

O-096-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3148565
BY COLD BLACK LABEL LIMITED
TO REGISTER**



**AS A TRADEMARK
IN CLASS 32
AND OPPOSITION THERETO (UNDER NO.406700)
BY
MONSTER ENERGY COMPANY**

BACKGROUND AND PLEADINGS

1. On 8 February 2016 Cold Black Label Limited ('the applicant') applied to register the following mark for **ales** in class 32.



2. The application was published on 4 March 2016 and was opposed by Monster Energy Company ('the opponent').

3. The opponent filed for opposition against all goods in class 32 on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act') and relies on four European trademarks, the details of which are set out below:

| Mark details and dates | Goods |
|--|--|
| EUTM no. 12251898 PUMP UP THE BEAST! Filed: 24/10/13 Registered: 11/4/14 | Class 32: non-alcoholic beverages |
| EUTM no. 10649184 REHAB THE BEAST! | Class 32: beverages, namely, carbonated soft drinks; non-alcoholic carbonated and non –carbonated drinks |

| | |
|---|--|
| <p>WWW.MONSTERENERGY.COM</p> <p>Filed: 16 February 2012 Registered: 5 March 2014</p> | <p>enhanced with vitamins, minerals, nutrients, proteins, amino acids and/or herbs; energy or sports drinks; fruit juice drinks.</p> |
| <p>EUTM no. 13389002</p> <p>UNLEASH THE CAFFEINE FREE BEAST!</p> <p>Filed: 21/10/14 Registered: 4/3/15</p> | <p>Class 32: non-alcoholic beverages</p> |
| <p>EUTM no. 13628383</p> <p>UNLEASH THE NITRO BEAST!</p> <p>Filed: 8/1/15 Registered: 21/5/15</p> | <p>Class 32: non-alcoholic beverages; beer</p> |

4. The opponent states that the parties' marks and their goods in class 32 are similar. They claim that there is a likelihood of confusion.

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

6. The opponent's trademarks are earlier marks, in accordance with Section 6 of the Act but are not subject to proof of use requirements as none have been registered for five years or more before the publication date of the applicant's mark, as per section 6A of the Act.

7. Neither party filed evidence. Both parties filed submissions. Neither party requested to be heard; only the opponent filed written submissions. I now make this decision on the basis of the papers before me.

PRELIMINARY ISSUES

8. In their submission, the applicant refers to the opposed trademark as belonging to a 'family' or range of 12 ale products which are all registered trademarks. As submitted by the opponent, those marks are irrelevant to the matter before me and will have no bearing on this decision.

DECISION

9. Section 5(2)(b) of the Act is as follows:

“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.

10. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

COMPARISON OF GOODS

11. The goods to be compared are

| | Goods of the opponent | Goods of the applicant |
|-------------------|--|------------------------|
| EUTM no. 13628383 | 32: non-alcoholic beverages; beer | 32: ales |
| EUTM no. 13389002 | 32: non-alcoholic beverages | |
| EUTM no. 12251898 | 32: non-alcoholic beverages | |
| EUTM no. 10649184 | 32: beverages, namely, carbonated soft drinks; non-alcoholic carbonated and non –carbonated drinks enhanced with vitamins, minerals, nutrients, proteins, amino acids and/or herbs; energy or sports drinks; fruit juice drinks. | |

12. With regard to the comparison of goods, in the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

13. The opponent submits that the applicant's 'ales' covers ginger ales which is 'a carbonated soft drink flavoured with ginger'. It states that ginger ales would also be covered by its term 'non-alcoholic beverages' in its earlier marks and therefore the

respective goods are identical. In addition, the opponent refers me to a decision of the EUIPO Opposition Division where a high degree of similarity was found between 'beers' and 'non-alcoholic beverages' on the basis that the latter would include 'non-alcoholic beers'. It therefore argues that the applicant's 'ales' are highly similar to 'non-alcoholic ales' covered by its term 'non-alcoholic beverages'.

14. Although I am not bound by a decision of the EUIPO Opposition Division and its persuasive value is limited, I agree with the opponent's arguments. The opponents term 'non-alcoholic beverages' is a broad term that would include both ginger ales which are identical to the applicant's goods and non-alcoholic ales which would be highly similar to the applicant's 'ales' given that they are likely to coincide in terms of producer, the trade channels are likely to be the same, the users may be the same, they will have similar tastes and textures and there may be an element of competition between them.

15. I also note that the specification of the opponents mark EUTM no. 13628383 UNLEASH THE NITRO BEAST! covers 'beers'. As an ale is a type of beer, these goods are also considered to be identical to the applicant's goods

16. The specification of the opponents mark EUTM no. 10649184 REHAB THE BEAST WWW.MONSTERENERGY.COM contains 'beverages, namely, carbonated soft drinks'. This term would also include ginger ales which are identical to the applicant's 'ales' and 'non-alcoholic ales' which are highly similar for the reasons given above.

AVERAGE CONSUMER AND THE PURCHASING ACT

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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.”

18. In this case the users of the goods are the general public and in the case of alcoholic beverages members of the public who are over 18 years old. The goods will be available through a number of trade channels. These include pubs, bars, clubs and restaurants as well as retail outlets such as supermarkets or off-licences. In *Simonds Farsons Cisk plc v OHIM* Case T-3/04 the General Court said:

“58 In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.

59 Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves,

although they may not find those marks side by side.”

19. The purchase is therefore likely to be mainly visual but I still bear in mind the aural component. The goods at issue are generally low cost items which are purchased reasonably frequently. A consumer may take into account factors such as the type, flavour and alcoholic strength of the drink (where applicable) when making their selection. Generally speaking, a medium level of attention is likely to be paid.

COMPARISON OF THE MARKS

20. 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 the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

21. The marks to be compared are:

| Opponents marks | Applicants mark |
|--|--|
| <p>PUMP UP THE BEAST!</p> <p>UNLEASH THE NITRO BEAST!</p> <p>UNLEASH THE CAFFEINE FREE BEAST!</p> <p>REHAB THE BEAST!</p> <p>WWW.MONSTERENERGY.COM</p> |  <p>The image shows a beer label for 'Red Beast Premium Ale'. The label is dark with a red banner across the middle that says 'RED BEAST'. Below the banner, it says 'PREMIUM ALE' and 'ALC 4.3% VOL'. The top of the label has a circular border with the text 'A TRADITIONAL ALE BREWED IN THE UK BY GOLD BEER LABEL'. The bottom of the label has a circular border with the text 'COLD BEER LABEL'. The central part of the label features a golden dragon or beast.</p> |

22. The opponents' four marks consist of word only 'invitational' type slogans ending with an exclamation mark. In the case of EUTM no. 10649184, there is also a domain name which forms part of the mark. The overall impression of the three marks consisting solely of a slogan lies in the mark as a whole as the words instantly combine to form a complete phrase. In the case of the other mark, the slogan forms one element and the domain name a second element. The two elements make a roughly equal contribution to the overall impression of that mark.

23. The applicant's mark is a complex one consisting of a number of elements including words, colours, devices and the overall getup of a beer bottle label. Some of the word elements will be perceived as mere description i.e. 'PREMIUM ALE', 'ALC 4.3%' and 'A TRADITIONAL ALE BREWED IN THE UK' and therefore carry very little weight in the overall impression.

24. In terms of the **RED BEAST** element, the opponent states that, although they consider **RED BEAST** to be the dominant element of the applicant's mark, they

submit that the word 'red' is just an adjective possibly relating to the overall colour within the mark or indeed to the colour of the ale and would be ignored by consumers. Instead, it submits, consumers would 'concentrate' on the word 'beast'. I am not persuaded by this submission that the word 'red' would be ignored. The word 'red' is presented in the same size, colour and font as the word that follows. There is nothing about the presentation which suggests that one word would have more weight than the other; both words instantly combine to form a phrase, RED BEAST, in which red describes the colour of the beast.

25. The opponent also submits that the device would go 'unnoticed' by consumers as a 'simple decorative motif'. The device in the applicants mark appears in the top half of the mark above the words 'Red Beast' and consists of an image of dragon.

26. In *L&D SA v OHIM* [2008] E.T.M.R. 62, the Court of Justice of the European Union stated that:

"55 Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant."

27. In my view the device is not insignificant and amounts to more than merely a 'simple decorative motif'. The image is not a line drawing or a representation made up of a few pen strokes. It is a dramatic image of a dragon depicting considerable anatomical detailing. I consider the dragon to have roughly equal weight in the overall impression with the RED BEAST element. Of all the elements in the mark, it is those two distinctive elements which make the greatest contribution to the overall impression of the mark. The words 'COLD BLACK LABEL', although smaller, are also a distinctive element and make an important contribution to the overall impression but to a lesser extent than 'RED BEAST' and the device of a dragon.

28. In a visual comparison of the marks, the only common element is the word 'beast'. All of the opponent's marks are, in all other respects, visually very different to the applicant's mark. Any visual similarity between the opponent's marks and the applicant's mark is of a very low degree.

29. In an aural comparison of the marks, again, the only common element is the word 'beast'. The opponent's three marks consisting of word-only slogans will likely be spoken in their entirety. Insofar as the fourth mark is concerned, the consumer may only refer to it by the slogan. When the applicant's mark is spoken of then it is not likely that a consumer would use all the words contained in the mark but instead is more likely to vocalise the most prominent word element **RED BEAST**. On that basis, I believe there is a very low degree of aural similarity between the applicant's mark and the opponent's marks.

30. In a conceptual comparison of the marks, the main conceptual hook for the consumer from the opponent's marks will be an invitation to do something with a beast, whether that be to pump it up, unleash it or rehab it. The mark containing the domain name also has the additional concept of monster energy. The applicant's mark also has a concept of a beast, reinforced by the dragon device. However there is no invitation to do anything with the beast as in the opponent's marks. The concept is simply of a red beast. Further, the image of the dragon in the applicant's mark tends to conjure up the concept of a specific red beast i.e. a dragon, whereas the opponent's marks do not conjure up such a specific kind of beast. There is also the concept portrayed by the COLD BLACK LABEL element in the applicant's mark which is self-explanatory and absent from the opponent's mark. On that basis I believe there is a low degree of conceptual similarity between the applicant's mark and the opponent's marks. I reach the same conclusion even if COLD BLACK LABEL does not form part of the immediate conceptual hook (due to its relative size).

DISTINCTIVE CHARACTER OF EARLIER MARK

31. The distinctive character of the earlier marks must be considered. 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).”

32. The opponent submits that their marks ‘enjoy a high degree of distinctiveness both from an inherent point of view ... and as a result of the use made by the opponent’. However as no evidence has been filed in this case, I can only consider the trade marks inherent distinctiveness.

33. Three of the opponent’s marks are word-only slogans followed by an exclamation mark. There appears to be commonality in that all contain the word ‘beast’ and all are invitations to do something with the ‘beast’. None are descriptive or allusive of the goods and I would say that the marks, as a whole, have a normal level of distinctiveness. The fourth mark also consists of a word-only slogan with an exclamation mark inviting the consumer to ‘Rehab the Beast!’ together with the website address www.monsterenergy.com. Each of these two elements, taken

separately is considered to be of normal distinctiveness, and the mark as a whole is also of normal distinctiveness.

LIKELIHOOD OF CONFUSION

34. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

35. Having weighed all of the relevant factors, I conclude that whilst the goods are identical or highly similar, this is outweighed by my finding that any visual similarity between all of the respective marks is very low, the aural similarity is very low and the conceptual similarity is low. I must also bear in mind that the purchase of the goods at issue is likely to be mainly visual so the level of visual similarity is of particular importance¹. Taking these factors into account, together with the normal level of distinctiveness of the earlier marks, I do not consider there to be a likelihood of direct confusion between the applicant's mark and any of the opponent's marks, on the part of an average consumer paying a medium level of attention. I also do not

¹ In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: "49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

consider that the average consumer is likely to believe that the respective goods come from the same or linked undertakings. The common element is not “so strikingly distinctive”², the applicant’s mark does not “simply add a non-distinctive element to the earlier marks”³, the applicant’s mark does not strike me as being “entirely logical and consistent with a brand extension”⁴ of the opponent’s marks and I cannot see any other reason why the marks are likely to be indirectly confused.

CONCLUSION

36. The opposition fails under section 5(2)(b) of the Act for all of the goods opposed in class 32.

COSTS

37. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited them to indicate whether they wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs will be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 2nd day of March 2017



June Ralph

For the Registrar

For the Comptroller General

² *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, [16].

³ *ibid*

⁴ *ibid*

