

O-571-20

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3353188
BY SHAKETASTIC LIMITED
TO REGISTER THE TRADE MARK**

COOKIE MONSTER

IN CLASSES 29, 30, 32 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 415705 BY
MONSTER ENERGY COMPANY**

BACKGROUND

1) On 13 November 2018, Shaketastic Limited (hereinafter the applicant) applied to register the trade mark COOKIE MONSTER in respect of the following goods:

- In Class 29: Frozen, preserved, and dried fruits; jellies; jams; edible oils and fats; beverages consisting principally of milk; beverages having a milk base; beverages made from or containing milk; by-products of milk; canned milk; cows' milk products; creams based on milk; dairy products being half cream and half milk; dairy products containing milk; dairy products for making milk shakes; desserts in the form of puddings with a milk base; desserts made from milk; desserts made from milk products; desserts made principally of milk; drinks based predominantly on milk; drinks containing chocolate as a favouring for milk; drinks containing cocoa as a favouring for milk; drinks flavoured with chocolate and having a milk base; drinks flavoured with fruit pastes and having a milk base; drinks flavoured with herbs and having a base of milk; drinks flavoured with spices and having a base of milk; flavoured milk; flavoured milk powder for making drinks; liquid milk; long life milk; low fat milk products; milk; milk products; milk drinks; milk products for drinking; milk shakes; milk shakes being milk beverages; mixed milk beverages; non-alcoholic milk beverages [milk predominating]; non-alcoholic milk shakes [milk predominating] containing fruit extracts; non-alcoholic milk shakes [milk predominating] containing fruit juices; non-alcoholic milk shakes [milk predominating] containing vegetable extracts; products based on milk; preparations for making milk shakes; yoghurts; weight reducing foods for non-medical use, predominantly made of non-fat milk solids and soy proteins.
- In Class 30: Coffee, tea, cocoa, sugar, preparations made from cereals, bread, pastry, confectionery, ices, honey, spices; eggs, milk, dairy products, dairy-based protein beverages in powdered form; snack foods; chocolate beverages containing milk; cocoa beverages with milk; coffee beverages with milk; drinks containing milk flavouring; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk; milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; fruit sauces.
- In Class 32: Mineral and aerated waters, fruit drinks and juices, carbonated and still non-alcoholic drinks, part frozen slush drinks; sorbets (beverages); whey beverages containing fruit

juices; fruit smoothies; smoothies; syrups and other preparations for making beverages; non-alcoholic drinks.

- In Class 43: Bar services; café services; restaurant services; juice bar services; milk shake bar services; services for providing food and drink.

2) The application was examined and accepted, and subsequently published for opposition purposes on 7 December 2018 in Trade Marks Journal No.2018/049.

3) On 7 March 2019 Monster Energy Company (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
MONSTER	UK 3254983	06.09.17 19.01.18	29	Dairy-based beverages and milk-based beverages containing coffee, chocolate and/or fruit juice; milk shakes.
			30	Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; ready to drink coffee, iced coffee and coffee based beverages; ready to drink flavored coffee, iced coffee and coffee based beverages.
			32	Energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages and other preparations for making beverages; beers.
MONSTER ENERGY	UK 3254891	06.09.17 02.02.18	29	Dairy-based beverages and milk-based beverages containing coffee, chocolate and/or fruit juice; shakes.
			30	Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; ready to drink coffee, iced coffee and coffee based

				beverages; ready to drink flavored coffee, iced coffee and coffee based beverages; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.
			32	Energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages and other preparations for making beverages; beers.
ESPRESSO MONSTER	UK 3320931	27.06.18 28.09.18	30	Coffee based beverages.
			32	Non-alcoholic beverages.
JUICE MONSTER	UK 3320933	27.06.18 28.09.18	32	Non-alcoholic beverages, including carbonated drinks and energy drinks; syrups, concentrates, powders and preparations for making beverages, including carbonated drinks and energy drinks; beer.
CAFFÈ MONSTER	EU 16257107	18.01.17 15.05.17 Priority date 19.07.16 United States of America	30	Ready to drink coffee, iced coffee and coffee based beverages; ready to drink flavored coffee, flavored iced coffee and flavored coffee based beverages.
			32	Non-alcoholic beverages.
COFFEE MONSTER	EU 17014879	21.07.17 14.03.18	29	Dairy-based beverages and milk-based beverages containing coffee, chocolate and/or fruit juice; shakes.
			30	Coffee, cocoa based beverages containing coffee; coffee-based beverages; chocolate-based beverages containing coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

			32	Non-alcoholic beverages; beer; syrups, powders and preparations for making non-alcoholic beverages.
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4) The grounds of opposition are, in summary:

- a) The opponent contends that its marks above and the mark applied for are very similar and that the goods and services applied for are identical / similar to the goods for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent also contends that it has a considerable reputation in its marks UK 3254983 & 3254891 in respect of Energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages. It states that the similarity between the marks and businesses is such that there is a likelihood of consumers assuming a link. It contends that this will enable the applicant to take unfair advantage of the opponent's reputation and free ride on its investment in promoting and advertising the brand. Use of the mark in suit will dilute and tarnish the reputation of the opponent. It contends that the mark in suit offends against section 5(3) of the Act.
- c) As a result of the use made of the signs MONSTER and MONSTER ENERGY since 2008 the opponent has acquired a substantial amount of goodwill and reputation in its marks in the UK in relation to drinks, such that the average consumer will assume that the goods and services of the applicant are those of the opponent or linked to them and therefore misrepresentation will occur. The mark in suit therefore offends against section 5(4)(a) of the Act.

5) Following a cooling off period, on 16 December 2019 the applicant filed a counterstatement, basically denying that the goods / services and marks are similar. It does not put the opponent to proof of use of its marks.

6) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither party wished to be heard on the issue and so a decision will be made from the papers. Only the opponent filed submissions which I shall take into account as and when necessary.

OPPONENT'S EVIDENCE

7) The opponent filed a witness statement, dated 12 December 2018, by Rodney Cyril Sacks the Chief Executive Officer, a position he has held since 1990. As is usual with this company the statement is a generic version not specifically geared to the instant case as it does not focus upon the marks actually relied upon by the opponent but provides evidence of use of a large number of marks which are not part of the instant case and provides details of the global position which is also irrelevant to the instant case. He states that his company sold a range of beverages including energy drinks, natural sodas, fruit juices, smoothies, lemonade and ice teas but in 2015 transferred the non-energy drink business to The Coca-Cola company, and so concentrates solely on energy drinks. The company uses three particular marks MONSTER, MONSTER ENERGY and a device element known as the "Claw Icon" (see below).



8) He states that every can of his company's Monster energy drinks has at least one of these three marks. Sales in the UK during the period September 2012 to June 2019 was Euro €949 million with a market share ranging from 8.8% to 15% over the same period. The opponent also has a significant market share of the energy drinks market throughout continental Europe. He states that the company does not advertise in the traditional manner, preferring to sponsor individuals and events such as Formula One, Moto GP, motocross, speedway, superbikes, WFC, rallying, rallycross, mountain biking, X games and musical events. The opponent provides numerous exhibits which show various sportsmen and women with the opponent's marks, in virtually all cases the one shown at paragraph 7 above, upon clothing and equipment. He also provides huge amounts of detail about the various events presumably in the mistaken belief that evidence is measured in weight rather than relevance. Suffice to say that most of the sports events are well attended and receive a combination of coverage by television, social media and press, mostly outside of the UK and the EU. The opponent also sells merchandising with this claw logo upon it.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) The first ground of opposition is under section 5(2)(b) which reads:

“5.-(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 of association with the earlier trade mark.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. As none of the opponent’s marks had been registered for five years at the time that the applicant’s mark was filed (13 November 2018), the proof of use requirements do not bite.

13) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

14) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services 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.”

15) The goods at issue in these proceedings are, broadly speaking, items of food and drink. The average consumer for such items will be the public at large including businesses. The goods at issue will typically be offered for sale in retail outlets, such as supermarkets, pubs, restaurants and cafes as well as on the internet including ordering by phone. The initial selection is therefore primarily visual. It is possible that the selection will be discussed with a member of staff or ordered over the phone. The latter, along with personal recommendations, bring aural considerations into play. Turning now to the level of attention the average consumer will display when selecting these goods, the average cost of most food and drink items is relatively low, but the average consumer will want to ensure that

whatever they consume is something which they enjoy and meets their requirements. There are a number of people with medical issues surrounding food and drink and increasingly the population is being encouraged to give more thought to the selection of the same, particularly the health aspects of the choice. **To my mind, the average consumer for such goods will be likely to pay a medium degree of attention to the selection of the goods at issue, whilst business purchasers such as hotels and restaurants will pay a higher degree of attention as their reputation and thereby livelihood depend on the quality of the food and drink served.**

16) The services at issue in these proceedings are, broadly speaking, café and restaurant services. The average consumer for such services will be the public at large. The services at issue will typically be advertised on the premises themselves, in printed media and on the internet. The initial selection is therefore primarily visual. It is possible that the selection will be as a result of personal recommendation, thus, aural considerations must also be considered. Turning now to the level of attention the average consumer will display when selecting these services, this will depend on whether the consumer simply feels hungry when out and about, in which case a spontaneous decision will be made, whereas if planning an evening out to celebrate an occasion a great deal of thought will be given to the choice of location, **but in general the average consumer is likely to pay a medium degree of attention to the selection of the services at issue.**

Comparison of goods and services

17) 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 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”.

18) 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.

19) 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”.

20) In carrying out the comparison of the goods and services I must also consider whether they might be considered complementary. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21) Whilst in *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

22) I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the GC pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

23) Thus, where the similarity between the respective goods / services is not self-evident, the opponent must show how, and in which respects, they are similar.

24) I will first consider the goods in class 29. The opponent has three marks which have goods registered in this class (UK3254983, UK 3254891 & EU 17014879). The three specifications are identical and so I shall only carry out a single comparison.

25) In my opinion the opponent's specification of "Dairy-based beverages and milk-based beverages containing coffee, chocolate and/or fruit juice; shakes" obviously encompasses the following items from the applicant's specification "beverages consisting principally of milk; beverages having a milk base; beverages made from or containing milk; by-products of milk; canned milk; cows' milk products; creams based on milk; dairy products being half cream and half milk; dairy products containing milk; dairy products for making milk shakes; drinks based predominantly on milk; drinks containing chocolate as a favouring for milk; drinks containing cocoa as a favouring for milk; drinks flavoured with chocolate and having a milk base; drinks flavoured with fruit pastes and having a milk base; drinks flavoured with herbs and having a base of milk; drinks flavoured with spices and having a base of milk; flavoured milk; flavoured milk powder for making drinks; liquid milk; long life milk; low fat milk products; milk; milk products; milk drinks; milk products for drinking; milk shakes; milk shakes being milk beverages; mixed milk beverages; non-alcoholic milk beverages [milk predominating]; non-alcoholic milk shakes [milk predominating] containing fruit extracts; non-alcoholic milk shakes [milk predominating] containing fruit juices; non-alcoholic milk shakes [milk predominating] containing vegetable extracts; products based on milk; preparations for making milk shakes; yoghurts; weight reducing foods for non-medical use, predominantly made of non-fat milk solids". These goods must be regarded as identical (*Meric*).

26) The remainder of the applicant's class 29 specification consists of "Frozen, preserved, and dried fruits; jellies; jams; edible oils and fats; desserts in the form of puddings with a milk base; desserts made from milk; desserts made from milk products; desserts made principally of milk; weight reducing foods for non-medical use, predominantly made of soy proteins". The opponent contended that of these "desserts in the form of puddings with a milk base; desserts made from milk; desserts made from milk products; desserts made principally of milk" are identical to its "dairy based beverages". Other than the fact that both contain milk it is unclear why a dessert such as a custard should be thought to be identical to a milk beverage containing coffee, chocolate or fruit juice". Their uses seem, on the face of it, very different and they would be found in different parts of a store, especially of the

pudding is tinned. I accept that some milk-based puddings maybe found in the refrigerated or freezer section relatively close to the opponent's milk beverages, and that some puddings will be coffee flavoured. I also take into account the view of the GC in Case T-736/14, *Monster Energy Company v OHIM*, where it upheld the finding of the OHIM Board of appeal that there was no similarity between coffee based beverages and confectionary/sweets. The court rejected the Appellant's argument that similarity was established by the fact the goods were sold in the same premises and share the same distribution channels. Although not absolutely on all fours with the instant case I believe that it shares enough elements and reinforces my view that, in the absence of any reasoning by the opponent, I find the applicant's goods not similar to those of the opponent.

27) The opponent contends that the term "Sauces (condiments); honey" in its class 30 specification is similar to the applicant's goods "Frozen, preserved, and dried fruits; jellies; jams" on the basis that fruit and vegetables are used in food preparation for making sauces or adding flavour or are used as spreads, and that sauces add flavour, moisture and visual appeal to a dish, and honey can be spread on bread. I am prepared to accept that "honey" and "jams" have a medium degree of similarity, also condiments would include items such as cranberry sauce made from fruit which has a degree of similarity to jam. However, I reject the opponent's other contentions and find the goods not similar. Frozen, dried and preserved fruits have a huge number of uses, not just making sauce. The contention is similar to stating that timber is similar to paper, it simply is not.

28) The opponent contends that the term "Sauces (condiments)" in its class 30 specification is similar to the applicant's goods "edible oils and fats" on the basis that both are used in cooking or consumed in foods. I disagree, the goods are not similar in nature, uses and are not in competition with each other.

29) The opponent makes no mention of the applicant's goods "weight reducing foods for non-medical use, predominantly made of soy proteins" in its submissions and I am not convinced that they are in any way similar to the opponent's goods, I find them to be not similar, but do not believe that anything turns on this point.

30) I next turn to consider the goods of the two parties in class 30. I will first compare the applicant's specification to the identical specifications found in the opponent's marks 3254891 & 17014879. The following conclusions are, in my opinion, obvious and irrefutable:

Applicant's goods	Opponent's goods	
In Class 30: Coffee, coffee beverages with milk;	ready to drink coffee, iced coffee and coffee based beverages; ready to drink flavored coffee, iced coffee and coffee based beverages;	identical
tea,	Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages;	identical
Sugar; honey	sugar, honey,	identical
preparations made from cereals, bread, pastry,	preparations made from cereals; bread, pastry;	identical
spices	spices	identical
confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk	confectionery; ices; ice	identical
fruit sauces.	sauces (condiments)	identical
cocoa, cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring;	Class 29: Dairy-based beverages and milk-based beverages containing coffee, chocolate	Highly similar

milk, dairy-based protein beverages in powdered form;	Class 29: Dairy-based beverages and milk-based beverages containing coffee, chocolate	Similar to a medium degree
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31) This leaves a few items in the applicant's specification. The first item "eggs" is not commented upon by the opponent in its submissions. To my mind, none of the goods in its specifications are in any way similar. The next term is "dairy products" which the opponent contends is similar to its class 29 specification of "Dairy-based beverages and milk-based beverages containing coffee and chocolate" as all contain milk. I accept that this is the case but there is a world of difference between the uses, physical nature etc. of milk when compared to butter or cheese. To my mind, there is at best a very low degree of similarity. The final item is "snack foods" which the opponent contends is identical to its specification of "preparations made from cereals". While I accept that some snack foods maybe made from cereals I have to also accept that snack foods are also made from vegetables, meat and fruit. There is a degree of overlap which provides a low degree of similarity.

32) The opponent also has class 30 specifications for some of the other marks relied upon, but as these mostly contain the same or highly similar wording, albeit not as extensive, the results are similar where the same wording appears. The results are as follows:

Class 30:	3254983
Coffee, coffee beverages with milk; tea; cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring; ice milk; milk.	Identical
Sugar; honey; preparations made from cereals, bread, pastry; spices; confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; fruit sauces; cocoa; dairy-based protein beverages in powdered form; dairy products; snack foods; eggs.	Not similar
Class 30: coffee beverages with milk;	3320931 & 16257107 Identical

Coffee;tea; cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring; ice milk; milk.	Highly similar
Sugar; honey; preparations made from cereals, bread, pastry; spices; confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; fruit sauces; cocoa; dairy-based protein beverages in powdered form; dairy products; snack foods; eggs.	Not similar

33) I next turn to consider the applicant's class 32 specification. In the absence of any comment by the applicant I accept that the whole of the applicant's specification of "Mineral and aerated waters, fruit drinks and juices, carbonated and still non-alcoholic drinks, part frozen slush drinks; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies; syrups and other preparations for making beverages; non-alcoholic drinks" is encompassed by the term "non-alcoholic beverages" found in the specifications of the opponent's marks 3254983, 3320931, 3320933, 16257107 and 17014879.

34) Lastly, I turn to consider the applicant's specification in class 43. The opponent quoted from R 267/2020-4, HelloFresh SE v Linea Nivnice, a.s., 13 Aug 2020, §28 and 32 as follows:

"The Court has confirmed that goods in Classes 29, 30 and 32 are complementary to services in Class 43 since such goods are used and offered in the context of restaurant, catering, bar, café, cafeteria, canteen and snack bar services and that those goods are therefore closely related to those services...

The consumers are likely to be the same (the general public) and further, they are in competition as the consumer may choose between purchasing foodstuffs or beverages and bringing them home to prepare and consume them, ordering a prepared (or ready to be prepared) meal to be delivered home and visiting a bar or restaurant."

35) The opponent contends that the opponent’s goods have a high degree of similarity to the applicant’s services. However, just because a court has reached such a conclusion does not mean that I have to adopt the same position. Each case is determined upon its own merits and I have no idea of the evidence filed or the circumstances at play in this case. I am willing to accept that the goods covered by the opponent’s marks are the type of goods (beverages including beer, and a small range of foodstuffs) sold in such establishments. Therefore, there is a degree of complementarity such that the services applied for are similar to a low to medium degree to the goods registered against the opponent’s marks.

Comparison of trade marks

36) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. 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.”

37) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The marks to be considered are as follows:

Opponent’s earlier marks		Applicant’s Mark
1	MONSTER	COOKIE MONSTER
2	MONSTER ENERGY	
3	ESPRESSO MONSTER	
4	JUICE MONSTER	

5	CAFFÉ MONSTER	
6	COFFEE MONSTER	

38) In the above table I have numbered the earlier marks as set out in the opponent's skeleton. The opponent contends:

"29. Visually, the Contested Mark is highly similar to the Earlier Trade Marks as they all incorporate the identical word MONSTER. In particular:

a) Earlier Trade Mark 1 is wholly incorporated in the Contested Mark;

b) Earlier Trade Marks 3, 4, 5 and 6 and the Contested Mark all incorporate two words where the second word is MONSTER;

c) Earlier Trade Marks 5 and 6 and the Contested Mark all incorporate two words where the first is a word beginning with the letter C and the second is the word MONSTER; and

d) Earlier Trade Mark 6 and the Contested Mark both incorporate a six-letter word beginning with the letter C at the start of the mark, followed by the identical word MONSTER.

30. There is therefore a high degree of visual similarity between the Earlier Trade Marks and the Contested Mark.

31. Aurally, the Earlier Trade Marks and the Contested Mark are highly similar as the MONSTER element of the respective marks is phonetically identical.

32. Conceptually, the MONSTER element, which is present in all Earlier Trade Marks and the Contested Mark, would be interpreted identically by the average consumer.

33. The words ESPRESSO, JUICE, CAFFÉ and COFFEE in Earlier Marks 3, 4, 5 and 6 will all be understood as relating to types or flavours of beverages. The word COOKIE in the Contested Mark relates to a specific type of food or an item of food or drink which is cookie-flavoured or contains cookies. Conceptually all of these words refer to food or drink substances. They are

therefore highly conceptually similar. Further, it is clear that the Earlier Marks and the Contested Mark coincide in the more distinctive element MONSTER.

34. It is clear from the above that the overall impression created by the Contested Mark is highly similar to the Earlier Trade Marks.”

39) To my mind this is an overly simplistic interpretation of the test which needs to be applied. I accept that all the marks above contain the word MONSTER and so there is inevitably a degree of visual and aural similarity. However, there are also visual and aural differences. The applicant’s mark has the initial word COOKIE whereas the opponent’s marks 1 & 2 both have the word MONSTER as their first word. The second word in the opponent’s mark 2 is significantly different to the first word of the applicant’s mark. The same is true of the first words in the opponent’s marks 3-6 which are completely different to that in the applicant’s mark. The marks therefore cannot be said to be highly similar visually and aurally, instead they have a low to medium degree of visual and aural similarity.

40) Turning to the issue of conceptual similarity, again the opponent simply states that the word MONSTER would be interpreted identically by the average consumer, and as the other words are all food or drink then this means they are all highly similar. Again, this is failing to take into account all the factors. To my mind, when the average consumer sees the term MONSTER it is most likely to suggest, obviously playfully, that the contents either come from a large, ugly, and frightening imaginary creature, will turn the consumer into the same or perhaps that the food and drink favoured by monsters. The opponent’s second mark consist of the two words MONSTER ENERGY, which might suggest that the food and drink items under consideration in the instant case will provide the consumer with the energy of a monster, or more simply a large amount of energy. Whilst the terms ESPRESSO, JUICE and COFFEE in the opponent’s marks 3, 4 & 6 respectively, might imply a monster which likes these types of beverages, or simply large servings of these drinks, whilst the opponent’s mark number 5 (CAFFÉ) would be seen by the average UK citizen as meaning a large building (café) which serves amongst other things, coffee.

41) Turning to consider the applicant’s mark, in my opinion, the average consumer in the UK will immediately envisage a large monster who eats cookies. This is particularly likely given that the majority of the population will be aware of the Cookie Monster from the television series Sesame St either having watched it when they were young or with their children and grandchildren. This programme featured a large blue character with an insatiable appetite, including eating inedible items

such as machines but with a penchant for cookies. As this character was known as the Cookie Monster, had a song about cookies and a catch phrase of “me want cookie” it was particularly memorable. I accept that there will be some consumers who will be unaware of the Sesame St character but these will not be a significant proportion of the UK consumer base. Further, even amongst these consumers I believe that the applicant’s mark will form an image of a cookie eating monster whereas the opponent’s marks struggle to bring such an image to mind, because usually monsters are known for eating not drinking. A monster which likes juice or coffee (of whatever type) is not easy to envisage and lacks any form of danger, unlike a voracious monster which because it likes cookies will be somewhat sizeable.

42) Taking all of the above into account I consider all of the opponent’s marks to have only a low degree of similarity to the applicant’s mark.

Distinctive character of the earlier trade mark

43) 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 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).”

44) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

45) The opponent contends:

"39. Furthermore, as can be seen from the Witness Statement and the exhibits thereto, the Opponent has acquired an enhanced degree of distinctiveness through the significant reputation it has built up in Earlier Trade Marks in relation to energy drinks."

And:

"42. It is clear from the Opponent's evidence that the Earlier Trade Marks are the subject of substantial and continuous advertising, marketing and promotion.

43. For this reason, the Opponent submits that the Earlier Trade Marks enjoy enhanced distinctive character, both per se and through the extensive use made of these marks."

46) I reject these contentions. Earlier in this decision I set out the way that the opponent's marks would be perceived. The word MONSTER has no actual meaning in relation to food and drinks, although it might be seen to relate to the size of the portion on offer. The other words in the opponent's mark ENERGY, COFFEE, JUICE etc. all have an obvious meaning for some of the items for which they are registered, although for other items such as "baking-powder; salt; mustard; vinegar, sauces (condiments); spices" terms such as COFFEE are not descriptive and could even be said to be deceptive. All of the opponent's marks are **inherently distinctive to an average degree**. Whilst the opponent has shown use of a number of marks as it only deals with energy drinks all of the use shown must be viewed as being in relation to these goods solely. Despite my criticisms of the opponent's evidence it is clear that the opponent has, under the term MONSTER acquired considerable reputation and therefore can benefit from **an enhanced distinctiveness through use for energy drinks for the marks MONSTER and MONSTER ENERGY, but none of the other marks qualify for enhanced distinctiveness**.

Likelihood of confusion

47) In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is the general public including businesses who will select the goods and services by predominantly visual means, although not discounting aural considerations and that they will pay a medium degree of attention to the selection of such goods and services, whilst business purchasers will pay a higher degree of attention.
- Overall, there is a low degree of similarity between the opponent's marks and the mark in suit.

- All of the opponent’s marks are inherently distinctive to an average degree, but only MONSTER and MONSTER ENERGY can benefit from enhanced distinctiveness through use but only in relation to energy drinks.
- My findings on the similarity of the goods and services are shown in the table below:

Applicant’s specification	3254983, 3254891 & 17014879
Class 29: beverages consisting principally of milk; beverages having a milk base; beverages made from or containing milk; by-products of milk; canned milk; cows' milk products; creams based on milk; dairy products being half cream and half milk; dairy products containing milk; dairy products for making milk shakes; drinks based predominantly on milk; drinks containing chocolate as a favouring for milk; drinks containing cocoa as a favouring for milk; drinks flavoured with chocolate and having a milk base; drinks flavoured with fruit pastes and having a milk base; drinks flavoured with herbs and having a base of milk; drinks flavoured with spices and having a base of milk; flavoured milk; flavoured milk powder for making drinks; liquid milk; long life milk; low fat milk products; milk; milk products; milk drinks; milk products for drinking; milk shakes; milk shakes being milk beverages; mixed milk beverages; non-alcoholic milk beverages [milk predominating]; non-alcoholic milk shakes [milk predominating] containing fruit extracts; non-alcoholic milk shakes [milk predominating] containing fruit juices; non-alcoholic milk shakes [milk predominating] containing vegetable extracts; products based on milk; preparations for making milk shakes; yoghurts; weight reducing foods for non-medical use, predominantly made of non-fat milk solids	Identical
jams	Medium similarity
Frozen, preserved, and dried fruits; jellies; edible oils and fats; desserts in the form of puddings with a milk base; desserts made from milk; desserts made from milk products; desserts made principally of milk; weight reducing foods for non-medical use, predominantly made of soy proteins	Not similar

<p>Class 30</p> <p>Coffee, coffee beverages with milk; tea; Sugar; honey; preparations made from cereals, bread, pastry; spices; confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk; fruit sauces.</p> <p>cocoa, cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring;</p> <p>milk, dairy-based protein beverages in powdered form;</p> <p>dairy products; snack foods</p> <p>eggs</p>	<p>3254891 & 17014879</p> <p>Identical</p> <p>Highly similar</p> <p>Similar to a medium degree</p> <p>very low degree of similarity</p> <p>Not similar</p>
<p>Class 30:</p> <p>Coffee, coffee beverages with milk; tea; cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring; ice milk; milk.</p> <p>Sugar; honey; preparations made from cereals, bread, pastry; spices; confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; fruit sauces; cocoa; dairy-based protein beverages in powdered form; dairy products; snack foods; eggs.</p>	<p>3254983</p> <p>Identical</p> <p>Not similar</p>
<p>Class 30:</p>	<p>3320931 & 16257107</p>

<p>coffee beverages with milk;</p> <p>Coffee; tea; cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring; ice milk; milk.</p> <p>Sugar; honey; preparations made from cereals, bread, pastry; spices; confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; fruit sauces; cocoa; dairy-based protein beverages in powdered form; dairy products; snack foods; eggs.</p>	<p>Identical</p> <p>Highly similar</p> <p>Not similar</p>
<p>Class 32:</p> <p>Mineral and aerated waters, fruit drinks and juices, carbonated and still non-alcoholic drinks, part frozen slush drinks; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies; syrups and other preparations for making beverages; non-alcoholic drinks</p>	<p>3254983, 3320931, 3320933, 16257107 and 17014879.</p> <p>Identical</p>
<p>Class 43:</p> <p>Bar services; café services; restaurant services; juice bar services; milk shake bar services; services for providing food and drink.</p>	<p>UK 3254983, 3254891, 3320931, 3320933, EU 16257107 & 17014879</p> <p>Similar to a low to medium degree</p>

48) I take into account the comments in *The Picasso Estate v OHIM*, Case C-361/04 P, where the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

49) I note that in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity”.

50) A similar view was also expressed in *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU). Having found that the some of the goods applied for are not in any way similar to the goods of the opponent then the ground of opposition must fail in relation to those goods identified above in the last bullet point of paragraph 47.

51) I also have to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, 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.

52) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

53) Taking into account all of the factors identified earlier, and allowing for the concept of imperfect recollection, I find that in relation to the following goods there is a likelihood of consumers being indirectly confused into believing that the goods listed below and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in relation to the following goods:**

Class 29: beverages consisting principally of milk; beverages having a milk base; beverages made from or containing milk; by-products of milk; canned milk; cows' milk products; creams based on milk; dairy products being half cream and half milk; dairy products containing milk; dairy products for making milk shakes; drinks based predominantly on milk; drinks containing chocolate as a favouring for milk; drinks containing cocoa as a favouring for milk; drinks flavoured with chocolate and having a milk base; drinks flavoured with fruit pastes and having a milk base; drinks flavoured with herbs and having a base of milk; drinks flavoured with spices and having a base of milk; flavoured milk; flavoured milk powder for making drinks; liquid milk; long life milk; low fat milk products; milk; milk products; milk drinks; milk products for drinking; milk shakes; milk shakes being milk beverages; mixed milk beverages; non-alcoholic milk beverages [milk predominating]; non-alcoholic milk shakes [milk predominating] containing fruit extracts; non-alcoholic milk shakes [milk predominating] containing fruit juices; non-alcoholic milk shakes [milk predominating] containing vegetable extracts; products based on milk; preparations for making milk shakes; yoghurts; weight reducing foods for non-medical use, predominantly made of non-fat milk solids; jams.

Class 30: Coffee, coffee beverages with milk; tea; Sugar; honey; preparations made from cereals, bread, pastry; spices; confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being

milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk; fruit sauces; cocoa, cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring; milk, dairy-based protein beverages in powdered form.

Class 32: Mineral and aerated waters, fruit drinks and juices, carbonated and still non-alcoholic drinks, part frozen slush drinks; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies; syrups and other preparations for making beverages; non-alcoholic drinks.

54) I also find that in relation to the following goods there is no likelihood of consumers being directly or indirectly confused into believing that the goods and services listed below and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails in relation to the following goods and services:**

Class 29: Frozen, preserved, and dried fruits; jellies; edible oils and fats; desserts in the form of puddings with a milk base; desserts made from milk; desserts made from milk products; desserts made principally of milk; weight reducing foods for non-medical use, predominantly made of soy proteins.

Class 30: dairy products; snack foods; eggs.

Class 43: Bar services; café services; restaurant services; juice bar services; milk shake bar services; services for providing food and drink.

55) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

56) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

57) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade marks enjoy a reputation or public recognition. In the instant case I found earlier in this decision that the opponent has reputation in respect of energy drinks in respect of its marks MONSTER and MONSTER ENERGY only.

58) I next have to consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

59) The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

60) Earlier in this decision I found that the opponent’s mark 3254983 MONSTER and 3254891 MONSTER ENERGY are similar to a low degree to the mark sought to be registered by the applicant. However, under this ground of opposition the opponent can only rely upon energy drinks. The opponent has not shown any evidence of why such a niche product would be regarded as similar to the more “mundane” goods and services sought to be registered by the applicant. It is clear from the opponent’s evidence that the energy drinks market is a distinct and separate sector within the overall food and drinks sector. The opponent has also not made any submissions as to why the goods of its client should be regarded as similar to those applied for, other than in the most generalised terms. To my mind the two parties are not in direct competition. This dissimilarity is not fatal to the opponent’s

case but is a factor I have to take into account in reaching my conclusion. Nor has the opponent provided evidence to suggest that it is common in trade for energy drinks providers to also provide the type of food and drink items or services applied for by the applicant. Based upon my own experience the applicant's goods in classes 29 and 30 would be in different parts of a supermarket and not in direct competition with the opponent's energy drinks. There is a degree of overlap within the applicant's class 32 products applied for and the opponent's energy drinks. The terms "carbonated and still non-alcoholic drinks" and "non-alcoholic drinks" must incorporate energy drinks. To my mind, if a member of the public saw the applicant's mark upon "carbonated and still non-alcoholic drinks" and "non-alcoholic drinks" they would make the link to the opponent. **The ground of opposition under section 5(3) succeeds in relation to "carbonated and still non-alcoholic drinks" and "non-alcoholic drinks" in class 32 applied for by the applicant:**

61) However, in my opinion, despite the fact that the users are the same and the opponent's reputation, if a member of the public saw the applicant's mark upon all the other goods and services applied for by the applicant they would not immediately make the link to the opponent. **The ground of opposition under section 5(3) fails in relation to the following goods and services applied for by the applicant:**

- Class 29: All goods.
- Class 30 All goods.
- Class 32: Mineral and aerated waters, fruit drinks and juices, part frozen slush drinks; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies; syrups and other preparations for making beverages.
- Class 43: Bar services; café services; restaurant services; juice bar services; milk shake bar services; services for providing food and drink.

62) The last ground of opposition is under section 5(4)(a) which reads:

"5.(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

63) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

64) Whilst Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

65) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

66) In *Lumos Skincare Limited v Sweet Squared Limited and others [2013] EWCA Civ 590*, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

67) Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

68) On the question of proof of misrepresentation Morritt L.J., in *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, stated that:

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

69) I also take into account the difference between mere confusion and deception in passing-off cases as set out in *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), where Mr Iain Purvis QC, as a Recorder of the Court stated that:

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”

70) The opponent is relying upon its signs MONSTER and MONSTER ENERGY which have been used in relation to energy drinks in the UK and continental Europe, and the marks have goodwill and reputation in relation to these products. The opponent’s evidence shows that energy drinks form a distinct sector in the overall food and drinks industry. The applicant’s specification only partly stays into this sector under its class 32 specification of “carbonated and still non-alcoholic drinks” and “non-alcoholic drinks”. However, under this ground of opposition there is no necessity for the parties to be engaged in the same field of activity. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been

deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’: *Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per Russell L.J..”

71) I also take note that in the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in

truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

72) To my mind, use of the mark in suit, actual or on a fair and notional basis, on the goods in classes 29 and 30 and services in class 43 would not result in the necessary misrepresentation required by the tort of passing off occurring. Similarly, when the mark in suit were to be used in the following goods in class 32 (Mineral and aerated waters, fruit drinks and juices, part frozen slush drinks; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies; syrups and other preparations for making beverages) again no misrepresentation would occur. **The opposition under Section 5(4)(a) of the Act must fail in relation to these goods and services applied for by the applicant.**

73) However, if the mark in suit were to be used upon the following class 32 goods: **"carbonated and still non-alcoholic drinks"** and **"non-alcoholic drinks"** then the necessary misrepresentation required by the tort of passing off would occur. The applicant has not provided any evidence of use of its mark. In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* [1939] 56 RPC 429 Goddard L.J. stated:

"But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man's business has been interfered with by the passing-off of goods, damage

results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

74) Consequently in the instant case if the applicant has established a goodwill and shown deception then damage can be considered as the automatic sequitur and the three elements of the classic trinity of passing-off will have been established. **The opposition under Section 5(4)(a) of the Act must succeed in relation to these goods applied for by the applicant.**

CONCLUSION

75) The opponent’s evidence makes it abundantly clear that they are interested only in the energy drinks sector, a statement reinforced by the fact that the opponent divested itself of all other holdings involved in sectors other than energy drinks. Because the applicant in this instance did not seek to invalidate the registrations as having been applied for in bad faith I have no alternative than to regard the opponent’s earlier marks as having been legally registered and to provide them with the protection required by the relevant law. As a result, the opponent has successfully opposed the following goods which will be removed from the application:

- Class 29: beverages consisting principally of milk; beverages having a milk base; beverages made from or containing milk; by-products of milk; canned milk; cows' milk products; creams based on milk; dairy products being half cream and half milk; dairy products containing milk; dairy products for making milk shakes; drinks based predominantly on milk; drinks containing chocolate as a favouring for milk; drinks containing cocoa as a favouring for milk; drinks flavoured with chocolate and having a milk base; drinks flavoured with fruit pastes and having a milk base; drinks flavoured with herbs and having a base of milk; drinks flavoured with spices and having a base of milk; flavoured milk; flavoured milk powder for making drinks; liquid milk; long life milk; low fat milk products; milk; milk products; milk drinks; milk products for drinking; milk shakes; milk shakes being milk beverages; mixed milk beverages; non-alcoholic milk beverages [milk predominating]; non-alcoholic milk shakes [milk predominating] containing fruit

extracts; non-alcoholic milk shakes [milk predominating] containing fruit juices; non-alcoholic milk shakes [milk predominating] containing vegetable extracts; products based on milk; preparations for making milk shakes; yoghurts; weight reducing foods for non-medical use, predominantly made of non-fat milk solids; jams.

- Class 30: Coffee, coffee beverages with milk; tea; Sugar; honey; preparations made from cereals, bread, pastry; spices; confectionery ices, milk chocolate; milk chocolate bars; milk chocolate teacakes; non-medicated confectionery containing milk; ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk ice cream containing milk; ice lollies being milk flavoured; ice lollies containing milk; ice milk bars; ice milk sandwiches; ice milk stick bars; ice milk; fruit sauces; cocoa, cocoa beverages with milk; chocolate beverages containing milk; drinks containing milk flavouring; milk, dairy-based protein beverages in powdered form.
- Class 32: Mineral and aerated waters, fruit drinks and juices, carbonated and still non-alcoholic drinks, part frozen slush drinks; sorbets (beverages); whey beverages containing fruit juices; fruit smoothies; smoothies; syrups and other preparations for making beverages; non-alcoholic drinks.

76) However, the opposition failed under all grounds in relation to the following goods and services which will therefore continue to registration:

- Class 29: Frozen, preserved, and dried fruits; jellies; edible oils and fats; desserts in the form of puddings with a milk base; desserts made from milk; desserts made from milk products; desserts made principally of milk; weight reducing foods for non-medical use, predominantly made of soy proteins.
- Class 30: dairy products; snack foods; eggs.
- Class 43: Bar services; café services; restaurant services; juice bar services; milk shake bar services; services for providing food and drink.

COSTS

77) As the opponent has been mostly successful it is entitled to a contribution towards its costs. However I have reduced the amount awarded as the evidence filed by the opponent was not strictly focussed upon the instant case with large amounts of extraneous material. I also found the submissions to be overly generalised and lacking in specifics and not particularly useful in reaching my decision.

Preparing a statement and considering the other side's statement	£300
Expenses	£200
Preparing evidence	£200
Submissions	£100
TOTAL	£800

78) I order Shaketastic Limited to pay Monster Energy Company the sum of £800. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of November 2020

George W Salthouse
For the Registrar,
the Comptroller-General