

**O-483-15**

**TRADE MARK ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3065281  
BY JOULE'S BREWERY LTD**

**TO REGISTER THE TRADE MARK:**



**GREEN  
MONKEY**

**IN CLASSES 32 AND 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 403239  
BY KLOSTERBRAUEREI WEIßENOHE GMBH & CO. KG**

## BACKGROUND

1. On 22 July 2014 Joule's Brewery Ltd ("the applicant") applied to register the mark shown on the cover page of this decision in respect of the following goods:

### **Class 32**

*Beers*


### **Class 33**

*Beverages (Alcoholic), except beer*

2. The application was published for opposition purposes on 15 August 2014.

3. The application was subsequently opposed by Klosterbrauerei Weißenohe GmbH & Co. KG ("the opponent") on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is directed against all of the goods in the application.

4. The opponent relies upon the earlier Community Trade Mark (CTM) shown below:

<b>Mark details</b>	<b>Goods relied upon</b>
<p><b>CTM 012840906</b></p>  <p><b>Colours claimed:</b> Shades of green, white, black.</p> <p><b>Filing date:</b> 2 May 2014</p> <p><b>Date of entry in the register:</b> 11 September 2014</p>	<p><b>Class 32</b> <i>Beer and brewery products; Non-alcoholic beverages; Preparations for making beverages.</i></p> <p><b>Class 33</b> <i>Alcoholic beverages (except beer); Preparations for making alcoholic beverages.</i></p>

5. The applicant filed a counterstatement in which it denies the basis of the opposition.

6. During the course of the evidence rounds the opponent filed submissions and the applicant filed evidence. In response to this evidence, the opponent filed written submissions in reply. Neither side asked to be heard, nor did they file written submissions in lieu of attendance at a hearing. I make this decision following a review of all the material before me.

## **EVIDENCE**

7. The applicant's evidence consists of a statement by Steven Nuttall, who is the managing director of the applicant, and two accompanying exhibits; it is dated 19 May 2015. Although given in the form of evidence, Mr Nuttall's statement contains a mixture of submissions and evidence of fact. So far as concerns the evidence, in paragraph 13-16, under the heading "Earlier use", Mr Nuttall outlines the history of the applicant's mark and claims that the applicant has an earlier right, on the footing that the first design of its mark was created before the opponent filed an application for its own mark. On that basis, Mr Nuttall opines that the opponent's mark could be vulnerable to cancellation. Exhibit SN2 effectively records that the applicant received the first design of its mark by email on 15 November 2013.

8. The issue of earlier use has no bearing upon the instant proceedings. Tribunal Practice Notice 4/2009 "Trade mark opposition and invalidation proceedings – defences", under the heading "The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark", outlines the approach. It states:

"4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

9. As far as I am aware, at no time did the applicant seek to invalidate the opponent's earlier mark, thus, the existence of a prior right is irrelevant to the issue I have to decide.

10. The rest of the witness statement cannot be considered to be evidence but rather commentary and legal submissions. Its content has been noted and will, along with other submissions, be referred to, if appropriate, during this decision.

## **DECISION**

11. Section 5(2)(b) of the Act states:

"5(2) A trade mark shall not be registered if because-

(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”.

12. An earlier trade mark is defined in Section 6 of the Act, 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 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) Reference 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.”

13. Given its date of filing, the opponent’s mark constitutes an earlier mark in accordance with Section 6 of the Act. The earlier mark had not been registered for more than five years at the date on which the applicant’s mark was published meaning that the proof of use provisions contained in Section 6A do not apply. The opponent can, as a consequence, rely upon all of the goods it has identified.

### **Section 5(2)(b) case law**

14. 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.

### **The correct approach**

15. In its counterstatement, the applicant contends that its trade is limited to a specific segment of the market, i.e. to its own pubs and a limited number of free trade houses, and geographically restricted to three counties within the UK. Further, in his statement, Mr Nuttall disputes the opponent's claim that it is using its mark in the UK.

16. These arguments are not relevant. Since the opponent's mark is less than five years old, it is entitled to rely on it for all the goods for which it is registered without needing to prove anything. The comparison I have to make is a notional one, based on the specifications as registered and for which registration is applied. So far as the applicant's alleged geographically limited use of its mark is concerned, this may be the reality at the present, however, the specification, as applied for, is not limited in any way and the opponent's registration covers the entire territory of the EU,

including the UK. Therefore, the matter must be considered from the perspective that there is potential for the parties to target the same segment of the market and for their goods to be sold in the same places.

17. Likewise, I have not placed any reliance on Exhibit SN1 and Mr Nuttall’s statement showing the “greenMONKey” mark on the opponent’s website where it appears with a coloured band around it. To do that would go beyond the mark to mark comparison that is required under Section 5(2)(b).

**Comparison of goods**

18. The goods to be compared are as follow:

<b>Opponent’s goods</b>	<b>Applicant’s goods</b>
<p><b>Class 32</b> Beer and brewery products; Non-alcoholic beverages; Preparations for making beverages.</p> <p><b>Class 33</b> Alcoholic beverages (except beer); Preparations for making alcoholic beverages.</p>	<p><b>Class 32</b> Beers</p> <p><b>Class 33</b> Beverages (Alcoholic), except beer</p>

19. In its Notice of Opposition, the opponent states that both marks “are directed to identical goods namely beers and alcoholic beverages”, an assertion that is not contested by the applicant. The applicant’s goods are, self-evidently, identical to some of the goods encompassed by the opponent’s specification, namely “Beers” in the applicant’s specification are identical to “Beer and brewery products” in the opponent’s specification and “Beverages (Alcoholic), except beer” in the applicant’s specification are identical to “Alcoholic beverages (except beer)” in the opponent’s specification.

**Average consumer**

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected 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.”

21. Both parties commented on both the degree of care paid by the average consumer when purchasing the goods at issue and the way these goods are ordered and sold. In its submissions, the opponent states, inter alia:

“As supported by the applicant’s description of the use of their trade mark, it appears to be common ground that the goods [...] are primarily bought by the average consumer in drinking establishments such as public houses and bars.

The average consumer is likely to be the general public that are 18 years old or over. The level of attention the average consumer will display when selecting the goods is likely to be low as the cost of the goods is likely to be relatively low.

Where supplied as draught, alcoholic drinks are usually either unseen by the consumer, or where bottled positioned behind the bar where viewed by the consumer from a distance, often in dim lighting. It is also common practice that goods of this nature are ordered in rounds so that one person will take an order from a group. In such situation the order will typically be made orally both by the members of the group to the designated person taking the round, and by the designated person making the order at the bar. The members of the group, if provided with the drink in draught form, will have no opportunity to visually inspect the mark, or in the case of bottled drinks may not be able to visually inspect the bottle until after it has been opened, when it is potentially non-returnable. In addition, it is common, where drinks are provided on a menu, to be written without include (sic) of stylisation or logos that may be associated with the brand.”

22. Contrary to the opponent’s contentions, the applicant claims that the average consumer is very sophisticated and that visual considerations are important. Its comments are limited to non-mainstream beers. It states:

“9. [the opponent’s view] does not take any account of the way in which the (certainly UK) beer market operates. For non-mainstream beers, customers are incredibly choosy. They tend to stick to a style of beer that they like, such as bitter, larger or wheat beer. Even within that type of beer a customer will often have a style of beer that they generally stick to [...]

10. The brewery name and reputation also plays a very important part in the customer’s reason for choosing a particular beer in this independent/craft beer/real ale market. The brand of a particular type of beer is often secondary to the fact that the beer comes from a particular brewery.

11. Moreover, I would submit that alcoholic drinks provided in draught format, principally beers, ales and lagers, are normally always situated at the front the bar and as such, they can be clearly seen by the purchasing public. The Opponent’s comment that drinks ordered in bottle form does not give the drinker the chance to visually inspect the bottle does not make sense, as bottles always come labelled and the label is not removed before its content is consumed.

12. If [...] the Applicant's and the Opponent's two products were on sale side by side, the customer would most likely first look to see which brewery the products were from, then consider the type of beer the products were (including the style of beer, alcohol content and things of that nature) often the customer will ask to try the beer first and then a decision will be made. [...]"

23. The goods of both marks consist of beers and alcoholic beverages. The average consumer of the goods concerned is the adult general public. Although these goods are, of course, sold in bars, public houses and restaurants, as indicated by the parties, they are also commonly sold through other trade channels, such as supermarkets, off-licences and websites.

24. As to the perception of the marks, the purchase is primarily visual; the average consumer will either visually self-select the goods from a shelf (or its online equivalent) in a supermarket/off-licence (or from a website) or scan the goods from shelves, fridges, optics and hand pumps/taps in bars and restaurants. However, I do not discount the potential for aural considerations, as goods may be ordered orally from a member of staff.

25. Bearing in mind the relatively low cost of beer and the frequency of the purchase, and given that the parties' specifications cover the general term 'Beer(s)' in class 32, which encompasses both mass-produced and handcrafted beers, I cannot accept the applicant's argument that the average consumer is a sophisticated one and I consider that the average consumer in the category of beer will pay a medium degree of attention instead. In relation to the remaining goods, both specifications include the broad term 'alcoholic beverages' in class 33, to which familiar considerations apply and whose cost is generally reasonable, giving rise, again, to a medium level of attention being paid.

### **Comparison of marks**

26. 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 Court of Justice of the European Union (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."

27. It would be wrong, therefore, artificially to dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the



marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. The respective marks are shown below:

Opponent's mark	Applicant's mark
	

### Overall impression

29. The applied for mark consists of the device of a monkey silhouette in a seated position, merged with a stylised capital letter “G” and the sequence “REEN MONKEY” in bold upper case, all in the colour green. Although the letter G blends together with the monkey silhouette, this does not prevent the word (GREEN) from being read clearly. I am fortified in this conclusion by the applicant’s own submission that its mark consists of the words “GREEN MONKEY”, which confirms my first impression of the mark.

30. The dominant element of the applied for mark is the phrase “GREEN MONKEY” on account of its prominent position. Although the word “GREEN” is in a larger font size than the word “MONKEY” and is positioned above it, none the less, the words combine to create a phrase that “hangs together” so they are perceived as a unit. As one word qualifies the other, it cannot be said that the element “GREEN” is, in the overall impression, predominant, contrary to what the applicant contends. The figurative element of a monkey and the colour (green) reinforce the message conveyed by the mark. Although the monkey device creates a striking visual impact and plays a role in the overall impression, it is the element “GREEN MONKEY” that plays the slightly greatest role.

31. Turning to the earlier mark, it consists of a number of elements, namely, the word “green” in lower case in white; the word “MONK” in upper case, in green and in a larger font size, the letters “ey” in lower case, in white and in the same size as the word “green”. The mark also contains the depiction of a monk and a monkey in black, but with some interior white features. The monk is depicted holding upright a long stick wrapped by a hop and the monkey seems to be climbing to reach the hop.

These elements are presented against a green circular background, which, on close inspection, also includes a device that appears to be heraldic in nature.

32. The word “MONK”, although incorporated within the phrase “greenMONKey”, is visually separated and stands out from it, owing to its size and colour. On this point, the applicant contends that:

“4...it is not initially evident that it is GREEN MONKEY by the use of lower case and upper case lettering. In fact, the word MONK [...] is the most prominent feature of the wording, preceded by the images of the monk and the monkey. When examining the mark, one’s gaze is drawn firstly to the imagery and then to the word MONK.”

33. I do not agree with the applicant. While the word “MONK” is placed in an eye-catching position because the sequences “green” and “ey” are proportionally smaller, and their colours form less of a contrast, this does not alter the fact that the phrase “greenMONKey”, which hangs together as a unit, will also strike the eye. The typographic presentation of the phrase, although unusual, still follows the order the average consumer reads (from left to right) and, consequently, it is unlikely that the word “green” and letters “ey” will not be perceived or read. It follows that the phrase “greenMONKey” cannot be relegated to the point that it is secondary in the overall impression. The use of upper and lower casing, which, in my experience, the average consumer is accustomed to seeing in marks, will not prevent it from grasping the meaning of “green monkey”, a meaning that is sufficiently clear and precise. Further, owing to its contrasting colours, its slightly off-centre upper position and its size, the phrase “greenMONKey” has a particular visual attraction that will catch the average customer’s eye, enabling it to recognise the pun on words and understand both semantic elements, i.e. “green monkey” and “MONK”.

34. The figurative representation of the monk and the monkey play an equally important role in the overall impression, as the words and the devices reinforce one another. The green circle and what appears to be the heraldic device are likely to have very little relative weight upon the perception of the average consumer because the heraldic device cannot be easily discerned and the green circle merely acts as a background. In my view, the words “greenMONKey” and the devices of a monk and monkey will have a roughly equal part to play in the overall impression the mark conveys.

### **Visual similarity**

35. On the visual similarity, the applicant contends that its mark’s dominant colour is green, while the opponent’s mark “contains different shades of green and white, although the predominant feature of the mark is the Device of the Monk, which is in black”. Colour is part of both marks (indeed the opponent claims, inter alia, “shades of green” as part of its mark) and in considering the visual similarity, I have taken this aspect into account but, in my view, it has no great significance either way. In my view, given the presence in both marks of phrases that will be perceived as “green monkey” but bearing in mind the various graphic differences, there is a low degree of visual similarity.

## **Aural similarity**

36. The average consumer is unlikely to articulate the figurative elements in the marks at issue. As these elements are not verbalised, they are not subject to phonetic assessment. Both marks are, in my view, most likely to be referred to as GRI-N--MUN-KEE and are, therefore, phonetically identical. Although I cannot exclude that, given the use of upper and lower case lettering, some consumers may articulate the opponent's mark as MUN-K or even GRI-N--MUN-K, I have no doubt that a significant part of the public will articulate the mark as GRI-N--MUN-KEE.

## **Conceptual similarity**

37. The average consumer will perceive the phrase "green monkey" in both marks. That creates a conceptual similarity, albeit the earlier mark will also convey the concept of a monk (being green or otherwise) which has no counterpart in the applied for mark. Overall, I find that there is a reasonably high degree of conceptual similarity.

## **Distinctive character of the earlier mark**

38. The distinctive character of a mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of the use made, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). The distinctive character of a mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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).”

39. Despite the parties' comments about the use of the marks, all indicating that the competing marks are actually in use, no evidence has been filed. As a consequence, I have only the earlier mark's inherent characteristics to consider.

40. The phrase "greenMONKey" has no specific meaning in relation to the goods in question. As noted by both parties in their submissions, the association between the concept of a "green monkey" with the goods at issue is fanciful and, in my view, it gives this aspect of the mark a reasonably high distinctive character per se. Although the distinctiveness is further enhanced by the other elements of the mark (i.e. the pun on the word "MONK", the depiction of a monk and a monkey, the striking presentation and the contrasting colours) this added distinctiveness is not relevant because in terms of increasing the likelihood of confusion, it is the distinctiveness of the common element that is the key<sup>1</sup>.

### **Likelihood of confusion**

41. 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

42. Earlier in this decision, I found that:

- the parties' goods are identical;
- the average consumer is the adult general public who will pay a medium level of attention. The purchase is primarily visual, although aural considerations play a role;
- the competing marks are visually similar to a low degree, potentially aurally identical and conceptually similar to a reasonably high degree;
- the common element in opponent's earlier mark is possessed of a reasonably high degree of distinctive character.

43. The opponent's and the applicant's arguments in support and against a finding of likelihood of confusion revolve around two issues: the aural similarity and the visual differences between the signs respectively. In particular, the opponent has drawn my attention to case C-342/97, in which it was held that "mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) of the Directive", which corresponds to section 5(2)(b) of the Act.

44. Whilst I note the above case law, that is not to say that aural similarity will always carry the day. Assessment of aural similarity is only part of the equation and it does

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<sup>1</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 39-40

not always have the same weight<sup>2</sup>. The outcome in any particular case will depend on the importance (or otherwise) of aural considerations in relation to the goods in question and a global assessment of all the relevant facts of the case<sup>3</sup>.

45. The competing marks in this case are potentially aurally indistinguishable and share the same concept of a “green monkey”. However, there are very clear visual differences and the opponent’s mark contains an additional element (the monk) which is unlikely to go unnoticed. I consider that, in the context of visual contact with the marks, which I found to be the primary means by which the average consumer will encounter the goods, the conceptual difference (created by the monk element in the opponent’s mark) and the visual differences between the marks are sufficient to prevent direct confusion (one mark being mistaken for another).

46. That being the case, the question is whether, nevertheless, there would be indirect confusion. In reaching a conclusion on this point, I remind myself of the finding of Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he stated:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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

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

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

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<sup>2</sup> *New Look Ltd v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 49

<sup>3</sup> *P Mulhens GmbH & Co KG v OHIM*, Case C-206/04

47. Earlier in this decision, I found that both marks conjure up the image of a “green monkey”, an image that is highly distinctive for the goods at issue. In the opponent’s mark, the “green monkey” message is conveyed in a more subtle fashion, since it is combined with the concept of a monk. Whilst the monk element (word and device) has a significant visual impact, it does not affect the meaning and significance that the average consumer is likely to attach to the “greenMONKey” element within the context of the opponent’s mark as a whole.

48. This similarity, despite the differences, will result in an expectation on the part of the average consumer that the identical goods at issue come from the same or linked undertaking(s). In the words of Mr Purvis, “the common element is so strikingly distinctive ....that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all”. There is a likelihood of indirect confusion. The opposition succeeds.

### **Conclusion**

49. The opposition has succeeded.

### **Costs**

50. The opponent has been successful, and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fees: £100

Preparing a statement and considering the other side’s statement: £200

Written submissions: £300

**Total: £600**

51. I order Joule’s Brewery Ltd to pay Klosterbrauerei Weißenohe GmbH & Co. KG the sum of £600 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 19th day of October 2015**

**Teresa Perks  
For the Registrar  
The Comptroller - General**