

O-405-14

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3006750
BY
MICHAEL HARBONE
TO REGISTER THE TRADE MARK



IN CLASS 25
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO 401195
BY
MONSTER ENERGY COMPANY

BACKGROUND

1) On 20 May 2013, Michael Harbone ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of "Ankle socks; Clothes for sports; Shorts; Sportswear" in class 25.

2) The application was published on 16 August 2013 in the Trade Marks Journal and notice of opposition was subsequently filed by Monster Energy Company ('the opponent'). The opponent initially claimed that the application offended under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). However, as no evidence was subsequently filed to substantiate the latter two grounds, these were struck out in accordance with rule 20(3)(a) of The Trade Marks Rules 2008.¹ Accordingly, the sole ground before me is under section 5(2)(b) of the Act. In support of this ground, the opponent relies upon four trade marks; these are shown in the table below.

Mark details	Goods relied upon
<p>Community Trade Mark ('CTM') No: 006368005 ('005')</p> <p>MONSTER ENERGY</p> <p>Filing date: 05 November 2007 Date of entry in the register: 09 October 2008</p>	<p>Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; stickers; sticker kits.</p> <p>Class 25: Clothing, footwear, headgear; hats.</p>
<p>UK Trade Mark No: 2499788 ('788')</p> <p>MONSTER ENERGY</p> <p>Filing date: 07 March 2008 Date of entry in the register: 18 February 2011</p>	<p>Class 9: Helmets, protective clothing for sports, protective gloves for sports.</p> <p>Class 16: Stickers, posters.</p> <p>Class 18: Bags, duffle bags, book bags, backpacks, sport bags and handbags.</p> <p>Class 25: Clothing and headwear.</p>

¹ The official letters of 21 February 2014 and 27 March 2014 refer.

<p>International Trade Mark Registration No: 1048069 ('069')</p>  <p>Date of international registration: 28 June 2010 Date of receipt at OHIM: 16 September 2010 Date protection granted in the EU: 21 July 2011</p>	<p>Class 9: Sports helmets.</p> <p>Class 16: Stickers; sticker kits comprising stickers and decals; decals.</p> <p>Class 18: All purpose sports bags; all-purpose carrying bags; backpacks; duffle bags.</p> <p>Class 25: Clothing, namely, t-shirts, hooded shirts and hooded sweatshirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely, hats and beanies.</p>
<p>CTM No: 007444318 ('318')</p> <p>MONSTER RIPPER</p> <p>Filing date: 05 December 2008 Date of entry in the register: 10 June 2009</p>	<p>Class 5: Nutritional supplements.</p> <p>Class 25: Clothing, footwear, headgear.</p> <p>Class 32: Non-alcoholic beverages.</p>

3) All of the opponent's marks have completed the registration procedure; they are earlier marks in accordance with section 6 of the Act. Further, as they had all been registered for less than five years prior to the publication date of the opposed trade mark, none are subject to the proof of use conditions contained in section 6A of the Act.

4) The applicant filed a counterstatement² in which it denies there is any aural, visual or conceptual similarity between the respective marks or that there is any similarity between the goods at issue such that there is no likelihood of confusion on the part of the consumer.

² I note that in its written submissions of 15 July 2014, the opponent states "The Opponent however notes that the Applicant has not filed any defence/counterstatement". This is incorrect. The official letter of 18 December 2013 served the Form TM8 and counterstatement to the opponent and, furthermore, the opponent's written submissions dated 14 February 2014 clearly state, inter alia, that "The Applicant filed his Notice of Defence and Counterstatement.....on 17 December 2013. The Opponent files this Reply in response to the Applicant's Defence."

5) There is no evidence before me in the present case³ and only the opponent filed written submissions in lieu of a hearing. I now make this decision based on the papers before me giving full consideration to all of the parties' submissions.

DECISION

Section 5(2)(b)

6) Having reviewed the four marks relied upon by the opponent, it appears to me that, if the opponent cannot succeed on the basis of either earlier mark 005 or 069, it is in no better position in relation to either of its other two marks, 318 or 788. I will approach my decision on that basis.

7) This section of the Act states:

“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.”

8) The leading authorities as regards the assessment of the likelihood of confusion under section 5(2)(b) of the Act are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

³ The opponent opted not to file evidence at all. The applicant did not file its evidence in an admissible format nor did it amend that evidence when provided with an opportunity to do so (the official letters of 15 April 2014 and 11 June 2014 refer).

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of goods

9) The goods to be compared are:

Opponent's goods	Applicant's goods
<p><u>Earlier mark No: 069</u></p> <p>Class 9: Sports helmets.</p> <p>Class 16: Stickers; sticker kits comprising stickers and decals; decals.</p> <p>Class 18: All purpose sports bags; all-purpose carrying bags; backpacks; duffle bags.</p> <p>Class 25: Clothing, namely, t-shirts, hooded shirts and hooded sweatshirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely, hats and beanies.</p> <p><u>Earlier mark No: 005</u></p> <p>Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; stickers; sticker kits.</p> <p>Class 25: Clothing, footwear, headgear; hats.</p>	<p>Class 25: Ankle socks; Clothes for sports; Shorts; Sportswear</p>

10) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

11) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given “an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor”.

12) In *YouView TV Ltd v Total Ltd* (*'YouView'*) [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

13) As regards when goods can be considered identical, I note the decision of the General Court ('GC') in *Gérard Meric v OHIM*, Case T-133/05 (*'Meric'*) where it held:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

14) The opponent's 't-shirts', 'hooded sweatshirts' and 'sweatshirts' covered by its earlier mark number 069 all fall within the applicant's broader terms 'clothes for sports' and 'sportswear'. These respective goods are identical in accordance with *Meric*.

15) The applicant's 'ankle socks' and 'shorts' and the opponent's class 25 goods covered by earlier mark 069 are all intended to be worn on the person, they are similar in nature, are likely to have the same users and share trade channels. There is a good degree of similarity between the applicant's 'ankle socks' and 'shorts' and the opponent's goods.

16) As for the goods covered by the opponent's earlier mark number 005, all of the applicant's goods are encapsulated within the opponent's broad terms 'clothing' and 'footwear'. The respective goods are identical in accordance with *Meric*.

Average consumer and the purchasing process

17) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

18) The average consumer for the goods at issue in this case is the general public. The specifications before me include items of clothing. In this connection, I note that in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“43. It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.



...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

19) As stated by the GC, items of clothing will vary greatly in price. A pair of socks, for instance, is likely to be considerably less expensive than a hooded sweatshirt. Accordingly, the purchase may not always be particularly considered. That said, as the consumer may wish try on the goods, or to ensure that they are of a preferred colour, size or material (for example), it is likely that at least a reasonable degree of attention is still likely to be afforded, even for those goods which sit at the lower end of the cost scale. The purchasing act will be primarily visual on account of the goods being commonly purchased based on their appearance; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

Comparison of marks

20) The marks to be compared are:

Opponent's marks	Applicant's mark
<p>069:</p>  <p>005:</p> <p>MONSTER ENERGY</p>	 <p>MONSTER</p>

21) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities must therefore be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). Accordingly, there cannot be an artificial dissection of the marks, although, it is necessary to take into account any distinctive and dominant components.

22) Mark 069 consists of three elements: the first is the image of three vertical lines which are stylised such that they are reminiscent of slashes made by the claws of an animal (I will refer to this from here on as the 'slash' image); the second is the stylised word MONSTER (with a vertical line through the letter 'o'); the third is the word ENERGY in plain block capitals. All three elements are distinctive. As to dominance, of all three elements, the word 'ENERGY' is the least dominant (although not negligible) given its relatively small size to the other elements and that it does not enjoy a prominent position within the mark as a whole. Both the slash image and the word MONSTER have substantial impact on the eye; they share roughly equal dominance. Mark 005 consists of the two words MONSTER ENERGY presented in plain block capitals. Given the manner in which they are presented,

they appear to hang together with neither word dominating the other.⁴ The applicant's mark contains two elements; the first is the image of what appears to be either three fangs (as the applicant submits) or claws, with the middle claw/fang being significantly shorter than the other two, surrounded by flames emanating from a pedestal; the second is the word MONSTER presented in bold letters in a fairly unremarkable font. The two elements are both distinctive and share roughly equal dominance.

23) Comparing mark 069 with the applicant's mark, a clear point of visual coincidence is the presence of the word MONSTER in both marks (albeit in different formats). However, there is also the presence of the word ENERGY in the opponent's mark which is absent from the applicant's mark. As for the respective images, these are of a similar size, proportion and positioning within the respective marks, however, the opponent's mark contains three slashes of roughly equal length whereas the applicant's mark consists of three claws/fangs with the middle claw/fang being substantially shorter than the other two, all of which are surrounded by flames emanating from a pedestal. Taking all of these factors into account, I would put the degree of visual similarity at moderate. From an aural perspective, the images in both marks are unlikely to be vocalised. Accordingly, the opponent's mark will be pronounced MON-STER EN-ER-GEE and the applicant's mark as MON-STER. Clearly, the first two syllables of the opponent's mark are identical to the only two syllables in the applicant's mark. Whilst the last three syllables in the opponent's mark are absent from the applicant's mark, I still consider there to be a reasonable degree of aural similarity. Turning to the conceptual identity of the marks, the word MONSTER in the opponent's mark will be perceived as an imaginary beast. This is accompanied by the concept of slashes (which appear to have been made by claws) and vitality/vigour evoked by the word ENERGY. The applicant's mark also evokes the idea of an imaginary beast together with the idea of claws/fangs and fire. Taking all factors into account, I consider there to be a reasonable degree of conceptual similarity between the marks.

24) Comparing mark 005 with the applicant's mark, the point of visual coincidence lies in the common presence of the word MONSTER (but again in different formats). The marks differ visually in all other respects. I find that there is a fairly low degree of visual similarity. The degree of aural similarity will be the same as that for the opponent's earlier mark 069; that is, at a reasonable level. In terms of conceptual similarity, the concept of the applicant's mark has already been identified in the previous paragraph. The opponent's mark evokes the concept of vitality/vigour of an imaginary beast. On the whole, the marks share a reasonable degree of conceptual similarity.

Distinctive character of the earlier mark

25) I must consider the distinctive character of the earlier marks. The distinctive character of a trade mark must be assessed by reference to the goods or services

⁴ In this regard, I have borne in mind the comments of the GC in *Ella Valley Vineyards (Adulam) Ltd v OHIM*, Case T-32/10, at paragraph [43].

for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

26) The opponent has filed no evidence in these proceedings and therefore, I have only the inherent level of distinctiveness of the marks to consider. The opponent's marks are neither descriptive nor allusive in any way in relation to the opponent's goods. I consider that both marks possess a reasonable degree of distinctive character.

Likelihood of confusion

27) In support of its contention that there is no likelihood of confusion between the respective marks, the applicant states:

“33- The Applicant sells Muay Thai equipment, Shorts, sportswear. The Opponent sells drinks which The Applicant does not sell, and clothing which is not sportswear”

This submission does not assist the applicant. The goods (or services) which the parties may currently be using their marks on, or in relation to, in the marketplace, is of no relevance to my considerations because marketing strategies may alter with the passage of time. I must assess matters from a notional and objective stand point based on the marks and specifications listed before me. In this connection see, for example, the comments of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, when it stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

28) I must now remind myself of all my earlier findings and feed them into the global assessment of the likelihood of confusion and, when conducting that assessment, I must also keep in mind the following established principles:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods (or services) may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) 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 B.V*), and;
- iii) the principle that the more distinctive the opponent's mark is, the greater is the likelihood of confusion (*Sabel BV v Puma AG*).

29) Earlier in this decision I found that earlier mark number 069 shares a moderate degree of visual similarity, a reasonable degree of aural similarity and a reasonable

degree of conceptual similarity with the applicant's mark. I also found that the goods covered by mark 069 are either identical or similar to a good degree to those of the application. As for earlier mark 005, I found that this mark shares a fairly low degree of visual similarity, a reasonable degree of aural similarity and a reasonable degree of conceptual similarity with the applicant's mark and that the respective goods are identical. The average consumer is the general public who are likely to pay at least a reasonable degree of attention during the mainly visual purchase (although aural considerations are not ignored) and both of the earlier marks possess a reasonable degree of distinctive character.

30) I will firstly consider the likelihood of confusion between earlier mark 069 and the application. Bearing in mind that the purchase is mainly a visual one and that at least a reasonable level of attention is likely to be paid, I consider it unlikely that the marks will be mistaken for one another. However, having taking into account, in particular, that the respective goods are either identical or similar to a good degree, there is, in my view, a likelihood that the average consumer will believe, on account of the similarities which do exist between the marks, that the respective goods are different ranges from the same clothing producer. There is therefore a likelihood of indirect confusion.

31) Turning to earlier mark 005, there is even less likelihood of this mark being directly confused with the application on account of the fairly low degree of visual similarity. Nevertheless, I am of the view that, the similarities which do exist between the marks combined with the identity between the goods, is again likely to lead the consumer to believe that the respective goods emanate from the same or linked undertaking(s).

32) The ground of opposition under section 5(2)(b) of the Act succeeds in full.

COSTS

33) As the opponent has been successful, it is entitled to an award of costs. Bearing in mind the guidance provided in Tribunal Practice Notice 4/2007, I award costs to the opponent on the following basis:

Preparing notice of opposition	£200
Opposition fee	£200
Written Submissions	£300
Total:	£700

34) I order Michael Harbone to pay Monster Energy Company the sum of **£700**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of September 2014

**Beverley Hedley
For the Registrar,
the Comptroller-General**