix or suffix. I note that no evidence of the register is placed before me and, even if it were, it would have no impact upon these proceedings. I say this because, without anything further as to use on the marketplace, the mere existence of similar trade marks on the register is of no impact on these proceedings. For example, if such comments were raised in order to prove a weakening of the distinctive character of the opponent's mark due to the common use of 'insane', there is established case law that sets out that the mere existence of marks on the register is not capable of pointing to a weakened distinctive character.

15. In addition to the above, I note that the applicant referred to the fact that in examining the applicant's mark, the UK IPO did not flag up the opponent's mark as a potentially similar mark in its examination report. For the avoidance of doubt, the fact that a mark did not appear on this examination report does not mean that that mark is not capable of being confusingly similar to an applied for mark. The examination report is not intended to be an exhaustive list of all potentially similar marks that exist on the trade marks register.

The applicant's comments as to the opponent's claims

16. In its counterstatement and evidence, the applicant has made several serious claims against the opponent. While I do not intend to discuss each and every claim, I do wish to discuss one example that is indicative of how all of the applicant's claims have been raised. I do so here in order to demonstrate that the applicant's approach is plainly misguided. In its counterstatement, the applicant refers to paragraph six of the notice of opposition and argues that the opponent's claims are false, frivolous, vexatious and baseless because it is not counterfeiting or imitating the opponent's mark. In considering paragraph six of the notice of opposition, the opponent simply discusses its claim as to the existence of both direct and indirect confusion. There is no such claim as to counterfeiting or imitation and I am unclear as to why the applicant sought to defend itself in the way it did.

17. In respect of the applicant's position on this point, generally, I will say for the avoidance of doubt that while the applicant may disagree with the claims made against it (and indeed it is entitled to do so), to suggest that the claims are fabricated, vexatious, frivolous, baseless, false or misleading (being the range of various claims made against the opponent) is entirely inappropriate in the circumstances. Having considered the opponent's claim, there is nothing to suggest the opponent has sought to mislead the Tribunal or that it has raised baseless or false claims. The comments of the applicant on this point are dismissed and I will say no more about them.

The applicant's evidence of use

18. As above, the applicant has filed evidence of its own use of its mark. It does not appear clear as to why this evidence was provided. Insofar as it was adduced to prove an argument of honest concurrent use which could be a factor that points away from the existence of confusion, it will only become relevant in the event that I find that there exists a likelihood of confusion. As such, I will only address this evidence at the conclusion of my assessment of a likelihood of confusion, and only if that conclusion is that there is confusion.

DECISION

Section 5(2)(b): legislation and case law

19. Section 5(2)(b) of the Act reads as follows:

> "(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 or association with the earlier trade mark."

20. Section 5A of the Act states as follows:

> "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."

21. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

22. The opponent's mark qualifies as an earlier trade mark under the above provisions. As set out above, the opponent's mark had not completed its registration process more than five years before the filing date of the applicant's mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the goods highlighted in its notice of opposition.

23. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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 great 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 the earlier mark to mind, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

24. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 3 Perfumery.	Class 3 Perfumes; Perfume; Perfume oils; Perfumed soap; Amber [perfume];

Class 21 Glassware, porcelain and earthenware, included in this class; busts, figures, statues and/or statuettes of porcelain, ceramic, earthenware or glass; containers for household and kitchen use (not of precious metal or coated therewith); mugs, not of precious metal; drinking bottles for sports; beer mugs; brushes and brush goods, included in this class; butter dishes; buckets; coolers (ice pails); bottles; bottle openers, electric and non-electric; combs and/or sponges; comb cases; pitchers and/or decanters, not of precious metal; cookie jars; ceramics for household purposes; corkscrews, electric and non-electric; vacuum jugs; heat-insulated containers, insulating flasks, in particular isothermic bags; cups of paper; cups of plastic; plates of paper; plates of plastic; lunch boxes; signboards of porcelain or glass; soap boxes; soap brackets; soap racks; soap dispensers; non-metal coin banks; toothbrushes.	Perfumed water; Perfumed powder; Perfumed creams; Perfume water; Perfumed soaps; Perfumed sachets; Perfuming sachets; Perfumed potpourris; Solid perfumes; Perfumed tissues; Liquid perfumes; Perfumed powders; Perfumed toilet waters; Perfumes for ceramics; Room perfume sprays; Fumigation preparations [perfumes]; Extracts of perfumes; Aromatics for perfumes; Perfumes for cardboard; Flowers (Extracts of -) [perfumes]; Perfumed lotions [toilet preparations]; Perfumes for industrial purposes; Sachets for perfuming linen; Linen (Sachets for perfuming -); Extracts of flowers [perfumes]; Natural oils for perfumes; Perfumes in solid form; Room perfumes in spray form; Cushions impregnated with perfumed substances; Perfumed body lotions [toilet preparations]; Perfumed powder [for cosmetic use]; Cushions filled with perfumed substances; Extracts of flowers being perfumes; Oils for perfumes and scents; Perfuming preparations for the atmosphere; Perfumed powders [for cosmetic use]; Perfumed oils for skin care; Essential oils as perfume for laundry purposes; Perfume oils for the manufacture of cosmetic preparations.

	Class 4 Perfumed candles; Candles (Perfumed-). Class 21 Perfume bottles; Perfume atomisers; Burners (Perfume -); Perfume sprayers; Perfume burners; Perfume vaporizers; Perfume atomizers [empty]; Perfume sprays, sold empty; Perfume bottles sold empty; Perfume sprayers [sold empty]; Perfume burners [other than electric]; Vaporizers for perfume sold empty; Perfume burners, electric and non-electric.

25. Section 60A of the Act sets out that goods or services are not to be considered similar simply because they appear in the same classes. Alternatively, section 60A also states that goods or services are not to be considered dissimilar simply because they appear in different classes.

26. 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:

> "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".

27. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

28. 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 fur 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."

29. I note that the opponent has provided detailed submissions as to the similarity of the goods at issue. While I can confirm that I have given the submissions due consideration, I will proceed to consider my own comparison of the goods based on the case law cited above. In respect of the applicant's position, I note that it denied any similarity between the goods. In addition, the applicant argues that the industry that the parties operate in differ entirely. On this point, the applicant claims

that the opponent does not operate in the UK either physically or virtually. While I have addressed the point of the opponent's use above (i.e. its mark is not subject of proof of use), I will set out here that the comparison I must make is, in fact, based on the concept of 'notional and fair use' which involves carrying out the comparison of the goods based on the specifications before me, not the goods effectively provided by the parties or what markets they operate in.[4]

Class 3

30. The opponent's specification includes the broad term "perfumery" which appears in its class 3 list of goods. This term is broad enough to encompass all types of perfumery goods, be that ordinary consumer goods used on the person (such as the applicant's "perfumes" or "perfumed soap"), in the home (such as "the applicant's "room perfumers in spray form") or as part of the manufacturing process for creating perfumery products (such as the applicant's "extracts of flowers [perfumes]" or "natural oils for perfumes", for example). Regardless of the type of perfumery goods covered by the applicant's specification, I find that they all fall within the broad term of "perfumery" in the opponent's specification. As such, I find that these goods are identical under the principle outlined in *Meric* with the opponent's "perfumery".

Class 4

31. The opponent's position in respect of the applicant's class 4 goods, namely "perfumed candles" and "candles (perfumed -)", is in line with its position in respect of the class 3 goods, namely that they are identical with its own term, "perfumery". While in different classes, I note that the explanatory note of the Nice Classification for class 3 goods,[5] sets out that class 3 goods may include room fragrancing preparations. As they are products lit in the home for the purpose of improving the smell of the surrounding area (which can include rooms), I consider that perfumed candles are a type of room fragrancing preparation. As such, I find that they can

[4] See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]
[5]https://nclpub.wipo.int/enfr/?basic_numbers=show&class_number=3&explanatory_notes=show&gors=&lang=en&menulang=en&mode=flat&notion=&pagination=no&version=20240101

be said to fall within the opponent's broad term of "perfumery". Therefore, these goods are identical under the principle outlined in *Meric*.

32. In the event that I am wrong to find identity between the applicant's class 4 goods and the opponents' class 3 goods on the basis that they are in different classes so cannot, therefore describe the same goods, then I find that they are similar to at least a medium degree. I say this because even if the goods differ in nature and method of use, they share overlaps in purpose (to give off a perfumed scent), user and trade channels. Further, the goods may be competitive in that a consumer may wish to buy a scented candle (being a class 4 good) over an indoor perfumed spray (being a class 3 perfumery good), or vice versa.

Class 21

33. The opponent's position in respect of the class 21 goods of the applicant is that they are identical to its own class 21 goods, namely "glassware, porcelain and earthenware, included in this class". In the event this is not the case, the opponent offers a backup that the class 21 goods are similar to its own class 3 goods on the basis that they are complementary. While the backup position is noted, I am in agreement with the primary submissions that the applicant's class 21 goods all fall within its own class 21 goods. I say this because the class 21 term of the opponent is broad enough to cover glassware for any purpose, including the dispensation of perfume be that in the form of an atomiser, burner, vaporizer or sprayer. On this point, the goods of the applicant in this class are likely to cover those that are made of glassware but can equally be made of porcelain or earthenware. Therefore, I find that the applicant's class 21 goods, being those listed below, are all identical under the principle outlined in *Meric* with the opponent's term of "glassware, porcelain and earthenware, included in this class".

> Perfume bottles; Perfume atomisers; Burners (Perfume -); Perfume sprayers; Perfume burners; Perfume vaporizers; Perfume atomizers [empty]; Perfume sprays, sold empty; Perfume bottles sold empty; Perfume sprayers [sold empty]; Perfume burners [other than electric]; Vaporizers for perfume sold empty; Perfume burners, electric and non-electric.

The average consumer and the nature of the purchasing act

34. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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."

35. The goods at issue are ordinary consumer goods that will be selected by the general public at large and specialist goods that will be selected by business users in the perfumery industry. Members of the general public will select the goods via general or specialist retailers (such as perfume shops) and their online equivalents. In physical stores, the goods will be displayed on shelves where they will be self-selected by the consumer. When the purchase takes place online, the goods will be selected after viewing an image on a webpage. Clearly, the visual component will dominate the selection process, though I do not discount the aural component entirely as suggestions may come via word of mouth recommendations or advice from sales assistants. As for business users, these are likely to select the goods from the producers directly, be that via physical stores, online or via tele-sales. When selecting the goods in stores, I suspect they will not be placed on shelves but rather be shown on catalogues or lists. The same will apply to the online selection. As for tele-sales, these will include an aural component but will also likely take place after the consumer sees the product in a catalogue or online, for example. For business users, the visual component will dominate the selection process but, again, I consider that the aural component will still play a role.

36. Regardless of the identity of the consumer, the goods are likely to be selected on a fairly frequent basis and at a varying cost (though I do not consider that this extends to highly expensive goods). When selecting the goods, both sets of consumers are likely to consider factors such as the ingredients, the scent and whether the goods have been tested on animals. I appreciate that business users may give greater attention to these factors (for example, they are likely to consider the chemical content of the ingredients in more detail). As a result, I find that, generally, members of the general public will pay a medium degree of attention regardless of the price of the goods, mainly because they are goods that are used on the human body or in the home. As for business users, these are likely to pay a higher than medium degree of attention (though not the highest) on the basis that they are important selections to the success of their business.

Comparison of the marks

37. It is clear from *Sabel v Puma AG* (particularly paragraph 23) 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.

38. 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."

39. 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.

40. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
inSané	INSANE PERFUMES

41. In arguing that the marks at issue in these proceedings are entirely different, the applicant reproduced an example of its packaging. I do not intend to reproduce this here but will, instead, simply set out that how the applicant uses its mark on packaging is not relevant to the comparison of the marks. This is because my assessment is based on the marks as they appear before me, not how they are used by the parties. For the avoidance of doubt, this is a notional assessment and I will confirm here that marks registered as word only marks (such as the opponent's) are capable of being used in any standard typeface and in either upper case, lower case or any customary combination of the two. Further, marks registered, or sought to be registered, in black and white (being both parties' marks) are capable of being used in any colour.[6]

42. I note that additional arguments as to the meaning of the opponent's mark have been put forward by the applicant and I will address these when considering the concept of the marks below. As for the opponent, I note that he has made submissions as to the similarity of the marks, namely that they are visually and aurally similar to a high degree and that the words 'INSANE' and 'Insané' are conceptually identical.

[6] See *Superquimica v EUIPO, Case T-24/17.*

Overall impression

43. The applicant's mark is a figurative mark that consists of two words. The first is the word 'INSANE' that is presented in a large bold black typeface. The second word is 'PERFUMES', which is presented underneath 'INSANE' and in a smaller standard typeface. In the context of the goods at issue here, 'PERFUMES' is descriptive and will, therefore, play a lesser role in the overall impression of the mark. As a result, I find that 'INSANE' plays the greater role. As for the presentation of the mark (namely the different size of the words and the fact that they are stacked on top of each other), I am of the view that this will play a negligible role.

44. The opponent's mark is a word only mark that consists solely of the word 'inSané'. While registered as 'inSané', the mark can be presented as 'INSANÉ'. While a significant proportion of consumers will notice the accent above the letter 'E', I am of the view that an equally significant proportion of consumers will not. There are no other elements that contribute to the overall impression of the mark which lies in the word itself. In the present case, I consider that it is this latter group of consumers that represent the opponent's best case. On this point, I refer to the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, wherein Kitchin LJ set out that if a court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court, then it may properly find infringement. While this was an infringement case, the principle applies equally to section 5(2) oppositions. Therefore, as the consumers that will ignore the accent above the letter 'e' form a significant proportion, then I am entitled to proceed with this decision in reliance upon those. It follows that if these consumers are confused then, as per the case law discussed above, I may refuse the applicant's mark. Alternatively, as this represents the opponent's best case, it follows that if there is no confusion then there will be no confusion for the remaining group of consumers. If necessary, I will return to address this point at the conclusion of my decision.

Visual comparison

45. As set out above, word only marks are capable of being presented in upper case and in any standard typeface. Therefore, the opponent's mark can be presented as 'INSANÉ' and in the same standard typeface used by the applicant[7]. The marks are clearly identical insofar as they share the word 'INSANE'. While the marks differ in the accent above the letter 'E' in the opponent's mark, I have found that this will be overlooked. As such, the only point of visual difference comes in the word 'PERFUMES' and the presentation of the same underneath the word 'INSANE'. While these points of difference play lesser/negligible roles in the overall impression of the mark, they are still points of visual difference. Taking all of this into account, I am of the view that the marks are visually similar to a high degree.

Aural comparison

46. Despite the descriptive nature of the word 'PERFUMES' in the applicant's mark, I consider that it will still be pronounced by the average consumers. On this point, I refer to the case of *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein Mr Phillip Harris, as the Appointed Person, stated that descriptiveness of an element does not render it aurally invisible. Therefore, the applicant's mark will be pronounced in full. As such, the applicant's mark consists of four syllables that will be pronounced in the ordinary way. In respect of the opponent's mark, this is the word 'inSané'. I consider that the significant proportion of consumers that overlook the accent above the letter 'e' will pronounce the opponent's mark as the ordinary English word 'insane'.

47. In comparing the marks, the entirety of the aural element of the opponent's mark is replicated in the first two syllables of the applicant's mark. However, the marks differ in the presence of the two syllables at the end of the applicant's mark, which have no counterpart in the opponent's mark. Taking all of this into account, I am of the view that the marks are aurally similar to a medium degree.

[7] On this point, I remind myself that, as per *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, it is not legitimate to consider the comparison as if the opponent's mark was presented in the same way as the applicant's mark. However, I say this to demonstrate that the stylisation differences are not points of distinction in themselves.

Conceptual comparison

48. The applicant argues that the opponent's mark, being 'InSané' (which again, can be presented as 'INSANÉ'), is derived from the Dutch word/name 'Sané' and that it is not unique or distinctive as it is the personal/family name of the opponent. This is disputed by the opponent who, instead, claims that it is the French spelling of 'INSANE'. There is no evidence before me as to the actual meaning of this word and nothing to suggest how it will be understood by average consumers in the UK. In any event, the actual meaning of the word is not relevant here and the issue for me to decide is how the average consumer in the UK perceives it. On this point, I remind myself that the approach I have taken is based on a significant proportion of consumers who will overlook the accent above the letter 'e'. Therefore, I do not consider that these arguments are of assistance in any event and find that the concept associated with the opponent's mark will derive from the ordinary English language word' insane', which will be understood as having multiple meanings, such as *severely mentally ill, so that normal thinking and behaviour is impossible*, *irresponsible; very foolish* or *outrageous; excessive.*[8]

49. The same meaning discussed above will be associated with the first word in the applicant's mark. As for the word 'PERFUMES', this is plainly descriptive and will, therefore, have very little impact on the concept of the mark. In comparing the marks, my view is that the word 'INSANE' has an identical concept across both marks with the word 'PERFUMES' contributing to only a very slight degree. As such, I find that the marks are conceptually similar to a very high degree.

Distinctive character of the opponent's mark

50. 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

[8] https://www.collinsdictionary.com/dictionary/english/insane

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-0000, 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)."

51. 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 opponent has not filed any evidence of use and, therefore, I have only the inherent position to consider.

52. The opponent's mark consists solely of the word 'InSané'. I have focused my assessment of this mark on the consumer that will overlook the fact that the letter 'e' has an accent above it. As a result, the consumer will see it as the ordinary dictionary word 'insane'. While this has no descriptive or allusive qualities to the goods upon which the opponent relies, it is an ordinary dictionary word with a well-known meaning. As a result, I do not consider that its use from a trade mark perspective is particularly remarkable. As such, I do not consider that it is a mark that qualifies as one that enjoys a high level of distinctive character. Instead, I find that the inherent distinctive character of the opponent's mark sits at a medium degree.

Likelihood of confusion

53. 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 undertakings 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 opponent's mark, 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 they have retained in their minds.

54. I have found the goods to be identical, though I remind myself that I have found some class 4 goods to be similar to at least a medium degree in the event that I was wrong to conclude identity. The average consumer base is formed of members of the general public and business users who will select the goods via primarily visual means (although I do not discount an aural component). Members of the general public will select the goods after having paid a medium degree of attention whereas the business users will pay a higher than medium degree of attention (but not the highest). I have found the marks at issue to be visually similar to a high degree, aurally similar to a medium degree and conceptually similar to a very high degree. I have found the opponent's mark to enjoy a medium degree of inherent distinctive character.

55. Taking all of these factors into account and particularly bearing in mind the principle of imperfect recollection, I consider that the parties' marks will be misremembered or inaccurately recalled for one another. In making this finding, I refer to the fact that my assessment is based on the significant proportion of consumers that

overlook the use of the accent in the opponent's mark. Further, I remind myself that fair and notional use of the opponent's mark means that the differences in typeface are not a point of distinction between the marks. As a result of this approach, the only point of difference between them comes in the word 'PERFUMES', which sits below the common element. This is plainly descriptive of the goods at issue and plays a lesser role in the overall impression of the applicant's mark. Therefore, when the consumer is confronted by the marks whilst looking to select perfume goods or products for the dispensation of perfumes, they are likely to misremember which mark contained the descriptive word 'PERFUMES' and which did not. Consequently, I consider that there is a likelihood of direct confusion between the marks, even in circumstances where business users are paying a higher than medium degree of attention.

56. For the sake of completeness, I will proceed to consider whether there exists a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

57. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

58. In the event that the consumers are able to use the descriptive word 'PERFUMES' to accurately recall the marks for one another, I consider that they will believe that the marks originate from the same or economically connected undertakings. I say this because the word 'PERFUMES' will be understood as a reference to the range of goods in the applicant's specification and, therefore, will be seen as indicative of a sub-brand of the 'INSANÉ' brand (with the accent being overlooked) that focuses on perfume goods, ingredients and dispensers for the same. I find that consumers will readily make this connection and assume that the goods under the applicant's mark share the same source of origin as the opponent's mark, being an entity known as 'INSANÉ'. Consequently, I consider that there exists a likelihood of indirect confusion between the marks. As was the case above, I consider that this finding applies even where the consumers pay a higher than medium degree of attention.

Final remark in respect of confusion

59. As set out throughout my decision, I have taken the approach of focusing on the consumers that overlook the accent in the word 'INSANÉ'. For the avoidance of doubt, I am of the view that even where consumers do notice the accent, there still exists a likelihood of indirect confusion. I say this because the accent has very little weight visually, meaning that the marks are still highly similar. Aurally, if consumers attempt to pronounce the accent, the similarity will be lessened, however, there will still be some. As for the concept, the addition of the accent will simply inform the consumer that the word they are seeing is a foreign language word. Regardless of what language it is, the identity of the actual letters used means that consumers will understand 'INSANÉ' to be a foreign language iteration of the word 'INSANE'. When confronted by the marks in this context, I consider that consumers will believe that the opponent's mark is a brand extension of 'INSANE PERFUMES' that originates from a different country or one that uses goods sourced from that foreign country. I consider that this is particularly the case given the nature of the perfume market and the commonplace presence of foreign language brand name across the same.[9] Alternatively, I consider it likely that 'INSANE PERFUMES' will be viewed as a sub-brand of INSANE' that (1) focuses on perfumes and (2) focuses on the UK market (being an English speaking market) and, as such, has removed the accent from its name.

Honest concurrent use

60. As discussed above, the applicant's evidence includes evidence as to its own use of its mark. I discuss it at this point in the event that it was introduced to demonstrate that the applicant's ongoing use of its mark gives rise to a defence of an honest concurrent use. Firstly, I will say that the majority of the evidence is of no relevance because, for the most part, it is either undated[10] or from after the relevant date for these proceedings (being the filing date of the applicant's mark).[11]

[9] On this point, I appreciate that there is no evidence on this point, however, I consider that it is a point that I am entitled to take judicial notice on, on the basis that it is not something that will be subject to any serious dispute. See *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08

[10] See RA2 which show undated social media screenshots.

[11] See RA4 which shows invoice dated in 2023.

61. The only evidence that can be said to be from prior to the relevant date is an invoice dated 1 April 2022 from a digital marketing company for a 12-month contract for site updates, maintenance and digital marketing in relation to the website 'insaneperfumes.com'. While noted, this invoice is just five months prior to the relevant date and given that it is a 12-month contract, the majority of the activity is likely to have taken place after the relevant date. Further, and perhaps more importantly, there is nothing in the evidence that actually shows this website, its level of UK visitors or any digital marketing in relation to the same. This is the sole item of evidence that can be said to relate to activity prior to the relevant date and, without anything further, I do not consider that it is of any assistance to the applicant. On this point, I refer to *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, EU:C:2011:605 and *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch) which are cases that govern the issue of honest concurrent use. In those cases, the courts set out that for concurrent use to succeed, the use must be honest and concurrent and take place over a long period of time. That is clearly not the case in the present proceedings with the applicant's case being, at best, that it ran some advertising in the five months prior to the relevant date. Therefore, I consider that the evidence filed fails to establish that there has been parallel trade under the applicant's mark that resulted in the average consumer being accustomed to distinguishing between the entities. As a result, I am not satisfied that the likelihood of confusion would be avoided because of honest concurrent use.

CONCLUSION

62. The opposition succeeds in its entirety and the applicant's mark is, subject to any successful appeal of my decision, refused registration for all goods.

COSTS

63. The opponent has succeeded in full and, therefore, is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While I note that the opponent did not file his own evidence, he was

required to consider the applicant's evidence and, therefore, I consider it appropriate to make a costs award in respect of this task.

64. In the circumstances, I hereby award the opponent the sum of £1,400 as a contribution towards its costs. The sum is calculated as follows:

Preparing the notice of opposition and considering the counterstatement:	£400
Considering the applicant's evidence:	£600
Written submissions in lieu:	£300
Official fees:	£100
Total:	**£1,400**

65. I hereby order Insane Brands LTD to pay Leroy Sané the sum of £1,400. The above sum should 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 13th day of November 2024

A COOPER
For the Registrar