

O/537/18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003255006 BY
MONSTER ENERGY COMPANY
TO REGISTER:**

MUTANT

AS A TRADE MARK IN CLASSES 5 AND 32

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000801 BY
FIT FOODS LTD**

BACKGROUND AND PLEADINGS

1. On 6 September 2017, Monster Energy Company (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK for the goods shown in paragraph 16 below. The application was published for opposition purposes on 24 November 2017.

2. The application was partially opposed under the fast track opposition procedure by Fit Foods Ltd (“the opponent”). The opposition is based upon section 5(1) and section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the earlier European Union Trade Mark registration no. 12436291 for the trade mark MUTANT which has an application date of 13 December 2013 and registration date of 8 May 2014.

3. The following goods in class 5 are relied upon in this opposition:

Drink mixes used as a meal replacement; dietary and nutritional supplements; powder used in the preparation of dietary and nutritional supplements; dietary and nutritional supplements containing protein for building body mass; dietary supplements for body building; dietary supplements for increasing bodyweight; dietary supplements for increasing muscle mass; dietary supplements for increasing muscle mass; dietary supplements for enhancing strength; dietary supplements for enhancing sports performance; protein-based preparations; protein for use as a dietary supplement; protein powder; powdered protein supplements; protein supplements in powder form; dietary supplements for reducing body fat; dietary supplements for reducing bodyweight.

4. The opponent submits that the respective goods are identical or similar and that the marks are identical.

5. The applicant filed a counterstatement denying the claims made.

6. There is no opposition to the goods in class 32 to which the application also relates.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

9. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; neither party elected to file written submissions.

DECISION

10. Sections 5(1) and 5(2)(a) of the Act read as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected

(b) [...]

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. 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, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include 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 subsection (1) (a) or (b) subject to its being so registered.”

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Comparison of the marks

13. It is a prerequisite of both sections 5(1) and 5(2) (a) of the Act that the trade marks are identical. The applicant has denied that the goods and services for which the marks are registered are identical and has made no submissions on whether the marks themselves are identical.

14. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer”.

15. The marks in this case are both the word “MUTANT” in capitalised font. I consider that these marks are clearly identical.

Comparison of goods

16. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 5 - Drink mixes used as a meal replacement; dietary and nutritional supplements; powder used in the preparation of dietary and nutritional supplements; dietary and nutritional supplements containing protein for building body mass; dietary supplements for body building; dietary supplements for increasing bodyweight; dietary supplements for increasing muscle mass; dietary supplements for increasing muscle mass; dietary supplements for enhancing strength; dietary supplements for enhancing sports performance; protein-based preparations; protein for use as a	Class 5 – Nutritional supplements; nutritional supplements in liquid form; nutritional supplements sold as a component in a beverage; nutritional supplements sold as an ingredient in a beverage; herbal beverages; nutritional beverages; vitamin-enriched beverages; nutrient-enriched beverages; amino acid-enriched beverages; herb-enriched beverages.

dietary supplement; protein powder; powdered protein supplements; protein supplements in powder form; dietary supplements for reducing body fat; dietary supplements for reducing bodyweight.	
--	--

17. 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 für 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”.

18. For the purposes of considering the similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

19. The opponent states that all of the applicant’s goods are identical to its goods because they all fall within the meaning of “dietary and nutritional supplements”. With regard to the goods described as “nutritional supplements sold as a component in a beverage” and “nutritional supplements sold as an ingredient in a beverage”, the opponent states that these may also be considered identical to its goods described as “powder used in the preparation of nutritional supplements”. If the goods cannot be considered identical to the opponent’s goods then the opponent submits that they are similar goods.

20. “Dietary and nutritional supplements” in the opponent’s specification and “nutritional supplements” in the applicant’s specification are clearly identical. The

phrase in the opponent's specification is a broad phrase that will encompass a wide range of goods including nutritional supplements in varying forms. The goods described in the application as "nutritional supplements in liquid form", "nutritional supplements sold as a component in a beverage", "nutritional supplements sold as an ingredient in a beverage", "nutritional beverages", "nutrient-enriched beverages", "vitamin-enriched beverages" and "amino acid-enriched beverages" in my view, are more particularly described examples of the forms a nutritional supplement might take and clearly fall within the phrase in the opponent's specification highlighted above. I find that the goods are identical.

21. That leaves "herbal beverages" and "herb-enriched beverages" in the applicant's specification to consider. The average consumer will be familiar with the concept of herbs being used for their health enhancing properties and their benefit to general and dietary well-being. Such goods are, in my view, to be regarded as identical on the principle outlined in *Meric* to "dietary and nutritional supplements" in the opponent's specification.

Section 5(1)

22. I have found that the marks are identical and that all of the applicant's goods are identical to the opponent's goods.

23. The ground under section 5(1) succeeds against those goods, for which registration will be refused.

Section 5 (2) (a)

24. The opponent has sought to rely on section 5(2) (a) in the alternative and has made submissions at paragraphs 20 to 22 of its Statement of Grounds as to the similarity of the following goods (in the event that they are not considered identical):

Class 5: Nutritional beverages; nutrient-enriched beverages; herbal beverages; herb-enriched beverages; vitamin-enriched beverages; amino acid-enriched beverages

25. I will, therefore, consider whether these goods are similar if I am wrong in my finding that they are in fact identical. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The Principles

(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.

Similarity of the goods

26. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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. “Nutritional beverages” and “nutrient-enriched beverages” are clearly intended to supplement particular nutrients in the consumer’s diet in the same way as dietary and nutritional supplements. They are likely to be used by people who are looking to supplement part of their diet for whatever reason and will be purchased through the same channels as dietary and nutrient supplements. These goods are likely to be in competition with other forms of dietary and nutritional supplements. I find that these goods share a high degree of similarity.

29. There is an established link between “herbal beverages” and “herb-enriched beverages” and dietary and health enhancing properties. They are often thought to benefit general and dietary well-being. These goods may be selected as an alternative

to other dietary and nutrient supplements available on the market and so are likely to be in competition. I find that these goods share a high degree of similarity.

30. The average consumer will be familiar with the terms “vitamin” and “amino acids” as natural substances that are known to be necessary for the proper functioning of the human body. Even if the average consumer is unable to identify the exact purpose of these substances or their particular health enhancing benefits, they will identify a link between these and nutrient and dietary well-being. Consequently, I find that these goods share a high degree of similarity with the opponent’s dietary and nutritional supplements.

The average consumer and the purchasing act

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods and services are likely to be selected by the average consumer.

32. 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.”

33. The parties have made no specific submissions on the average consumer for these goods or on the purchasing process for the goods at issue. The average consumer of the goods at issue in these proceedings is a member of the general public. Purchases of goods of this nature are likely to be fairly frequent and of low cost. I would, therefore,

expect the average consumer to pay an average degree of attention during the selection process.

34. Such goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet, from a website equivalent or perhaps from a specialist catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that orders may be placed over the telephone and advice may be sought from sales assistants or representatives.

Distinctive character of the earlier trade mark

35. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case-342/97 the Court of Justice of the European Union stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or less 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).”

36. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

37. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. The opponent has made the following submission in respect of the earlier mark:

“The mark MUTANT possesses a high degree of inherent distinctiveness in relation to the goods in question, having no meaning in relation to such goods and being a word which would not usually be associated with food or drink. Indeed, the use of a word which may usually be taken to have negative connotations is both novel and fanciful in relation to the goods in question, which enhances the distinctiveness of the word”.

38. The applicant has made no substantive submissions in respect of the distinctiveness of the mark.

39. I accept that the word is not descriptive of the goods and services. However, it is a recognised word with a recognised meaning, albeit unrelated to the goods in issue. I therefore consider that the mark has a medium degree of inherent distinctive character.

Likelihood of confusion

40. 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 and services 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade 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 he has retained in his mind.

41. The marks are identical. I have found that the goods are either identical or highly similar. I have also found that the average consumer will pay an average degree of attention in selecting the goods. The higher the degree of similarity between the goods, and the lower the level of attention paid to the selection, the more likely it is that there will be confusion. I take into account that the earlier mark enjoys a medium degree of inherent distinctiveness. Having taken all of these factors into account, I consider that there is a likelihood of confusion.

CONCLUSION

42. The application is refused for the goods listed in class 5. The application will proceed to registration in respect of the goods in class 32.

COSTS

43. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Note ("TPN") 2 of 2015. Using that TPN as a guide, I award costs to the opponent on the following basis.

Preparing a statement and considering the applicant's counterstatement	£200
Opposition fee	£100

Total:

£300

44. I order Monster Energy Company to pay to Fit Foods Ltd the sum of £300. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of August 2018

S WILSON

For the Registrar