TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3120031
BY UNILEVER PLC
TO REGISTER THE TRADE MARK

RELEASE THE BEAST

IN CLASS 30
AND

IN THE MATTER OF OPPOSITION
THERETO UNDER No. 405459 BY
MONSTER ENERGY COMPANY

BACKGROUND

1) On 29 July 2015, Unilever Plc (hereinafter the applicant) applied to register the trade mark RELEASE THE BEAST in respect of the following goods in Class 30: Ice cream; water ices; frozen yoghurt; frozen confectionery.

2) The application was examined and accepted, and subsequently published for opposition purposes on 21 August 2015 in Trade Marks Journal No.2015/034.

3) On 16 November 2015 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 and registration	Class	Specification relied upon
REHAB THE BEAST!	CTM 9584244	09.12.10 20.05.11	5	Nutritional supplements in liquid form in Class 5.
			30	Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages in Class 30.
			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 in Class 32.
UNLEASH THE BEAST WITHIN!	CTM 10645968	15.02.12 09.10.13	5	Nutritional supplements in liquid form.
			30	Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and

				tea based beverages.
			32	Non-alcoholic beverages, namely energy drinks, energy drinks flavored with tea, energy drinks flavored with juice, sports drinks, and fruit juice drinks having a content of 50% or less by volume; all of the foregoing enhanced with vitamins, minerals, nutrients, amino acids and/or herbs.
PUMP UP THE BEAST!	CTM 12251898	24.10.13 11.04.14	5	Nutritional supplements in liquid form; vitamin fortified beverages.
			30	Bases for making energy shakes; prepared coffee and coffee based beverages; bases for making energy shakes with a coffee flavour; bases for making energy shakes with a chocolate flavour; prepared chocolate and chocolate-based beverages.
			32	Non-alcoholic beverages.

a) The opponent contends that the mark in suit and its earlier marks are highly similar and that the goods for which its earlier marks are registered are similar to those applied for. It contends that the application offends against Section 5(2)(b) of the Act.

4) On 18 January 2016 the applicant filed a counterstatement, basically denying that the marks are similar. The applicant did not request proof of use.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 4 April 2016 by Cristina Garrigues Martinez, the opponent's Trade Mark Attorney. She states that she carried out a "cursory Internet search on 1 April 2016" in respect of several UK –leading ice cream and milk based beverage brands and also the applicant's own MAGNUM brand showing cross-over of this mark from ice cream to novelty confectionery and chocolates. She provides the following exhibits:

- CGM1: The various pages show images of brand such as Galaxy, Mars, Snickers, Nesquik and Bounty used on milk shakes, ice cream and lollies / choc ices / cornets.

- CGM2: This shows the Unilever brand of MAGNUM, previously used on ice cream lollies now launching a range of chocolate confectionery under the same brand.

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

DECISION

8) The only 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."

9) 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.”

10) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant did not request that the opponent provide proof of use, and, given the interplay between the dates that the opponent’s marks were registered (20.05.11 / 9.10.13 / 11.4.14) and the date that the applicant’s mark was published (21 August 2015), the proof of use requirements do not bite.

11) 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

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods 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."

13) The applicant's goods are Ice cream; water ices; frozen yoghurt; frozen confectionery, whereas the opponent's products are, broadly speaking, beverages including those which are vitamin fortified, flavoured with tea, chocolate or coffee; energy drinks; carbonated and non-carbonated drinks and fruit juice drinks.

14) Both parties' products would be purchased by the general public including businesses. These types of products are freely available in a wide range of retail outlets as well as on-line. They will initially be chosen by eye and thus the visual aspect will be the most important element in selection although I must also consider aural issues as, in a restaurant or bar, they may be stored behind the counter and require interaction with an assistant. They may also be the subject of a personal recommendation during a conversation. When seeking products to consume the average consumer is likely to take some care to ensure that the product is suitable for them (particularly diabetics) and will not have an adverse effect upon them. Although I accept that these are low cost items which are also purchased by children. **In my opinion, the average consumer will take at least a medium degree of care.**

Comparison of goods

15) In the judgment of the 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".

16) 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.

17) I also take into account Case T-736/14, *Monster Energy Company v OHIM,* where the General Court 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.

18) The goods of the two parties are:

Applicant's goods	Opponent's goods

Class 30: Ice cream; water ices; frozen yoghurt; frozen confectionery.	CTM 9584244: Class 5: Nutritional supplements in liquid form. Class 30: Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages. Class 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.
	CTM 10645968: Class 5: Nutritional supplements in liquid form. Class 30: Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages. Class 32: Non-alcoholic beverages, namely energy drinks, energy drinks flavored with tea, energy drinks flavored with juice, sports drinks, and fruit juice drinks having a content of 50% or less by volume; all of the foregoing enhanced with vitamins, minerals, nutrients, amino acids and/or herbs.
	CTM 12251898: Class 5: Nutritional supplements in liquid form; vitamin fortified beverages. Class 30: Bases for making energy shakes; prepared coffee and coffee based beverages; bases for making energy shakes with a coffee flavour; bases for making energy shakes with a chocolate flavour; prepared chocolate and chocolate-based beverages. Class 32: Non-alcoholic beverages.

19) I note that the opponent makes no submissions as to why the goods in class 5 should be regarded as similar to the applicant's goods. To my mind, the opponent's goods in class 5 are a specialised form of nutrition which will not be sold ice cream/ frozen confectionery. The users and physical nature are different. They will not be found alongside each other in shops and, to my mind they are not in competition with each other. **In my opinion the opponent's goods in class 5 under all three earlier marks are not similar to the goods applied for by the applicant.**

20) Turning to the opponent's goods in class 30, the specifications vary somewhat between its marks. Both CTM 9584244 & CTM 10645968 have identical specifications based around tea beverages whereas CTM 12251898 is concerned with chocolate or coffee based beverages including energy shakes and unflavoured energy shakes. The opponent contends that:

> "25. Furthermore, in our health-conscious society the traditional ice creams and yoghurts are being reformulated and healthier ingredients are added to make those products more nutritious for the consumer.
>
> 26. For example, non-fat pomegranate energy/vitamin boost yoghurt, and frozen Bio- Live yoghurts and ice creams are made using live bacterial cultures and probiotics are sold in the UK market.
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> 27. Furthermore, the Opponent's goods in Classes 30 and 32 include also all kinds of iced chocolate-based beverages and energy drinks including shakes, to be served chilled. In many occasions, consumers either purchase an ice cream, a healthier shake, or a chilled energy drink to keep cool."

21) In my opinion, the users for both parties' products would be the same i.e. the general public. The physical nature of the products differ in that the opponent's goods are liquid whereas the applicant's goods will be solid or semi-solid when purchased. I do not have any information regarding trade channels. Large retail outlets such as supermarkets have the space to display a wide range of such products. As such the ready-to-drink products will be with other such items in a chiller unit whereas the frozen items of the applicant will be kept with other frozen foods in an entirely different area. However, in small retail outlets the goods will be located closer to each other, although probably not in the same cabinet due to the requirements for different temperatures. The applicant's goods will be kept below freezing point whereas the opponent's goods will be merely chilled. I accept that tea, coffee and chocolate based beverages can all be chilled at the point of sale and might, at a stretch, be an alternative, on a hot day, to ice cream or frozen items such as lollies or ice-cream based confectionery bars. Other than this I do not believe that the goods will be in competition with each other. **Taken overall there is no similarity between the goods of the applicant and the opponent's class 30 goods.**

21) I next turn to consider the opponent's goods in class 32. Broadly speaking all three specifications are for non-alcoholic beverages. The same reasoning set out in paragraph 20 above applies and so I find that **there is no similarity between the goods of the applicant and the opponent's class 32 goods.**

22) 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."

23) I note that this view was also expressed in *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU). As I have found that there is no similarity between the goods of the two parties there is no need to go on and consider the similarity of the marks. **The opposition under Section 5(2) (b) therefore fails.**

COSTS

24) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Considering opponent's evidence	£300
Preparation of submissions	£500
TOTAL	£1100

46) I order Monster Energy Company to pay Unilever Plc the sum of £1100. This sum 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 3rd day of August 2016

George W Salthouse

For the Registrar,

the Comptroller-General