

O-175-20

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 3354388

BY MICHAEL EFE OMERU

TO REGISTER:

JUST BE MONSTER

AS A TRADE MARK IN CLASS 25

AND

OPPOSITION THERETO (UNDER No 415642)

BY MONSTER ENERGY COMPANY

Background and pleadings

1. The relevant details of the opposed application are:

Mark:	JUST BE MONSTER
Filing date:	18 November 2018
Publication date:	30 November 2018
Applicant:	Mr Michael Efe Omeru
Specification:	Clothes (in class 25)

2. Registration is opposed by Monster Energy Company (“the opponent”). Its grounds of opposition are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The following three marks/signs are relied upon:


- UK registration 3254983 for the mark **MONSTER**, which was filed on 6 September 2017 and registered on 19 January 2018.

Under section 5(2)(b), the opponent relies on the terms: clothing, headgear and footwear, as covered by its class 25 specification; the claim is that there is a likelihood of confusion.

Under section 5(3), the opponent relies on (and claims a reputation for) the terms: energy drinks, sports drinks, fruit juice drinks, and other non-alcoholic beverages, as covered by its class 32 specification. The opponent claims damage on the basis that the public would regard the competing marks as economically linked; it additionally claims that the applicant would derive an unfair advantage by its mark calling to mind the opponent's mark, further, that the use of the applied for mark may tarnish its reputation, and further again, that the use of the applied for mark may dilute the distinctiveness of its mark and its ability to distinguish its goods from those of other traders.

- UK registration 3254991 for the mark **MONSTER ENERGY**, which was filed on 6 September 2017 and registered on 2 February 2018. There is no section 5(2)(b) claim. Under section 5(3), this registration is relied upon to the same extent as earlier mark 3254983, with the same types of damage claimed to arise.



- European Union trade mark (“EUTM”) 11154739 for the mark: , which was filed on 31 August 2012 and registered on 9 January 2013. There is no section 5(2)(b) claim. Under section 5(3), the opponent relies upon (and claims a reputation for) the term: non-alcoholic beverages, as covered by its class 32 specification. The same types of damage are claimed to arise as per earlier marks 3254991 & 3254983.
- Under section 5(4)(a), the opponent relies on the use of signs corresponding to the three trade mark registrations detailed above, with all of those signs claimed to have been used in the UK since 2008 in relation to energy drinks. The opponent claims that the goods sold under the applicant’s mark will be assumed to be provided by, endorsed by, or otherwise commercially linked to, the opponent, such that its use is liable to be prevented under the law of passing-off.

3. All of the opponent’s marks were filed before the applicant’s mark, so meaning that they qualify as earlier marks in accordance with section 6 of the Act. UK earlier marks 3254991 & 3254983 were registered within (not before) the period of 5 years ending on the date the applicant’s mark was filed, so meaning that the use conditions set out in section 6A do not apply. Consequently, those earlier marks may be relied upon for the goods identified by the opponent without use having to be shown. However, the opponent’s EUTM 11154739 was registered before that five-year period which means that the provisions do apply, with use needing to be demonstrated (unless the applicant does not require it) in order for it to form a basis for this opposition.

4. Mr Omeru filed a counterstatement denying the grounds of opposition. In particular, I note that he:

- Puts the opponent to proof of use in relation to EUTM 11154739.
- States that the classes “are primarily different”.
- States that in his mark MONSTER is used as part of a phrase, of three words and four syllables.
- States that the respective “placements” of MONSTER “are opposite”.
- States that the font and styles are clearly different.
- States that the above points render the use of MONSTER “trivial”.
- States that MONSTER is a dictionary word which does not “allude to any exclusivity, reputation or goodwill of the opponent”.
- States that mere association, in that one mark may bring to mind the other, is not sufficient to uphold the opposition.

5. Both sides filed evidence. Neither side requested a hearing, although the opponent did file written submissions in lieu of a hearing. The opponent has been represented by Bird & Bird LLP. Mr Omeru has represented himself.

The evidence

6. The opponent’s evidence comes from Mr Rodney Sacks, in the form of a witness statement together with 50 exhibits. Whilst Mr Sack’s evidence is lengthy, I believe most of it can be summarised reasonably briefly.

7. The opponent’s business predominantly relates to the energy drinks market. The evidence clearly shows that the opponent is a leading player within this market. The opponent’s branding predominantly features the word MONSTER, often in the manner shown in its earlier figurative mark. I have no doubt that the average consumer for energy drinks will be strongly aware of the brand and that MONSTER is the opponent’s core brand name. To illustrate its significance in the UK market, I record here that the opponent’s sales of energy drinks in the UK amounted to around 80 million Euro in 2012 and 153 million Euro in 2017.

8. Mr Sack's explains that the opponent does not use traditional advertising methods. Instead, it focuses on sponsorship and product placement. Numerous exhibits demonstrate such activity, with initiatives particularly focused on motor sports (including F1 racing) and forms of extreme sport. This ties in with what Mr Sacks says is the image of the opponent's MONSTER brand, he states:

"The image of the MONSTER energy drinks is 'edgy and aggressive'. The athletes and events Monster sponsors tend to be edgy and aggressive, or extreme."

9. In this promotional context, the marks are displayed on banners, vehicles, clothing etc. Mr Sacks states that the company spent more than €119.4 million on advertising, promotion and marketing in the EU in 2015; in the UK between 2011 and 2018 it expended over US \$370 million.

10. Towards the end of his witness statement Mr Sacks discusses "APPAREL AND MERCHANDISING". He states that the opponent has used its marks on clothing since 2002 and has given approval and licenses for other companies to sell clothing and merchandise which bear the MONSTER marks. He adds that, given its popularity, it has expanded into other ranges such as MUSCLE MONSTER, MONSTER ARMY and JAVA MONSTER. Some photographs showing these ranges are included within the witness statement.

11. Mr Sacks says there is a huge demand for such items which is why license agreements were made (he names 5 licensees), including in the UK. However, what Mr Sacks does not say is how many items of clothing have been sold in the UK, either through itself, or via its licensees.

12. Mr Sacks refers to other initiatives including sponsoring amateur athletics as part of the Monster Army athletics development program and that athletes can login to the Monster Army website to order clothing and other merchandise which bears the Monster marks. Reference is also made to the Monster Gear program which ran between 2011 and 2013 where consumers in the EU (including the UK) could order items, and that over 19,000 items were distributed; a similar program was run to

promote its Monster Java products. Finally, reference is made to the giving away of promotional items of clothing such as t-shirts at various events.

13. Mr Omeru's evidence is more limited. In his witness statement, he provides examples of how he intends to use his mark, showing fonts and stylisation etc. I note that in some examples MONSTER is presented in larger lettering than the other words in the mark. He says that his brand will be in class 25 only and will promote motivation, self-improvement, and the living of a healthy ambitious lifestyle. He states that his mark is a whole phrase, and that the phrase represents the brand's philosophy.

Section 5(2)(b)

14. I begin this decision with the ground of opposition under section 5(2)(b) of the Act, based on the opponent's earlier mark 3254983 which consists of the word **MONSTER**. The relevant section of the Act states that:

"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."

15. The following principles are gleaned from the judgments 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 greater 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

16. Mr Omeru seeks registration for “clothes” in class 25. The opponent’s mark covers “clothing, headgear, footwear”. These terms are clearly identical, clothes and clothing being an interchangeable term.

17. I have, of course, noted Mr Omeru’s reference to the classes being different. However, whilst it may be the case that the opponent’s core business is in the energy drinks market, the registration it relies on covers clothing. Further, and as mentioned earlier, that registration is not subject to the requirement to prove use, so the opponent is perfectly entitled to rely on it.

18. The only finding possible is that the goods are identical.

Average consumer and the purchasing act

19. 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.”

20. The goods at issue are in the clothing field. The average consumer will be a member of the general public. Generally, such items are not greatly expensive. Some care will be taken in respect of style, colour, fitness for purpose etc. I consider that this equates to a reasonable, no higher or lower than the norm, level of care and consideration. The goods will be perused in traditional bricks and mortar retail establishments and their online equivalents. The goods and the marks used in relation to them may be seen in advertisements and on websites. This means that their visual impression is likely to take on more significance, although, I do not discount their aural impact completely.

Comparison of marks

21. 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 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.”

22. 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. The respective marks are set out below:

JUST BE MONSTER

v

MONSTER

Overall impression

23. The opponent's mark comprises just one component, the word **MONSTER**. That component is, thus, the only thing that contributes to its overall impression.

24. In relation to Mr Omeru's mark, I agree with him that it comprises a phrase. None of the words within that phrase stand out as separate components. None of the words stand out any more due to the way in which the mark is presented. The opponent submits that **MONSTER** is the dominant and distinctive component of the mark because **JUST BE** is of little or no distinctiveness. Whilst I may not have put it that way, I accept that the word **MONSTER** is likely to be taken as an important part of the mark because **JUST BE** acts as a form of qualifier – it is **MONSTER** that the phrase is encouraging one to "just be".

Visual and aural similarity

25. There are self-evident points of visual and aural similarity (the commonality of the word **MONSTER**), together with self-evident points of difference (the presence/absence of the words **JUST BE**). Weighing this up, and notwithstanding that **MONSTER** is at the end of the applicant's mark (which I assume is the point Mr Omeru

is making when he refers to the opposite position), I still consider there to be a medium level of both visual and aural similarity.

26. There are two points to make before moving on, particular with regard to the visual comparison. The first is to deal with Mr Omeru's point that the font and style of the marks are different. I cannot take this into account because neither Mr Omeru's mark, nor the opponent's earlier mark, contain any form of stylisation. They are both plain words marks which, in fact, could actually be used in the same or similar font. The second point is to deal with the opponent's submission that Mr Omeru's potential use (as per his evidence) includes use where MONSTER is used in much larger font, thus increasing the similarity of the marks. Likewise, I cannot take this into account. Whilst it is right to consider notional and fair use of the application, it would in my view be a step too far to take into account a mark presented in such a way as to give significantly more emphasis to a particular word within it.

Conceptual comparison

27. Both marks make reference to MONSTER. This could be in the context of a mythical creature, or an alternate meaning of being of daunting size etc, monstrous. Either way, the commonality of this concept creates some conceptual similarity. I bear in mind that Mr Omeru's mark is a whole phrase, JUST BE MONSTER. However, for the reasons given earlier, MONSTER will be quite memorable as an aspect of the mark, forming a key part of its conceptual hook. I consider there to be at least a medium degree of similarity on a conceptual level.

Distinctive character of the earlier trade mark

28. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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).

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)."¹

29. From an inherent perspective, the word MONSTER for clothing is a perfectly distinctive trade mark. It may not be at the higher end of the distinctiveness spectrum where invented or highly fanciful marks reside, but neither does it have any great allusive or suggestive qualities that result in its distinctiveness level being low. It has a normal, or medium, level of inherent distinctiveness.

30. In terms of the use made of the earlier mark, had I been contemplating use in relation to energy drinks, I would have had no hesitation concluding that the earlier mark was highly distinctive on account of the use made of it. However, the comparison here is based upon clothing. Whilst I accept that some use has been made, much of that has been for promotional (of its energy drinks) purposes, and, in any event, the evidence lacks precision in terms of the overall sales/distribution of clothing items bearing the MONSTER mark, whether that relates to promotional clothing or to the clothing Mr Sacks says was sold by, for example, licensees. Therefore, contrary to the opponent's submissions, the evidence does not enhance the mark's distinctiveness.

¹ C-342/97, paras. 22-23

Likelihood of confusion

31. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

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

32. I believe this to be a case where indirect confusion is the better argument. Notwithstanding the concept of imperfect recollection, it is, in my view, unlikely that the average consumer will misrecall/misremember the marks to such an extent that they will not remember that one mark was a phrase, the other just a single word. I therefore rule out direct confusion and move to consider indirect confusion.

33. In terms of indirect confusion, this requires the average consumer, having appreciated, as Mr Purvis put it in the case-law above, that “[t]he later mark is different from the earlier mark, but also has something in common with it” to conclude, via a “mental process of some kind”, that the presence of the common element is indicative that “it is another brand of the owner of the earlier mark”. This is where the nature and construction of the phrase matters. As I touched on earlier, the words JUST BE within the phrase act as a form of qualifier to the word MONSTER. The phrase is slightly jarring, but emphasises that it is MONSTER that one is to JUST BE. The average consumer’s focus on the MONSTER element, together with the qualifying role the other words play, will, in my view, lead the average consumer to assume that the later mark is a form of variant branding of the earlier mark, promoting, but as a trade mark in its own right, the MONSTER mark. This is so particularly bearing in mind that I am considering the position on the basis of marks to be used for identical goods and, further, that MONSTER has a medium level of inherent distinctiveness. The fact that MONSTER is a dictionary word does not prevent this assumption from occurring when the context of the actual phrase here is considered. There is a likelihood of indirect confusion.

34. The ground under section 5(2)(b), and as a consequence, the opposition as a whole, succeeds. Given the opposition has succeeded, I will deal with the other grounds of opposition more briefly.

Section 5(3)

35. Under this ground, the opponent relies on all three marks identified earlier in this decision. Section 5(3) prevents the registration of a trade mark which:

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

36. Further relevant law can be seen in section 5(3A), as follows:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

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

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

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

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

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

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

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

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

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

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

Reputation

38. The opponent relies on its reputation for energy drinks. I have no hesitation in finding that the opponent's marks have the requisite reputation, a strong one at that.

The link

39. The opponent submits that the relevant public will make a link between the marks due to their similarity, together with the strong reputation for energy drinks, coupled with an extended reputation in relation to clothing. I have already touched on the lack of specificity in relation to the opponent's evidence in so far as it relates to clothing. That said, I accept that the MONSTER/MONSTER ENERGY trade marks, and the figurative mark set out earlier, have featured on forms of clothing when promoting the energy drinks business. However, and although I have found a likelihood of confusion when identical goods are considered, I do not consider it likely that the relevant public, when encountering the applied for mark on clothing products, will bring to mind the opponent's earlier marks. Something more would have been required beyond the word MONSTER appearing in the phrase which comprises the applied for mark for such a bringing to mind to occur.

40. The ground of opposition fails under section 5(3).

Section 5(4)(a)

41. Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b)...

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

42. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and, iii) damage. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off:

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

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

43. In its pleading, the opponent relies on the use of its three signs (corresponding to its three registered trade marks) in relation to energy drinks. I fully accept that the opponent has the requisite goodwill. However, for similar reasons to why I rejected the existence of a link under section 5(3), I reject the claim that there will be a relevant misrepresentation. The ground under section 5(4)(a) is dismissed.

Conclusion

44. Given the success under section 5(2)(b), the opposition succeeds. Subject to appeal, Mr Omeru’s application is hereby refused.

Costs

45. I have determined these proceedings in favour of the opponent. It is, therefore, entitled to an award of costs.

46. I award the opponent the sum of £800 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee: £100

Preparing the Notice of opposition and considering the counterstatement: £300

Preparing and filing written submissions: £400

47. In the above assessment, two things should be noted:

- Although the opponent paid £200 as an official fee, it only succeeded on the ground under section 5(2)(b). An opposition based only on that ground would have cost £100 to file. Therefore, I consider that £100 is what the opponent should be compensated for.
- Although the opponent filed evidence, and had to consider the evidence of Mr Omeru, I have not made an award to reflect this. This is because Mr Omeru's evidence was extremely light. Further, the opponent's evidence played no part in its success in these proceedings.

48. I therefore order Mr Omeru to pay Monster Energy Company, the sum of £800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of March 2020

Oliver Morris
For the Registrar
the Comptroller-General