

O/0511/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001735581

DESIGNATING THE UK

IN THE NAME OF QUALITY FIRST GMBH

FOR THE FOLLOWING TRADE MARK:



MORE  
NUTRITION

---

MORE  
BIOTIC

IN CLASSES 32 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 443437 BY

MONSTER ENERGY COMPANY

## BACKGROUND AND PLEADINGS

1. International registration no. 1735581 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Quality First GmbH. The IR is registered with effect from 28 February 2023. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the goods and services listed in Annex 1 to this decision.

2. On 6 October 2023, Monster Energy Company (“the opponent”) opposed the protection of the IR in the UK based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) of the Act, the opponent relies upon the following trade marks:



UKTM no. 3875956

Filing date 8 February 2023; registration date 28 April 2023

Priority date: 1 September 2022 (USA)

(“the First Earlier Mark”)



UKTM no. 3350872

Filing date 5 November 2018; registration date 1 March 2019

Priority date: 8 May 2018 (EU)

("the Second Earlier Mark")



UKTM no. 3431545

Filing date 25 September 2019; registration date 13 December 2019

("the Third Earlier Mark")



UKTM no. 3758359

Filing date 23 February 2022; registration date 12 August 2022

("the Fourth Earlier Mark")



UKTM no. 3576729

Filing date 8 January 2021; registration date 14 May 2021

("the Fifth Earlier Mark")

3. Whilst these marks are registered across multiple classes, only some of the goods and services for which they have protection are relied upon for the purpose of this opposition (the details of which are set out in Annex 2 to this decision). The goods and services underlined in Annex 2 are relied upon by the opponent in relation to its section 5(2)(b) opposition.

4. The opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

5. Whilst I note that the opponent has indicated that the section 5(2)(b) opposition relates to only some of the goods and services for which the holder seeks protection, it has listed all of the goods and services that remain subject of this IR in its Form TM7.<sup>1</sup> Consequently, I will treat the whole application as opposed.

6. Under section 5(3) of the Act, the opponent relies upon the Second and Third Earlier Marks. In addition, the opponent relies upon the following mark:

---

<sup>1</sup> I understand that the holder has divided its application and so the unopposed terms are no longer relevant.



UKTM no. 911154739<sup>2</sup>

Filing date 31 August 2012; registration date 9 January 2013

("the Sixth Earlier Mark")

7. The opponent claims to have a reputation for those goods highlighted in bold in Annex 2 to this decision. The opponent claims that use of the IR would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the Second, Third and Sixth Earlier Marks.

8. Under section 5(4)(a) of the Act, the opponent relies upon following signs which it claims to have used throughout the UK since 2008 in relation to "non-alcoholic beverages".



---

<sup>2</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing European Union trade mark ("EUTM"). As a result of the opponent having an EUTM protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

9. The opponent claims that use of the IR would be contrary to the law of passing off.

10. The holder filed a counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of the Sixth Earlier Mark.

11. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful consideration of all the papers on file.

## **REPRESENTATION**

12. The holder is represented by Stevens & Bolton LLP.

13. The opponent is represented by Bird & Bird LLP.

## **EVIDENCE AND SUBMISSIONS**

14. The opponent filed evidence in chief in the form of the witness statement of Paul J Dechary dated 29 February 2024, which is accompanied by 44 exhibits (PJD-1 to PJD-44). Mr Dechary is the Executive Vice President and Deputy General Counsel of the opponent. Exhibit PJD4 is subject to a confidentiality order.

15. The holder filed evidence in the form of the witness statement of Svenja Wachtel dated 2 May 2024, which is accompanied by 10 exhibits (SW1 to SW10).

16. The opponent filed evidence in reply in the form of the witness statement of Charlotte Peacock dated 3 July 2024, which is accompanied by 10 exhibits (CP1 to CP10). Ms Peacock is a solicitor acting on behalf of the opponent in these proceedings.

17. Both parties filed written submissions in lieu dated 22 August 2024.

18. I have taken the evidence and submissions into consideration in reaching this decision and will refer to them below, where necessary.

## **RELEVANCE OF EU LAW**

19. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **DECISION**

20. Section 5(2)(b) of the Act reads as follows:

“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.”

21. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

22. The First, Second, Third, Fourth and Fifth Earlier Marks are relied upon under this ground. Given their earlier filing dates, all five qualify as earlier trade marks pursuant to section 6 of the Act. Further, as they had not completed their registration process more than 5 years prior to the designation date of the IR, they are not subject to the use provisions in section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services identified for those marks.

23. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

### **Comparison of goods and services**

24. The goods and services to be compared are set out in the Annexes to this decision.

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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.”

26. I note that the holder has provided evidence about the goods they sell in the marketplace. For the avoidance of doubt, the comparison I must undertake is between the goods/services in the respective specifications, not between the goods/services the parties actually sell. I also note that in her evidence Ms Wachtel states:

“18. The [holder]’s products are sold in spray bottles, screw top tubs and bottles, or in sachets, each bearing the [holder]’s brands. None of the [holder]’s products bearing the MORE NUTRITION brands are sold in pressurised cans (or cans at all), which appears to be the only form in which the Opponent’s products are available.”

27. Ms Peacock has filed evidence in reply to demonstrate that the opponent’s goods are, sometimes, sold in bottles. None of this is relevant to the decision I must make, as the comparison is between the specifications, not the way in which the goods are packaged.

28. The term “fruit squashes” in the specification of the IR falls within the broader term “fruit drinks” in the specification of the First Earlier Mark; they are, therefore, identical on the principle outlined in *Meric*.

29. The term “energy drinks” in the specification of the IR falls within the broader terms “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” in the specification of the Second Earlier Mark and “Non-alcoholic beverages, including carbonated drinks and energy drinks”

in the specification of the Third Earlier Mark. They are, therefore, identical on the principle outlined in *Meric*.

30. The term “advertising” in the specification of the IR falls within the broader term “advertising, marketing and promotional services” in the specification of the Fourth Earlier Mark.

31. As the First, Second, Third and Fourth Earlier Marks have protection for a term identical to one listed in the specification of the IR, I will carry out my assessment in respect of those marks on the basis of identical goods and services as that represents the opponent’s best case. If there is no confusion in respect of identical goods/services, it follows that there will also be no confusion in respect of less similar goods/services.

32. In relation to the Fifth Earlier Mark, the opponent’s submissions appear to focus on the fact that both parties’ specifications cover retail services (albeit in relation to different goods). In my view, the best that can be said is that there is a low degree of similarity arising from a very general level of overlap in nature (both are types of retail service, albeit different ones), method of use (both may be accessed through webpages, for example), user (both may be used by members of the general public), and purpose (both are intended to facilitate the sale of goods). However, given the very general nature of these overlaps, I conclude that any similarity that does exist is at a low level.

### **The average consumer and the nature of the purchasing act**

33. 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.

34. 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.”

35. The average consumer for the goods and services will be either members of the general public and, in the case of the services, business users. The cost of the goods is likely to be relatively low, and they are likely to be reasonably frequent purchases. However, factors such as flavour and sugar content are likely to be considered when purchasing the goods. Consequently, I consider that a medium degree of attention is likely to be paid. I recognise that some of the services are likely to be a more considered and less frequent purchase, and so a higher (although not high) degree of attention will be paid.

36. The goods are likely to be self-selected from the shelves of a retail outlet or an online equivalent. The services are likely to be selected following perusal of websites or physical premises. Consequently, visual considerations will dominate the purchasing process for the goods and services. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part.

### **Comparison of trade marks**

37. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing

in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

38. 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.

39. The respective trade marks are shown below:

| Opponent’s trade marks                                                                                                      | The IR                                                                               |
|-----------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------|
| <br>(the First and Second Earlier Marks) |  |

|                                                                                                                                                                                                                                                  |  |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|
|  <p>(the Third Earlier Mark)</p>  <p>(the Fourth and Fifth Earlier Marks)</p> |  |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|

### Overall Impression

40. The First and Second Earlier Marks consist of a device made up of three long lines, with another (much shorter) line at the top of each (which is at a right angle to the first). Each line is jagged in appearance and tapers off to a point at the bottom. The lines are presented in two different shades of green, giving a somewhat three-dimensional appearance. The device is presented on a black background. The device itself plays the greater role in the overall impression of the mark, with the background playing a lesser role.

41. The Fourth and Fifth Earlier Marks consist of the same device, presented entirely in black. The overall impression of the marks resides in the device itself.

42. The Third Earlier Mark consists of the same device, with the addition of text beneath it. The word MONSTER is the largest, presented in a stylised font (with the O

struck through vertically), and the word ENERGY is presented in smaller writing beneath it. In my view, the word MONSTER (being the largest text element to which the eye is naturally drawn) and the device (due to its size), play the greater role in the overall impression.

43. The IR consists of the letter M presented in bold font above the words MORE NUTRITION MORE BIOTIC, which are separate by a pink line. The letter M draws the eye due to its size and bold font. The words MORE BIOTIC also draw the eye due to their size. These elements play the greater role in the overall impression. The words MORE NUTRITION play a lesser role due to their size and lighter font. The pink line plays an even lesser role.

#### Visual Comparison

44. The First and Second Earlier Marks and the IR overlap in that the shape of the device in the First and Second Earlier Mark is similar to the letter M in the IR. However, they differ in the presentation of the device as a claw mark in the First and Second Earlier Marks, and the additional words in the IR which are absent from the First and Second Earlier Marks. Further, the use of colour in each mark is an additional point of difference. In my view, any similarity between these marks is at a low degree.

45. The same assessment also applies to the Fourth and Fifth Earlier Marks, with the exception that as these marks are registered in black and white, they could be used in any colour (including the colours used in the IR). Consequently, the colours do not act as a point of visual difference in the same way as they did in relation to the First and Second Earlier Marks. However, any similarity between the marks remains at a low degree.

46. The same applies to the Third Earlier Mark, but the additional (and different) text in that mark acts as a further point of difference. Any similarity that exists between the marks is at a very low degree.

### Aural Comparison

47. The First, Second, Fourth and Fifth Earlier Marks are unlikely to be articulated as they are likely to be viewed as a device, rather than the letter M. By contrast, the IR is likely to be articulated as EM-MORE-NEW-TRISH-UNN-MORE-BYE-OTT-IKK. Consequently, there is no aural similarity between the marks.

48. I do not consider that the device in the Third Earlier Mark will be articulated. The only element that will be articulated are the words MONSTER ENERGY, in contrast with the IR, which will be articulated as set out above. Any similarity that arises from the common letter 'M' at the beginning of both marks, will be at a very low level.

### Conceptual Comparison

49. I consider it unlikely that the First, Second, Fourth and Fifth Earlier Marks will convey any conceptual message to the average consumer. By contrast, the words MORE NUTRITION MORE BIOTIC in the IR have a clear dictionary meaning, which will be understood by the average consumer. In my view, the marks are conceptually dissimilar.

50. As above, I do not consider that the device in Third Earlier Mark will convey any conceptual meaning to the average consumer. The words MONSTER ENERGY are dictionary words, which will be attributed their usual meaning. There is no overlap between the meaning of these words and the words MORE NUTRITION MORE BIOTIC in the IR. In my view, the marks are conceptually dissimilar.

### **The distinctive character of the earlier trade marks**

51. 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-2779, 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)."

52. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

53. The First, Second, Fourth and Fifth Earlier Marks consists of a device. If it is recognised as anything, it will be that of a claw mark. I consider it to be inherently distinctive to a medium (or average) degree. The Third Earlier Mark consists of the same device, and the words MONSTER ENERGY presented in a stylised font. In my view, that mark is inherently distinctive to between a medium and high degree.

54. I must now consider whether the distinctiveness of the First, Second, Third, Fourth and Fifth Earlier Marks has been enhanced through use. The relevant market for assessing enhanced distinctive character is the UK market. Mr Dechary gives evidence that it has sold energy drinks in the UK since 2008 with the following packaging (any changes to the packaging during this time have been minor):



55. The opponent's UK sales figures for energy drinks sold to its distributors in the UK vary from €79.9million in 2012 to €325million in 2021. In 2019 alone, 296.9million cans were sold in the UK. In 2023, the opponent had a 29.7% market share for energy drinks in the UK.<sup>3</sup> Clearly, the opponent's use in the UK has been intensive and long-standing. The opponent's use in the UK has clearly been widespread. Mr Dechary confirms that the opponent's energy drinks were sold in over 417,000 retail stores in the UK as of May 2022, including Tesco, Co-op, Lidl and Sainsbury's. In 2022 alone, the opponent spent more than \$123million on sales and marketing activities in the UK.

56. With this in mind, I have no doubt that the distinctive character of the First, Second, Third, Fourth and Fifth Earlier Marks has been enhanced through use to a high degree in relation to energy drinks. Whilst I note that there is some evidence of use in relation to other goods, I have limited information about the extent of that use in the UK and I do not consider it sufficient to establish any enhancement.

### **Likelihood of confusion**

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency

---

<sup>3</sup> Exhibit PJD-15

principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

58. I have found as follows:

- a. The goods and services are identical or similar to a low degree.
- b. The average consumer for the goods and services is either a member of the general public or a business user who will pay a medium or higher than medium degree of attention during the purchasing process.
- c. The purchasing process is predominantly visual, although I do not discount an aural component.
- d. The marks are visually similar to either a low or very low degree, and aurally and conceptually dissimilar.
- e. The First, Second, Third, Fourth and Fifth Earlier Marks are inherently distinctive to a medium or higher than medium degree, which has been enhanced through use to a high degree in relation to energy drinks.

59. Bearing in mind the visual, aural and conceptual differences between the marks, I do not consider it likely that they will be mistakenly recalled or misremembered as each other. Consequently, there is no likelihood of direct confusion.

60. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained 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’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

61. I bear in mind that these examples are not exhaustive. Even taking the identical goods in relation to which the opponent benefits from enhanced distinctiveness, the

distance between the marks is simply too great for a likelihood of indirect confusion to arise. The differences between them clearly point away from the marks originating from the same or economically linked undertakings. In my view, none of the examples of indirect confusion in *LA Sugar* apply, nor can I see any other basis for finding indirect confusion.

62. For the avoidance of doubt, even if I had found that the First, Second, Third, Fourth and Fifth Earlier Marks included stylised representations of the letter M, my finding would remain the same. I note that the opponent has provided examples of decisions of this Tribunal in which various single letter marks have been found to be similar.<sup>4</sup> However, even if the marks were all recognised as representing the letter 'M', in this case, I consider that because they are presented in such strikingly different ways, any visual similarity would be very low. Clearly, this is an important consideration given the primarily visual purchasing process. Any aural similarity, arising from the common articulation of the letter 'M' would be offset by the additional wording in the holder's mark (and the Third Earlier Mark, where applicable). The result of this is that there is no reason for the consumer to conclude that the marks originate from the same or connected undertakings and would certainly not mistake one for the other. This is particularly the case given that single letter marks are typically considered distinctively weak.<sup>5</sup>

63. The opposition based upon section 5(2)(b) of the Act is dismissed.

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

64. Section 5(3) 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

---

<sup>4</sup> See paragraph 38 of the opponent's written submissions in lieu.

<sup>5</sup> *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG*, Case C-265/09 P

in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

65. Section 5(3A) of the Act states:

“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.”

66. Under this ground of opposition, the opponent relies upon the Second, Third and Sixth Earlier Marks. I have already explained above that the Second and Third Earlier Marks qualify as earlier marks pursuant to section 6 of the Act; the same is true of the Sixth Earlier Mark. The Sixth Earlier Mark is subject to the use provisions in section 6A of the Act. Given the extent of the evidence of use provided (described above), it is very plain to me that the opponent has genuinely used its mark in the UK during the relevant period in relation to energy drinks. I am not convinced that its use is any broader than that (such that it could rely upon the broader term “non-alcoholic beverages” at large), but as nothing will turn on that in this case I need not deal with it any further.

67. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors*, *Case 252/07, Intel*, *Case C-408/01, Adidas-Salomon*, *Case C-487/07, L’Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora* and *Case C383/12P, Environmental Manufacturing LLP v OHIM*. 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 and Environmental Manufacturing, paragraph 34*.

(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*).

68. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the Second, Third and Sixth Earlier Marks and the IR are similar. Secondly, the opponent must show that the Second, Third and Sixth Earlier Marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the Second, Third and Sixth Earlier Marks being brought to mind by the IR. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

69. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

70. In determining whether the opponent has demonstrated a reputation for the goods and services relied upon, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with those goods and services. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it".

71. I bear in mind that as the Sixth Earlier Mark is a comparable mark, the opponent is entitled to rely upon evidence of use of that mark up to and including IP Completion Day for the purposes of establishing a reputation.<sup>6</sup>

72. Although the test for enhanced distinctiveness and reputation are different, the factors relevant to both are the same. In my view, the opponent plainly had a strong reputation in the UK in relation to energy drinks at the relevant date. As these are identical to some of the holder's goods, I will carry out my assessment on the basis of identical goods as that represents the opponent's best case.

---

<sup>6</sup> See paragraph 10, Part 1 of Schedule 2A of the Act.

## Link

73. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

### The degree of similarity between the conflicting marks

I have found the Second and Third Earlier Marks to be visually similar to the IR to a low degree or very low degree, and I have found them to be aurally and conceptually dissimilar.

The only difference between the Third Earlier Mark and the Sixth Earlier Mark is the use of colour. The different colours cannot put the opponent in any stronger position than it is in relation to the Third Earlier Mark, so I will apply the same findings to both.

### 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

I will proceed on the basis that the goods are identical. If there is no link in relation to identical goods, it follows that there will be no link in relation to those that are less similar.

### The strength of the earlier marks' reputation

The Second, Third and Sixth Earlier Marks have a strong reputation for energy drinks in the UK.

### The degree of the earlier marks' distinctive character, whether inherent or acquired through use

The distinctiveness of the Second, Third and Sixth Earlier Marks has been enhanced through use to a high degree in the UK in relation to energy drinks.

Whether there is a likelihood of confusion

I do not consider there to be a likelihood of direct or indirect confusion due to the visual, aural and conceptual differences between the marks.

74. Taking all of this into account, I consider that the distance between the marks is too great for a link to be made in the minds of the relevant public, even when the marks are used on identical goods. I make this finding notwithstanding the strength of the opponent's reputation. If a link was made it would be too weak for damage to occur or for the IR to take unfair advantage of the Second, Third and Sixth Earlier Marks.

75. The opposition based upon section 5(3) of the Act is dismissed.

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

76. Section 5(4)(a) of the Act states as follows:

“5(4) 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, where the condition in subsection (4A) is met,

aa)...

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.”

77. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

78. I can deal with this ground relatively swiftly. The signs relied upon are either identical to, or black and white versions, of the marks relied upon under section 5(2)(b). The result is that there will be no material difference between them for the purposes of my assessment of similarity. Although the opponent claims goodwill for “non-alcoholic beverages”, the evidence only supports a finding of goodwill in relation to energy drinks. I have no doubt in my mind that the opponent had a substantial goodwill for energy drinks at the relevant date. I acknowledge that at least some of the goods will be identical. However, in my view, the distance between the parties’ signs is sufficient to avoid misrepresentation or damage arising, notwithstanding the strength of the opponent’s goodwill and the identity of the fields of activity.

79. The opposition based upon section 5(4)(a) of the Act is dismissed.

## **CONCLUSION**

80. The opposition is unsuccessful and, subject to appeal, the IR may proceed to registration.

## **COSTS**

81. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the holder the sum of **£2,300**, calculated as follows:

|                                                  |      |
|--------------------------------------------------|------|
| Preparing a counterstatement and considering the | £550 |
| Notice of opposition                             |      |

|                                                            |               |
|------------------------------------------------------------|---------------|
| Considering the opponent's evidence and preparing evidence | £1,200        |
| Written submissions in lieu                                | £550          |
| <b>Total</b>                                               | <b>£2,300</b> |

82. I therefore order Monster Energy Company to pay Quality First GmbH the sum of **£2,300**. This sum is to 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 5<sup>th</sup> day of June 2025**

**S WILSON**

**For the Registrar**

## ANNEX 1

- Class 32 Syrups and other preparations for making beverages; energy drinks; energy drinks containing caffeine; non-alcoholic beverages flavoured with tea; non-alcoholic beverages flavoured with tea; water-based beverages containing tea extracts; fruit-based soft drinks flavored with tea; non-alcoholic beverages flavoured with coffee; non-alcoholic beverages flavoured with coffee; fruit squashes; syrups for making flavoured mineral waters; syrups for beverages; energy drinks containing green tea extract; green tea flavoured non-alcoholic drinks; non-alcoholic drinks containing green tea flavouring; water-based beverages containing green tea extracts; fruit-based non-alcoholic drinks containing green tea flavouring; powders used in the preparation of soft drinks; powders used in the preparation of fruit-based beverages; powders for the preparation of beverages; powders used in the preparation of coconut water drinks.
- Class 35 Business management; marketing; advertising; business administration; business administration; updating and maintenance of data in computer databases; updating of advertising material; cost price analysis; business inquiries; banner advertising; computerized file management; compilation of statistics; publication of publicity texts; layout services for advertising purposes; market analysis; marketing research and analysis; merchandising; advertising by mail order; market canvassing; customer loyalty services for commercial, promotional and/or advertising purposes; retail and wholesale services also provided via the internet in relation to the following goods: food, drinks and nutritional supplements; retail and wholesale services also provided via the internet in relation to the following goods: food, beverages and food supplements containing green tea extracts; retail and wholesale services also provided via the internet in relation to the following goods: pharmaceutical preparations containing green tea extracts and caffeine, tea, coffee, cocoa and energy beverages; retail and wholesale services also provided via the internet in relation to the following goods: green tea and coffee drinks; retailing

and wholesaling, including via the internet, relating to foodstuffs and beverages containing green tea flavouring; wholesale services in relation to dairy products; retail services in relation to dairy products; retail services in relation to frozen yogurts; wholesale services in relation to frozen yogurts.

## ANNEX 2

### **The First Earlier Mark**

Class 32     Drinking water; Energy drinks; Flavored waters; Fruit drinks; Soft drinks; Sparkling water; Sports drinks; Water beverages.

### **The Second Earlier Mark**

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.**

### **The Third Earlier Mark**

Class 32     **Non-alcoholic beverages, including carbonated drinks and energy drinks; syrups, concentrates, powders and preparations for making beverages, including carbonated drinks and energy drinks; beer.**

### **The Fourth Earlier Mark**

Class 9     Downloadable software namely virtual goods; downloadable software namely virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel; downloadable software namely virtual goods in the field of beverages, food, supplements, sports, gaming, music, and apparel for use in virtual environments and worlds; downloadable software namely virtual goods in the nature of beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; downloadable multimedia file containing artwork, text, audio, and video; downloadable multimedia file containing artwork, text, audio, and video relating to beverages, food, supplements, sports, gaming, music, and apparel authenticated by non-fungible tokens; non-fungible tokens; blockchain tokens; downloadable

computer software for managing, displaying, monetizing, buying, selling, trading, transferring, clearing, confirming, and authenticating virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; downloadable computer software for use as a digital token wallet; cryptocurrency hardware wallets; downloadable software for enabling users to electronically create, store, send, receive, accept, exchange, and transmit digital assets; downloadable computer programs for data storage; downloadable computer programs for blockchain data storage; downloadable computer software for facilitating transactions with others; downloadable computer software for facilitating blockchain-based financial transactions; downloadable computer programs for data authentication; downloadable computer programs for data authentication via blockchain; downloadable computer software featuring the purchase and sale of rights to digital goods; downloadable computer software for managing digital collectibles; downloadable digital files; software; downloadable digital file sharing software; downloadable computer software and downloadable mobile application software for viewing images, videos, and content relating to beverages, food, supplements, sports, gaming, music, and apparel; downloadable computer programs in relation to virtual goods namely beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items;.

Class 35      Retail store and online retail store services featuring virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; retail store and online retail store services featuring virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets in the field of beverages, food, supplements, sports, gaming, music, and apparel;

retail store and online retail store services featuring virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets as part of a computer program; retail store and online retail store services featuring virtual goods, namely, beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items; provision of an online marketplace for buyers and sellers of artwork, text, audio, and video relating to beverages, food, supplements, bags, beverageware, coolers, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, video game equipment and accessories, games, notebooks, coasters, posters, accessories, and other retail items authenticated by non-fungible tokens (NFTs); provision of an online marketplace for buyers and sellers of virtual goods, blockchain tokens, digital tokens, non-fungible tokens, digital media, digital files, and digital assets; advertising, marketing, and promotional services.

### **The Fifth Earlier Mark**

Class 35     On-line retail store services in relation to bags, luggage, beverageware, coolers, refrigeration equipment, beverage storage equipment, personal care products, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, location tracking devices, charging devices, video game equipment and accessories, games, furniture, notebooks, coasters, posters, and point-of-sale accessories; Retail store services in relation to bags, luggage, beverageware, coolers, refrigeration equipment, beverage storage

equipment, personal care products, clothing, headwear, footwear, gloves, tool kits, helmets, umbrellas, blankets, tents, towels, sporting equipment, musical instruments and accessories, sound and audio equipment and accessories, timepieces, jewelry, toys, toy cars, location tracking devices, charging devices, video game equipment and accessories, games, furniture, notebooks, coasters, posters, and point-of-sale accessories.

### **The Sixth Earlier Mark**

Class 32      **Non-alcoholic beverages.**