

O-287-20

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATION NO. 1302959
BY MERCK KGaA IN RESPECT OF THE TRADE MARK**



IN CLASSES 1, 2, 3, 5, 7, 9, 10, 11, 16, 17, 29, 30, 32, 35, 6, 35, 40, 41, 42 AND 44

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416698 BY
MONSTER ENERGY COMPANY**

BACKGROUND AND PLEADINGS

1) Merck KGaA (hereafter “the holder”) is the holder of an International Registration. It requested a UK designation of this International Registration (“IRUK”) no. 1302959 on 19 February 2019 to register the following trade mark that was then subsequently published for opposition purposes on 22 March 2019:



2) The designation was filed in respect of various goods and services in classes 1, 2, 3, 5, 7, 9, 10, 11, 16, 17, 29, 30, 32, 35, 6, 35, 40, 41, 42 and 44. For the purposes of these proceedings it is sufficient that I record these goods and services include the following:

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.*

Class 30: *Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.*

3) Monster Energy Company (“the opponent”) partially opposed the application on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the goods identified in the previous

paragraph. In respect of the first two grounds, the opponent relies upon six earlier trade marks, the relevant details of which are shown below (with the highlighted goods being those where the opponent claims a reputation):

3254978

Filing date: 6 September 2017 Date of entry in register: 1 December 2017
The list of goods relied upon: Class 29: <i>Dairy-based beverages and milk-based beverages containing coffee, chocolate and/or fruit juice; shakes.</i> Class 30: <i>Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; ready to drink coffee, iced coffee and coffee based beverages; ready to drink flavored coffee, iced coffee and coffee based beverages; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.</i> Class 32: <i>Energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages and other preparations for making beverages; beers.</i>

3350872


Filing date: 5 November 2018

Priority date: 8 May 2018 (priority country: EU)

Date of entry in register: 1 March 2019

The list of goods relied upon:

Class 32: *Non-alcoholic beverages, namely carbonated and non-carbonated **energy drinks**, carbonated and non-carbonated **sports drinks**, and drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs.*

[additionally, a reputation is claimed in respect of **fruit juice drinks, other non alcoholic beverages and other preparations for making beverages; beers**, but these terms are not covered by the specification]

EU12924718



Filing date: 30 May 2014

Date of entry in register: 29 October 2014

The list of goods relied upon:

Class 30: *Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; ready to drink coffee, iced coffee and coffee based beverages; ready to drink flavored coffee, iced coffee and coffee based beverages in Class 30.*

Class 32: *Non-alcoholic beverages in Class 32.*

EU15334824



Filing date: 12 April 2016

Date of entry in register: 17 August 2016

The list of goods relied upon:

Class 29: *Dairy-based beverages and milk-based beverages containing coffee, chocolate and/or fruit juice; shakes.*

Class 30: *Coffee, tea, cocoa and artificial coffee; coffee-based beverages; tea-based beverages; chocolate-based beverages; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.*

Class 33: *Alcoholic beverages except beers.*

[A claim of a reputation in various Class 32 goods is relied upon but this registration does not include this class]

EU12924973



Filing date: 30 May 2014

Date of entry in register: 29 October 2014

The list of goods relied upon:

Class 30: *Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; ready to drink coffee, iced coffee and coffee based beverages; ready to drink flavored coffee, iced coffee and coffee based beverages in Class 30.*

Class 32: *Non-alcoholic beverages in Class 32.*

EU17896505



Filing date: 8 May 2018

Date of entry in register: 26 September 2018

The list of goods relied upon:

Class 32: *Non-alcoholic beverages, namely carbonated and non-carbonated **energy drinks**, carbonated and non-carbonated **sports drinks**, and drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs.*

[additionally, a reputation is claimed in respect of **fruit juice drinks, other non alcoholic beverages and other preparations for making beverages; beers**, but these terms are not covered by the specification]

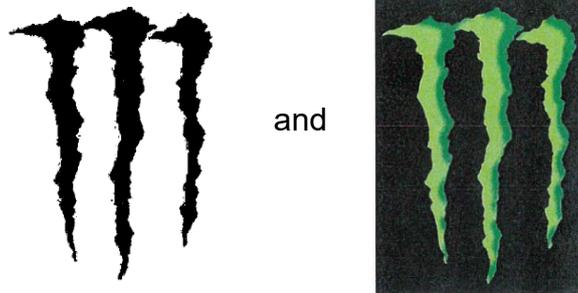
4) The opponent's marks are all earlier marks within the meaning of section 6(1) of the Act because they have earlier filing dates than the contested IRUK. They completed their registration procedures less than five years before the date of designating the UK and, as a result, they are not subject to the proof of use provisions contained in section 6A of the Act.

5) The opponent relies upon all of the earlier marks for its grounds based upon sections 5(1), (2)(a) and (b) of the Trade Marks Act 1994 (“the Act”). It claims that the respective marks are visually, aurally and conceptually identical or alternatively, highly similar. It also asserts that the respective goods are identical or similar.

6) The opponent relies upon its earlier marks 3254978, 3350872, EU15334824 and EU17896505 when pleading that the IRUK is open to objection under section 5(3) of the Act because the opponent has a reputation in respect of the goods identified (in bold) above, that the relevant public will believe that the respective marks are used by the same undertakings or believe that there is an economic connection between them. It claims that as a result:

- The holder will take unfair advantage of the opponent’s reputation because its mark will benefit from the opponent’s reputation without having contributed to any of the investment;
- Use of the IRUK will result in detriment to the reputation of the earlier marks because the opponent has spent considerable sums and resources in building up a brand with the earlier marks. The marks are identical/highly similar as are the respective goods and it is inevitable that the public will make an association between the respective marks and IRUK leading to detriment to the reputation of the earlier mark;
- Use of the IRUK will result in detriment to the distinctive character of the earlier marks because the holder is likely to gain advantage from the opponent’s extensive marketing and presence in the market place. The relevant public associate the distinctive character of the earlier marks with the opponent and because of the identity or high similarity to the opponent’s marks, use of the holder’s mark will cause confusion leading to detriment in the form of dilution of the value of the opponent’s goods and lead to a reduced willingness of consumers to purchase goods under the earlier marks.

7) In respect of the grounds based upon section 5(4)(a), the opponent asserts that use of the IRUK in respect of its Class 29, 30 and 32 goods will result in a misrepresentation leading to passing off. It relies upon the following two signs:



8) It claims that these signs were first used in the UK in 2008 and have been used in respect of *energy drinks, sports drinks, fruit juice drinks, other non-alcoholic beverages and other preparations for making beverages; beers*. It asserts that it has acquired goodwill in the UK and that use of the holder's mark would amount to misrepresentation with the relevant consumers mistakenly believing that the holder's goods originate from the opponent. This would lead to damage being caused to the opponent.

9) The holder filed a counterstatement denying the opponent's claims and putting to strict proof of the claimed reputation of its marks.

10) The opponent filed evidence and written submissions. The holder chose not to. There was no request for a hearing and I give my decision after careful consideration of the papers.

11) The opponent was represented throughout the proceedings by Sheridans Solicitors and the holder by A. A. Thornton & Co.

DECISION

Opponent's evidence

12) This takes the form of a witness statement from Rodney C. Sacks, Chairman and Chief Executive Officer of Monster Beverage Corporation and its subsidiaries including the opponent. I note this evidence, but for reasons that will become apparent, it is not necessary that I refer to it.

Sections 5(1) and 5(2)(a)

13) Sections 5(1) and 5(2)(a) of the Act are as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”

14) The opponent submits that the respective marks are visually, aurally and conceptually identical. I disagree. Whilst all the marks may be perceived as alluding to the letter “M” the visual presentation of the opponent’s marks is likely to create doubt in the mind of the average consumer. The holder’s mark is presented as a flattened “m” type shape. Its orientation is also consistent with the letter, but it is also device like in character with the curvy nature of its lines. The opponent’s marks all present as a device in the form of three elongated claw marks positioned in such a way as to potentially bring to mind the letter “M”. The visual differences between

the parties' marks are such as to rule out any argument that the respective marks are identical. Further, there is a conceptual identity (of claw marks) present in the opponent's marks that is absent in the holder's mark. I find that the marks are not identical.

15) This finding is sufficient to defeat both the section 5(1) ground and also the section 5(2)(a) ground.

Section 5(2)(b)

16) 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”.

Comparison of goods and services

17) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, 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”.

18) 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 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. 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.

19) In addition, I also keep in mind the guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, when it stated that:

“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 trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”

20) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking”.

Class 29

Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

21) In respect of the holder’s *milk and milk products*, the opponent submits that these are identical to its *diary-based beverages and milk-based beverages containing coffee, chocolate, chocolate and/or fruit juice, shakes* of its earlier mark 3254978. I agree that these are all included in the holder’s *milk products* and, therefore, applying the principle in *MERIC*, they are identical. They also share a good deal of similarity to *milk* because they are both beverages used for refreshment or nourishment.

22) The opponent also relies on various other goods covered by other of its earlier marks in Class 30 and Class 32, but none of these place it in a stronger position. I will not consider these further.

23) In its written submissions, the opponent is silent on the similarity between the remainder of the holder’s Class 29 goods and it is not obvious to me what the similarity is. Therefore, in the absence of submissions or evidence on the point¹, I find that they are not similar to any of the opponent’s goods.

Class 30

Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; edible ices; sugar, honey,

¹ *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07 at [47] where it is stated that it is necessary to adduce evidence of similarity between goods.

treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

24) The opponent identifies the Class 30 specification of its earlier mark 3254978, submitting that the respective goods are identical or highly similar. I agree that most are self-evidently identical. The only exception is the holder's *cocoa and artificial coffee* that do not have the equivalent in the opponent's specification. That said, I agree with the opponent that they are *highly similar*. *Artificial coffee* differs only in its ingredient but in all other respects it is identical the opponent's *coffee based beverages*. Similarly, with the holder's *cocoa*, it is also a hot beverage and is highly similar to all of the opponent's tea and coffee beverages.

Class 32

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

25) The opponent's earlier marks 3254978 and include unspecified *non-alcoholic beverages* and this broad term includes the holder's *mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices*. Applying the *MERIC* principle, they are identical. The opponent's 3254978 also includes *beer* and therefore, is identical to the same term in the holder's specification. Finally, the opponent's 3254978 includes preparations for making beverages and these are, self-evidently identical to the holder's *syrups and other preparations for making beverages*.

Comparison of marks

26) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, 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.”

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

28) All of the opponent’s earlier marks are in respect of marks that vary only in minor detail. Therefore, for procedural economy, I will restrict my comparison to the opponent’s 3254978 mark. My findings in respect of this mark will be materially the same in respect of all the opponent’s earlier marks. The respective marks are shown below:

Opponent’s mark	Holder’s mark
	

29) The opponent’s mark consists of a device comprising three vertical elements positioned alongside each other. They resemble three tear marks left by claws. The opponent submits that it is a logo version of the letter “M” and I accept that some consumers may perceive this. However, if it is perceived as a letter “M”, it is very likely to also be perceived as consisting of three claw marks. Therefore, the

distinctive character of the mark resides in the combination of the three elements with no one element being more dominant than the other, each contributing in an equal way to the distinctive character. The holder's mark consists of a device that more obviously brings the letter "M" to mind. It is the only element and it is self-evidently the dominant and distinctive element.

30) Visually, the opponent submits that the respective marks are logo versions of a capital letter "M" and it points out that they are both presented in black upon a white background. It also explains that its mark's design was inspired by the claws of the dinosaur called a velociraptor. This is consistent with my finding in the previous paragraph. Whilst I have already acknowledged that the opponent's earlier mark may present as a letter "M" to some consumers, the overriding impression is of three claw marks. Such consumers may recognise that both marks are allusive of a letter "M", however, their presentation and stylisation of the respective marks are significantly different in all other visual respects and I conclude that the respective marks share only a low level of visual similarity.

31) The opponent also submits that because its marks are famous they will, therefore, be automatically recognised as belonging to the "Monster" brand. The GC have provided guidance to the effect that reputation plays no part in the comparison of the marks² and, therefore, I reject this argument.

32) Aurally, if the consumer "sees" beyond the stylisation, both marks may be expressed aurally as the letter "M". In such circumstances, they are aurally identical.

33) Conceptually, the opponent's mark is likely to be perceived as three claw marks. As I have already acknowledged, these are presented in such a way that some consumers may be reminded of a letter "M". The holder's mark is more readily identifiable as a letter "M" but the concept of claw marks is absent. Taking all of this into account, I conclude they share a low to medium level of conceptual similarity.

Average consumer and the purchasing act

² *Ravensburger AG v OHIM*, Case T-243/08 at [27]

34) 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*.

35) 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.”

36) All the respective goods are ordinary food and drink or grocery items and the average consumer for all these goods is likely to be predominantly the general public. Such goods are every day or regular purchases where the level of care and attention is not particularly high. The purchasing act is pre-dominantly visual in nature with the products being selected from the shelf in a shop or the online equivalent, however, I do not rule out that aural considerations may play a part in some circumstances, for example, where a drink is ordered at a bar. In such circumstances, visual considerations remain important because the consumer is still likely to visually select the drink from a display of bottles or cans or, in the case of beer, from a pull-pump before ordering.

Distinctive character of the earlier trade marks

37) 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).”

38) In respect of the earlier mark’s inherent distinctive character, the opponent submits that it is “acquired by the visual representation of the marks: the use of the lines in the shape of an M, resembling claw marks...”³. I generally agree with this comment, with the one proviso that the mark is not obviously a letter “M”. That said, taking account of the stylisation creating the impression of claw marks, I find that it creates a medium level of inherent distinctive character (being neither particularly high, nor low).

39) In its written submissions, the opponent claims that because of the reputation its marks enjoy, they benefit from an enhanced distinctive character of its mark based upon huge marketing spend figures and extensive marketing activities in the UK.

³ Opponent’s written submissions at [23]

Much of the opponent's evidence goes to demonstrate this. I do not intend to summarise it here but, for the purposes of this decision, I will proceed on the basis that the significant use of the mark, in respect of the goods where it claimed a reputation, has resulted in it gaining a level of enhancement that results in a high level of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

40) The following principles are obtained from the decisions of the CJEU 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

41) 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). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which 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 and goods down to the responsible undertakings being the same or related).

42) The opponent submits that there is a high likelihood of confusion. This assertion is based upon its premise that the respective marks are identical or highly similar visually, phonetically and conceptually. Whilst I have found that the respective marks are aurally identical, I have also found that the respective marks share only a low level of visual similarity and a low to medium level of conceptual similarity. I factor this into my considerations together with my other findings, namely:

- The majority of the respective goods are identical;
- The dominant and distinctive element of the holder's mark resides in its single element. The opponent's mark consists of three parallel "claw mark" devices that combine to create a distinctive whole. No one of these is more dominant than the other;
- The average consumers is likely to be predominantly the general public.
- The level of care and attention during the purchasing act is not particularly high;
- The purchasing act is pre-dominantly visual in nature but I do not rule out that aural considerations may play a part;
- The opponent's mark has medium level of inherent distinctive character and for the purposes of this decision, I am proceeding on the assumption that it has a high level of enhanced distinctive character.

43) The high point of the opponent's case is that both marks may be perceived as a representation of a letter "M", however, even where the respective goods are identical, the striking visual differences and the absence of the "claw marks" concept in the holder's mark is such that upon the consumer encountering one of the marks, it is not likely to bring the other to mind. The opponent's mark presents as three claw marks and is a powerful conceptual message and striking visual aspect of the mark. On the other hand, the holder's mark presents as a simple design presenting as a slightly squat letter "M". The contrast between the two is such as to not result in the

respective marks even bringing the other to mind and suggests that there is no likelihood of direct or indirect confusion even when identical goods are involved.

44) Whilst the respective marks may be aurally identical and it is possible that aural aspects may play a part in the purchasing process, it is my view that purchases will rarely be conducted purely on an aural basis. There may be a combination, for example in circumstances where the consumer asks for the goods by reference to the mark, but upon being presented with the goods it will be evident whether it is the correct goods.

45) This finding is undisturbed when any of the other of the opponent's six earlier marks are considered. As I noted earlier, none of these place the opponent in a stronger position.

46) Taking all of the above into account, I conclude that there is no likelihood of confusion and the opposition fails insofar as it is based upon section 5(2)(b).

Section 5(4)(a)

47) Section 5(4)(a) states:

“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.”

48) The opponent's case is based upon its claim that the respective mark and signs are identical or very similar and that a likelihood of confusion arises as a result of this. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumer are confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here and I find that, because of the differences between the opponent's signs and the holder's mark, members of the public are not likely to be misled into purchasing the holder's goods in the belief that they are the opponent's goods.

49) The opposition fails, insofar as it is based upon section 5(4)(a) of the Act.

Section 5(3)

50) Section 5(3) of the Act states:

"5. - (1) ...

(2) ...

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

(b) (repealed)

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 (EU) 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."

51) I keep in mind that:

- a 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*, Case 252/07 [24], and;
- 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*, Case C-487/07 [29] and *Intel*, Case C-408/01 [63].

52) Therefore, the mark must have established a reputation by the relevant date and the challenged mark must create a link before detriment or unfair advantage can occur. In the purposes of this decision, I will proceed on the basis that the opponent has the requisite reputation in respect of the goods identified in the table at paragraph 3 of this decision and that this reputation is a strong one.

53) In respect of the requisite link, I keep in mind that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion⁴. However, in the current case, I have already found that the differences between the respective marks are such as one will not bring the other to mind, even in circumstances where the respective goods are identical. The absence of a bringing to mind is sufficient to find that the requisite link has not been established.

54) In the absence of a link in the mind of the public, there can be no detriment or unfair advantage⁵.

55) In light of this finding, I conclude that the grounds based upon section 5(3) fail in their entirety.

⁴ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P at [72]

⁵ *Intel Corporation Inc. v CPM United Kingdom Ltd*, C-252/07 at [31]

Summary

56) The opposition fails in its entirety and the designation of the UK of IRUK 1302959 can be confirmed on the register

Costs

57) The holder has been wholly successful and is entitled to an award of costs. Awards of costs are made on a contributory basis as set out in the scale published in Tribunal Practice Notice 2/2016. I keep in mind that only the opponent filed evidence and submissions and that there has been no hearing. I award costs as follows:

Considering statement and preparing counterstatement:	£400
Considering evidence:	£300
TOTAL	£700

58) I, therefore, order Monster Energy Company to pay Merck KGaA the sum of £700. The above sum should be paid within 2 months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of May 2020

Mark Bryant

For the Registrar

The Comptroller-General