

**O-506-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3285284  
IN THE NAME OF GUDSEN TECHNOLOGY CO., LTD  
TO REGISTER**



**AS A TRADE MARK  
IN CLASSES 09 AND 12**

**AND**

**OPPOSITION THERETO UNDER NO. 412616  
BY MONSTER ENERGY COMPANY**

## BACKGROUND

1) On 25 January 2018, Gudsen Technology Co., Ltd ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of the following goods:

**Class 9:** Computer peripheral devices; Smartphones; Camcorders; Cinematographic cameras; Cameras [photography]; Cases especially made for photographic apparatus and instruments; Tripods for cameras; Selfie sticks [hand-held monopods]; Optical lenses; Batteries, electric.

**Class 12:** Electric vehicles; Motorcycles; Cars; Remote control vehicles, other than toys; Motors, electric, for land vehicles; Bicycles; Air vehicles; Boats; Suspension shock absorbers for vehicles; Shock absorbers for automobiles; Vehicle seats.

2) The application was published in the Trade Marks Journal on 02 March 2018 and notice of opposition was later filed by Monster Energy Company ('the opponent').

3) The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). In support of its grounds under section 5(2)(b) of the Act, the opponent relies upon the following:

Trade Mark details	Goods and services relied upon
<p><b>Registration No: UK3254978</b> (<b>'78</b>)</p>  <p><b>Filing date: 06 September</b> <b>2017</b></p> <p><b>Date of entry in register: 01</b></p>	<p><b>Class 09:</b> Protective covers and cases for cell phones, laptops, tablets, portable media players and other electronic devices, namely, mobile phones, smartphones, media players, music players, computers, and portable electronic devices; earphones and headphones; protective ear coverings, namely helmets; eye glasses, eye glass cases, sunglasses, sunglass cases.</p>

<p><b>December 2017</b></p>	<p><b>Class 35:</b> Promoting goods and services in the sports, motorsports, electronic sports, and music industries through the distribution of printed, audio and visual promotional materials; promoting sports and music events and competitions for others.</p> <p><b>Class 41:</b> Entertainment; sporting and cultural activities.</p>
<p><b>Registration No: EU11669851 ('51)</b></p>  <p><b>Filing date: 19 March 2013</b>  <b>Date of entry in register: 24 October 2013</b></p>	<p><b>Class 09:</b> Protective covers and cases for cell phones, laptops, tablets, portable media players and other electronic devices, namely, mobile phones, smartphones, media players, music players, computers and portable electronic devices; earphones and headphones; protective ear coverings, namely, helmets; eye glasses, eye glass cases, sunglasses, sunglass cases.</p> <p><b>Class 28:</b> Protective covers and cases for other electronic devices, namely hand-held video game systems.</p>

4) Under section 5(3) of the Act, three marks are relied upon. The first is mark '78 (shown in the table above) in respect of 'Energy drinks, sports drinks, fruit juice drinks and other non-alcoholic beverages' in class 32. Details of the second and third marks are shown below:

Trade Mark details	Goods relied upon
<p><b>Registration No: EU12924718 ('18)</b></p>  <p><b>Filing date: 30 May 2014</b>  <b>Date of entry in register: 29 October 2014</b></p>	<p><b>Class 32: Non-alcoholic beverages.</b></p>
<p><b>Registration No: EU11154739 ('39)</b></p>  <p><b>Filing date: 31 August 2012</b>  <b>Date of entry in register: 09 January 2013</b></p>	<p><b>Class 32: Non-alcoholic beverages.</b></p>

5) The opponent claims that the marks relied upon under section 5(3) have a strong reputation in respect of the goods covered by them in class 32. It is claimed that the consumer will make a link between the respective marks leading to unfair advantage and detriment to the earlier marks' reputation and distinctive character.

6) Under section 5(4)(a) of the Act, the opponent relies upon use of three signs. The representations of those signs are identical to earlier marks '39, '18 and '78. It is

claimed that all three signs have been used throughout the UK since 2008, in relation to 'drinks' and that use of the applicant's mark in respect of the goods applied for will mislead the public into believing that its goods are provided by, endorsed by, or otherwise commercially linked to, the opponent. It is said that this confusion will lead to damage to the opponent's goodwill associated with its earlier signs.

7) The trade marks relied upon by the opponent under Sections 5(2) and 5(3) are earlier marks, in accordance with section 6 of the Act. As mark '39 is the only mark to have completed its registration procedure more than five years prior to the publication date of the contested mark, it is only that mark which is subject to the proof of use conditions, as per section 6A of the Act.

8) The applicant filed a counterstatement in which it puts the opponent to proof of use of earlier mark '39. It also denies all the grounds of opposition. In particular, I note the applicant states that:

- The applicant's mark consists of the device of an animal's claws surrounding the invented word MOZA (which has no meaning) whereas the opponent's marks consist of the device of, what is likely to be perceived as, a stylised spikey letter 'M' or a trident fork. As such, it states that there are clear visual and conceptual differences between the respective marks.
- With the possible exception of 'Cases especially made for photographic apparatus and instruments', none of the goods covered by its application are similar to the opponent's goods and services.
- Any reputation and goodwill which the opponent's marks enjoy is limited to energy drinks which are so different from applicant's goods that consumers will not make any link between the respective marks or believe that the applicant's goods are in any way connected with those of the opponent.

9) Both parties filed evidence. Neither party requested to be heard; only the opponent filed written submissions in lieu. I now make this decision after carefully considering all the papers before me.

## **EVIDENCE**

### **Opponent's evidence**

10) The opponent's evidence comes from Paul J. Dechary, Senior Vice President and Deputy General Counsel of Monster Beverage Corporation and its subsidiaries. One of those subsidiaries is the opponent. It suffices to record here that the overwhelming majority of the evidence relates to extensive use the opponent has made of its earlier marks in relation to energy drinks, including extensive advertising and promotion of those goods through various means such as sponsorship of sporting/music events and professional athletes. The remainder of the evidence relates to use in relation to merchandise such as clothing and headgear.

### **Applicant's evidence**

11) The applicant's evidence is from Guan Chenyong, Chief Executive of the applicant company. The evidence gives details of the genesis of the applicant's mark and the use that has been made of it in relation to film and video camera equipment. I also note that, in his witness statement, Guan Chenyong states:

“I note that several claims rely on the reputation that the Opponent's marks have acquired in the United Kingdom. However, the Opponent's evidence shows only a reputation in the field of energy drinks.”<sup>1</sup>

I will bear this statement in mind when I come to assess the claim to reputation under section 5(3) of the Act. I also take this statement to be a (sensible) concession that the opponent's evidence is sufficient to prove genuine use of earlier mark '39 in respect of energy drinks. I do not consider it necessary to also consider whether genuine use has been proved for other kinds of 'non-alcoholic beverages' because this would not, in the circumstances, improve the opponent's prospects of success.

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<sup>1</sup> Witness Statement of Guan Chenyong, paragraph 10.

## DECISION

### Section 5(2)(b)

12) This section of the Act provides that:

“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.”

13) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Approach**

14) I note that the two marks relied upon under this ground are identical and are also registered in relation to the same goods in class 09. Those goods clearly represent the opponent's best prospect of success. Accordingly, it is only necessary to base my assessment on one of the earlier marks. I will use mark '78.

15) I will first assess matters based on the parties' identical goods in class 09. The identity lies between the opponent's "Protective covers and cases for...portable electronic devices" and the applicant's "Cases especially made for photographic apparatus and instruments"<sup>2</sup>. If the opponent is unsuccessful on that basis, it is clearly in no stronger position in relation to any of its other goods and services under section 5(2)(b).

## **Average consumer and the purchasing process**

16) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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:

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<sup>2</sup> In accordance with *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) where the General Court 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)."

“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.”

17) The average consumer of the parties’ goods in class 09 is the general public. The goods are cases for portable (photographic) electronic devices. This includes cases for mobile phones, traditional cameras and the like. Generally speaking, such goods are not, in my experience, particularly expensive items. That said, the consumer is likely to take account of the size and shape of the goods and will wish to ensure that they are the correct ‘fit’ for the device in question. Aesthetic appeal may also play a part. I would expect a normal level of attention to be paid. The goods will be sought out by visual means in high-street shops or on-line equivalents and therefore the visual aspect is particularly important. However, I also bear in mind the potential for aural use of the marks during the selection process.

### **Comparison of marks**

18) 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.”

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

19) The marks to be compared are:

Opponent's mark	Applicant's mark
	

20) The overall impression of the opponent's mark is based upon the sole device element of which it consists. The applicant's mark consists of two elements. The first element is the word MOZA (the stylisation of the letter 'O' is so subtle as to be barely noticeable). The second element is the four claws surrounding that word. Both elements are distinctive. I find that the two elements contribute roughly equally to the overall impression of the mark.

21) Visually, there are notable differences between the respective marks due to the absence of the word MOZA in the opponent's mark and the very different appearance of the respective device elements. The device in the opponent's mark consists of three long jagged-edged slash-type markings. The device in the applicant's mark consists of shorter smooth-edged curved claws (three above the word 'MOZA' and one below). I struggle to see any visual similarity between the marks; in my view they are not visually similar. Aurally, the opponent's mark will not

be vocalised. Only the word MOZA in the applicant's mark will be spoken. There is no aural similarity.

22) The opponent contends that both marks consist of 'claw' devices which are conceptually identical and that the word MOZA in the applicant's mark will be perceived as meaning 'monster'. The applicant submits that:

“...the Opponent's mark does not really give the impression of a claw, but rather a stylised “spikey” letter “M” or a trident fork.”<sup>3</sup>

I have no doubt that the applicant's device will be perceived as claws (of the animalistic kind). The opponent's mark, in my view, is likely to be perceived as slashes which have been made by claws but that is not the same concept as claws *per se*. I accept that the mark may also (or alternatively) be perceived as a stylised letter 'M' given its resemblance to that letter. In terms of the applicant's MOZA element, I would expect this to be perceived as an invented word with no meaning. Even if it were perceived as being reminiscent of the word 'monster', as contended by the opponent (but which I consider unlikely), that would, in any event, create a point of conceptual difference between the marks because the opponent's device mark, of itself, sends no such concept. It follows that however the opponent's mark is perceived, it shares no conceptual similarity with the applicant's mark. If I am wrong on that, any conceptual similarity between the marks (stemming from the respective device elements) is low.

### **Distinctive character of the earlier marks**

23) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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<sup>3</sup> Form TM8, Statement of Case, paragraph 3.

“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).”

24) None of Mr Dechary’s evidence shows any use of the earlier mark in relation to “Protective covers and cases for...portable electronic devices”. Therefore, I have only the inherent degree of distinctiveness of the earlier mark to consider. The mark does not describe or allude to the goods covered by it in any way. In my view, it has a normal level of distinctiveness.

### **Likelihood of confusion**

25) When conducting the global assessment of the likelihood of confusion, I must keep in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods/services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) 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.*).

26) I have found that the marks are not visually or aurally similar and share no conceptual similarity or, if I am wrong on the latter point, only a low degree of conceptual similarity. These factors all clearly point strongly in the applicant's favour. I have no hesitation in finding that, despite the normal degree of distinctiveness of the earlier mark and the identity between certain of the respective goods in class 09, there is neither a likelihood of direct nor indirect confusion on the part of an average consumer paying a normal level of attention. As per my comments in paragraph 15, **the opposition under section 5(2)(b) fails in its entirety.**

### **Section 5(3)**

27) This section of the Act states:

“5(3) A trade mark which-

(a) 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.”

28) The leading cases in assessing a claim under section 5(3) of the Act are 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, *Addidas-Salomon*, [2004] ETMR 10 and Case 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 later mark would cause an average consumer to bring 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 likelihood 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**

29) It is abundantly clear from the evidence before me that all the opponent’s marks, which are relied upon under this ground, have a substantial reputation in the UK in relation to energy drinks. As I noted earlier, the applicant has sensibly conceded that such a reputation exists.

## **Link**

30) Whether the public will make the required mental ‘link’ between the respective marks must take account of all relevant factors. The relevant factors identified in *Intel* are:

The degree of similarity between the conflicting marks

31) I have already assessed the similarity between the applicant's mark and mark '78. I found that those marks are not visually or aurally similar and share no conceptual similarity or, if I am wrong on the latter point, only a low degree of conceptual similarity. Those findings are equally applicable here.

32) Mark '18 differs to mark '78 only in respect of the colour in which it is presented. My findings in respect of the latter apply equally to the former.

33) I now to turn to assess the similarity between mark '39 and the applicant's mark:



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I bear in mind my earlier comments regarding the relative weight of the elements within the applicant's mark. The opponent's mark consists of four elements. The 'slashes' device (presented in green), the word MONSTER (stylised), the word 'ENERGY' and the black rectangular background. The descriptive nature of the 'ENERGY' element, and its small size, mean that it has very little weight in the overall impression. The black rectangular background serves as little more than a backdrop for the other elements of the mark; it also has little weight in the mark's overall impression. The 'slashes' device is distinctive and the largest most visually striking element of the mark. The word MONSTER is also distinctive and visually prominent. Those latter two elements contribute substantially (and to a roughly equal extent) to the overall impression.

34) Visually, I have already addressed the similarity between the respective device elements. There is a point of visual coincidence between the respective words 'MONSTER' and 'MOZA' to the limited extent that they both begin with the letters 'MO'. The other letters within those words are different and 'MOZA' is shorter than

'MONSTER'. Further points of visual difference arise due to the presence of 'ENERGY' and the black background in the opponent's mark which are absent from the applicant's mark. Considering the marks as wholes, I find no visual similarity or, at best, a very low degree of visual similarity.

35) Aurally, the applicant's mark consists of two syllables, likely to be pronounced as MOZ-AH (MOZ as in moth). The opponent's mark will be spoken in an entirely predictable fashion. If both words in the opponent's mark are spoken, there is a very low degree of aural similarity. If only the 'MONSTER' element is spoken, I find a medium degree of aural similarity with 'MOZA'.

36) Conceptually, the opponent's mark sends a clear conceptual message of a monster (a mythical beast). The presence of that word will, no doubt, lead the consumer to perceive the 'slashes' device as those which have been made by a monster's claws or possibly as monster claws per se. The 'slashes' device may also (at the same time) be perceived as a stylised letter 'M' given its resemblance to that letter and its presence above the word 'MONSTER' (which begins with 'M'). Turning to the applicant's mark, I have already found that the device will be perceived as claws and that the word MOZA is likely to be perceived as invented. Considering the marks as wholes, there is a low degree of conceptual similarity between them (stemming from the common 'claw' concept).

37) Overall, there is a low degree of similarity between mark '39 and the applicant's mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

38) Although both parties' goods will be purchased by the general public, the respective nature, uses, methods of use and trade channels of the opponent's energy drinks are obviously entirely different to those of the applicant's goods. Neither are they in competition or complementary. The opponent's energy drinks are wholly dissimilar to all the applicant's goods in classes 09 and 12.

*The strength of the earlier mark's reputation*

39) All of the earlier marks have a substantial reputation in relation to energy drinks.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

40) All the earlier marks have a very high degree of enhanced distinctiveness, consequent upon the use made of them in the UK in relation to energy drinks.

41) Having considered all the above factors, I find that the very high degree of enhanced distinctiveness and substantial reputation of the earlier marks in respect of energy drinks is unlikely to lead to the requisite link in the mind of the average consumer, given the wholly dissimilar goods in play and the low degree of similarity between the applicant's mark and each of the earlier marks. Without a link, there can be no damage or unfair advantage. **The claims under section 5(3) of the Act fail.**

**Section 5(4)(a)**

42) 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.”

43) 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 as follows:

“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).”

44) I find that, whilst it is clear on the evidence before me that the opponent’s business selling energy drinks enjoys a substantial goodwill and that each of the rights relied upon is associated with that goodwill, the very different fields of activity of the parties<sup>4</sup>, together with the low degree of similarity between the respective marks<sup>5</sup> is such that I do not find that a substantial number of the opponent’s customers (or potential customers) will believe that the applicant’s goods in classes 09 and 12 are, in any way, connected with the opponent. There is no misrepresentation. Without misrepresentation, there can be no damage. **The claims under section 5(4)(a) of the Act fail.**

## **OUTCOME**

**45) The opposition fails in its entirety.**

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<sup>4</sup> As per my findings in paragraph 38.

<sup>5</sup> As per my earlier findings, in relation to the relevant identical marks relied upon under ss.5(2) and 5(3).

## **COSTS**

46) As the applicant has been successful, it is entitled to a contribution towards its costs. I make no award for the preparation of the applicant's evidence as it was of no assistance to me. Using the guidance in Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

Preparing a statement and considering the opponent's statement	£300
Considering the other side's evidence	£500
<b>Total:</b>	<b>£800</b>

47) I order Monster Energy Company to pay Gudsen Technology Co., Ltd the sum of **£800**. This sum is 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 29 day of August 2019**

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