

OPPOSITION No B 3 125 519

Monster Energy Company, 1 Monster Way, 92879 Corona, California, United States of America (opponent), represented by **Bird & Bird LLP**, Avenue Louise 235, 1050 Bruxelles, Belgium (professional representative)

a g a i n s t

YG Entertainment Inc., 3, Huiujeong-ro 1-gil, Mapo-gu, 04028 Seoul, South Korea (holder), represented by **Marco Zardi**, Via della Bastiglia, 44, 22100 Como, Italy (professional representative).

On 23/08/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 125 519 is partially upheld, namely for the following contested goods and services:

Class 9: CDs; DVDs; blank USB flash drives; downloadable multimedia file; downloadable video files; downloadable music files; downloadable image files; electronic publications, downloadable; computer software applications, downloadable; musical video recordings; phonograph records; compact discs featuring music; pre-recorded DVDs featuring music; computer software.

Class 25: all the goods in this class.

Class 28: *Golf balls; golf bags.*

Class 41: *Entertainment services in the form of performances by singers; night club entertainment services; presentation of live performances; entertainment services; entertainer services; entertainment information; conducting of entertainment events; production of audio recordings; production of music; arranging and conducting of concerts.*

2. International registration No 1 518 394 is refused protection in respect of the European Union for all of the above goods and services. It may proceed for the remaining goods and services.
3. Each party bears its own costs.


REASONS

On 03/07/2020, the opponent filed an opposition against all the goods and services of international registration designating the European Union No 1 518 394 'BABYMONSTERS' (word mark). The opposition is currently based on the following earlier rights and grounds


(after the withdrawal of some of the originally invoked earlier rights in the opponent's observations of 09/09/2021 and 01/06/2022):

1. German trade mark registration No 302 010 067 454 'Monster' (word mark);
2. EUTM registration No 6 368 005 'MONSTER ENERGY' (word mark);
3. EUTM registration No 16 526 204 'MONSTER ENERGY' (word mark);
4. EUTM registration No 17 952 872 'MONSTER ENERGY' (word mark);
5. EUTM registration No 15 438 518 'MONSTER ARMY' (word mark);



6. French trade mark registration No 4 203 024  (figurative mark);




7. Croatian trade mark registration No Z20 160 467  (figurative mark);



8. EUTM registration No 17 896 507  (figurative mark);
9. EUTM registration No 2 784 486 'MONSTER' (word mark);
10. EUTM registration No 4 823 563 'MONSTER ENERGY' (word mark);



11. EUTM registration No 18 129 188  (figurative mark);



12. EUTM registration No 17 940 339  (figurative mark);



13. EUTM registration No 17 912 990  (figurative mark);

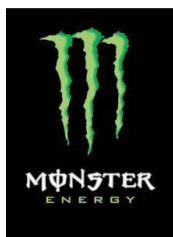
14. non-registered trade mark 'MONSTER' (word mark) used in the course of trade in Germany and Spain;

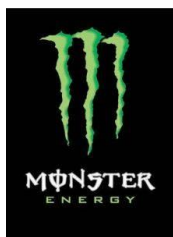
15. non-registered trade mark 'MONSTER ENERGY' (word mark) used in the course of trade in Germany and Spain;



16. non-registered trade mark  (figurative mark) used in the course of trade in Germany and Spain;

17. non-registered trade mark  (figurative mark) used in the course of trade in Germany and Spain;



18. non-registered trade mark  (figurative mark) used in the course of trade in Germany and Spain.

The opponent invoked Article 8(1)(b) EUTMR for earlier marks 1-8, Article 8(5) EUTMR for earlier marks 9-13, and Article 8(4) EUTMR for earlier marks 14-18.

PROOF OF USE

In accordance with Article 47(2) and (3) EUTMR, if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of filing or, where applicable, the date of priority of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years.

The same provision states that, in the absence of such proof, the opposition will be rejected.

For international registrations designating the European Union, the 'date of filing' or, where applicable, the 'date of priority' of the contested mark within the meaning of Article 47(2) EUTMR, that is to say for the purposes of establishing the five-year period of use obligation for the earlier mark, is considered to be the date of registration, the date of subsequent designation of the European Union or the date of priority of the contested international registration, as applicable. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years. In the present case, the priority date of the contested IR is 12/12/2019.

The holder requested that the opponent submit proof of use of earlier marks 1, 2 and 7.

As regards earlier marks 1 and 2, the request was submitted in due time and is admissible given that the earlier trade marks were registered more than five years prior to the relevant date mentioned above.

However, the request regarding earlier mark 7 is inadmissible because it concerns a mark that, at the date of priority of the contested IR, had not been registered for at least five years (as notified to both parties by the Office on 27/01/2022).

The relevant date for the contested international registration (priority date) is 12/12/2019. The opponent was therefore required to prove that the earlier marks 1 and 2 were put to genuine use in Germany and the European Union, respectively, from 12/12/2014 to 11/12/2019 inclusive.

Furthermore, the evidence must show use of the trade marks for the goods on which the opposition is based, namely the following:

Earlier mark 1

Class 28: Games, namely, board games, namely, mill, checkers, chess, backgammon, card games, throwing games, Puzzle games, dice games, board games (all the aforesaid goods including electronic components); toys, namely, cars, railways, highways, wood, metal and electrical kits, game balls, dice, toy bricks and figures, toy building block systems, gymnastic and sports equipment, skiing, tennis and fishing equipment, Christmas tree decorations.

Earlier mark 2

Class 25: Clothing, footwear, headgear; hats.

According to Article 10(3) EUTMDR, the evidence of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.

On 27/01/2022, in accordance with Article 10(2) EUTMDR, the Office gave the opponent until 01/04/2022 to submit evidence of use of the earlier trade marks. On 01/06/2022, within the time limit extended until 01/06/2022, the opponent submitted evidence of use.

The evidence to be taken into account is the following:

A witness statement by Mr. P.J.D., Executive Vice President and Deputy General Counsel of Monster Energy Company (the opponent), dated 25/05/2022. It states that, inter alia, the opponent's company is predominantly in the business of producing and selling energy drinks. The original 'Monster' energy drink was launched in the USA in 2002, and launched in the European Union in 2008. Since its creation, the energy drink has obtained great success in the USA and internationally, including in the EU and has very high sales numbers and a significant market share. With regard to Class 25 goods, the opponent has used its MONSTER ENERGY mark on clothing and headgear since 2002 and has also given approval and a license to a number of companies to sell clothing and headgear which bear the MONSTER ENERGY mark. As regards the goods in Class 28, it is stated that since 2004, the opponent has maintained an amateur athlete program called The Monster Army, in which over 2300 amateur athletes from Germany were involved. The opponent supports the athletes with branded gear, including sporting equipment bearing the MONSTER mark. MONSTER branded sporting equipment could be obtained from the opponent's website.

The witness statement is accompanied by the exhibits listed below. The opponent requested to keep certain commercial data contained in some of the exhibits confidential vis-à-vis third parties. The Opposition Division accepts this request insofar as it relates to part of the evidence concerning any financial and other sensitive commercial information contained in the documents. Therefore, it will describe that part of the evidence only in the most general terms without divulging any such data or specific information, which could breach the terms

of the confidentiality request made and accepted. However, this does not apply to evidence that is already in the public domain.

- Exhibit PJD-1: several printouts from the website www.freestylextreme.com in English, French and Italian, obtained through the internet archive *Wayback Machine*, dated between July 2014 and June 2017 and showing the offer of motorcycle-themed clothing, headgear and helmets for sale.
- Exhibit PJD-2: copies of pages from the opponent's 'POS' ('point-of-sale') catalogues dated 2014, 2015 and 2016 showing various POS apparel, for example hoodies, T-shirts or caps, bearing various opponent's marks.
- Exhibit PJD-3: an internal report (table) showing the distribution figures of MONSTER branded POS products, including the goods in Class 25 (such as T-shirts, jackets, hoodies) between October 2015 and November 2016. The report shows the distribution among various Monster Energy companies or distributors in various countries in and outside the EU.
- Exhibit PJD-4: several invoices showing the distribution of POS materials (for example T-shirts or hoodies) to the European Union, dated between April 2015 and February 2016. The invoices show the distribution among various Monster Energy companies.
- Exhibit PJD-5: a print-out from the opponent's German website concerning the promotional campaign 'Lobster snowboard giveaway', mentioning 'Win an exclusive Monster Energy Lobster snowboard!', dated 2017.
- Exhibit PJD-6: several photographs showing cans of Monster energy drink on promotional display in shops together with motorcycles, dated between February 2014 and January 2015.
- Exhibit PJD-7: several internal tables and lists which, according to the opponent, show distribution records for MONSTER sports equipment in Germany, dated 2013-2018 or undated; several documents titled 'Dealer Loaders', either undated or dated in 2019, depicting various products bearing one or more of the opponent's marks, such as toy cars, headphones, a helmet, skate boards, snowboards, bags or clothing.
- Exhibit PJD-8: an internal spreadsheet showing the sales of MONSTER-branded sports and gaming goods in Germany. The data refer to the years 2016-2021 and mostly concern the delivery of the goods to various Monster Energy companies.
- Exhibit PJD-9: invoices, release forms and purchase orders showing the distribution of various Monster products (such as skate decks, gloves, sunglasses, helmets, mouses or headphones) in Germany, dated 2016-2021. The documents mostly show the distribution of the products among various Monster Energy companies.
- Exhibit PJD-10: print-outs from www.hjc-germany.com and www.hjchelmets.de, obtained through the internet archive *Wayback Machine*, showing helmets bearing various MONSTER marks, dated 2016-2020.

Previously, on 09/09/2021, the opponent submitted another set of evidence with a view to prove enhanced distinctiveness, reputation and use in the course of trade of the earlier marks invoked in these proceedings. As this evidence was submitted before the relevant

date for submitting proof of use, it must also be taken into account when assessing genuine use of earlier marks 1 and 2.

The evidence of 09/09/2021 to be taken into account is the following:

A witness statement by Mr. P.J.D., Senior Vice President and Deputy General Counsel of Monster Beverage Corporation and its subsidiaries, including 'Monster Energy Company' (the opponent), dated 01/09/2021. It states that, inter alia, the opponent's company is in the business of producing and selling energy drinks. The original 'Monster' energy drink was launched in the USA in 2002, and launched in the European Union in 2008. Since its creation, the energy drink has obtained great success in the USA and internationally, including in the EU, and has very high sales numbers and a significant market share. The opponent has also obtained numerous awards. Various decisions of the EUIPO and the Spanish and German Patent and Trade Mark Offices have confirmed the reputation of the opponent's marks. The energy drink is not promoted in a traditional way, but essentially through sponsorship of, for example, sports events, athletes and music festivals. The opponent's energy drink also has an extensive presence on the internet and social media. 'MONSTER' marks are used on various merchandising items, including apparel and backpacks. The opponent's marks are also promoted in video games and at e-sport events.

The witness statement is accompanied by the exhibits listed below. The opponent requested to keep certain commercial data contained in some of the exhibits confidential vis-à-vis third parties. The Opposition Division accepts this request insofar as it relates to part of the evidence concerning any financial and other sensitive commercial information contained in the documents. Therefore, it will describe that part of the evidence only in the most general terms without divulging any such data or specific information, which could breach the terms of the confidentiality request made and accepted. However, this does not apply to evidence that is already in the public domain.

- Exhibit PJD-1: a report of all registered and pending 'Monster' marks in the European Union.
- Exhibits PJD-2-PJD-6: internal documents, investor presentations and market research company reports, which show very high sales numbers and that the opponent's 'Monster' energy drink has a significant market share in various EU Member States and the EU as a whole, dated 2011-2021.
- Exhibits PJD-7-PJD-11: a selection of web clippings, articles and reports concerning the reputation and market share of 'Monster' energy drink in several EU Member States and worldwide, dated 2008-2020.
- Exhibits PJD-12 and PJD-13: documents concerning a number of awards obtained by the opponent between 1999-2018.
- Exhibit PJD-14: a document concerning *Beverage World*, a beverage industry magazine that gave one of the awards.
- Exhibits PJD-15 and PJD-16: copies of EUIPO, German and Spanish Patent and Trade Mark Office decisions, accompanied by English translations, in which the opponent's trade marks were found to have a reputation for *energy drinks*.
- Exhibit PJD-17: photographs of sponsored athletes bearing 'MONSTER' marks.

- Exhibits PJD-18-PJD-19: evidence concerning point of sale items used in retail stores to sell 'Monster' energy drinks.
- Exhibits PJD-20-PJD-27: documents concerning promotion on the opponent's website and on social media between 2003-2020.
- Exhibits PJD-28-PJD-71: documents regarding various advertising and marketing activities promoting 'Monster' energy drinks in the EU, such as through sports event, athlete and music festival sponsorship (e.g. car and motorcycle races or extreme sports competitions) and elsewhere, between 2008-2020.
- Exhibits PJD-72-PJD-75: documents concerning 'Monster Girls', a group of women sponsored by the opponent, who appear at events to entertain the public.
- Exhibit PJD-76: photographs from promotional events, where various merchandising products promoting 'Monster' energy drinks were distributed.
- Exhibits PJD-77-PJD-80: documents concerning the promotion of the opponent's 'Monster' energy drinks through video games and video game competition sponsorship.

The opponent has submitted, *inter alia*, evidence relating to the United Kingdom (UK) with a view to demonstrating use of earlier mark 2 in the European Union. That evidence relates to a period prior to 01/01/2021.

On 01/02/2020, the UK withdrew from the EU subject to a transition period until 31/12/2020. During this transition period EU law remained applicable in the UK. Therefore, use in the UK prior to the end of the transition period constituted use 'in the EU'. Consequently, the evidence relating to the UK and to a period prior to 01/01/2021 is relevant with a view to maintaining rights in the EU and will be taken into account (see Communication No 2/20 of the Executive Director of the Office of 10 September 2020 on the impact of the United Kingdom's withdrawal from the European Union on certain aspects of the practice of the Office, Section V 'Earlier rights in *inter partes* proceedings').

Having examined all the evidence listed above, it is considered that there is a substantial deficiency as regards the nature of use of the marks.

In the context of Article 10(3) EUTMDR, the expression 'nature of use' includes evidence of use of the sign in accordance with its function, of use of the mark as registered, or of a variation thereof according to Article 18(1), second subparagraph, point (a) EUTMR, and of its use for the goods and services for which it is registered.

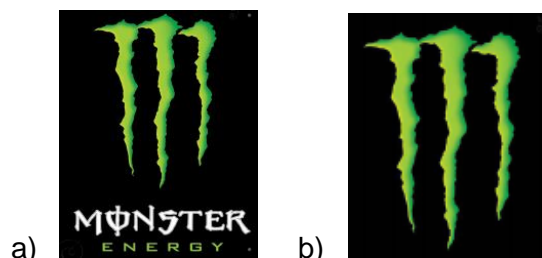
According to Article 18(1), second subparagraph, point (a), EUTMR, the following will also constitute use within the meaning of paragraph 1: use of the European Union trade mark in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor. When examining the use of an earlier registration for the purposes of Article 47(2) and (3) EUTMR, Article 18 may be applied by analogy to assess whether or not the use of the sign constitutes genuine use of the earlier mark as far as its nature is concerned.

In the present case, the marks as registered are the following:

Earlier mark 1: 'Monster' (word mark)

Earlier mark 2: 'MONSTER ENERGY' (word mark)

The marks appearing in the evidence are mostly the following:



It is evident that the figurative mark as used under b) does not prove use of the word marks 'Monster' and 'MONSTER ENERGY' at all.

As to the mark as used under a), it is a complex mark dominated by the large and distinctive claw-like element. The distinctive element 'MONSTER' is particularly stylised in a Gothic-like font and the elements 'MONSTER' and 'ENERGY' are depicted in different fonts, one underneath the other, in different colours and in different sizes. Consequently, the mark as used under a) contains numerous modifications or additions which, taken as a whole, do alter the distinctive character of the word marks 'Monster' and 'MONSTER ENERGY' as registered.

On some occasions, the evidence also shows use of several other variants of the marks a) and b) for which the above reasoning applies mutatis by analogy.

In view of the above, the Opposition Division considers that the evidence does not show use of the earlier marks 1 and 2 as registered within the meaning of Article 18(1), second subparagraph, point (a), EUTMR.

In addition, the evidence shows on occasions also other forms of use of the marks. However, these forms of use appear only sporadically in the evidence and therefore, clearly do not prove sufficient extent of use of such marks.

The Opposition Division therefore concludes that the evidence furnished by the opponent is insufficient to prove that earlier marks 1 and 2 were genuinely used in the relevant territory and during the relevant period of time. Consequently, the opposition based on earlier marks 1 and 2 must be rejected and these earlier marks will not be examined in the further assessment of the opposition.

EVIDENCE OF ENHANCED DISTINCTIVENESS, REPUTATION AND USE IN THE COURSE OF TRADE

On 09/09/2021, the opponent submitted a vast body of evidence to prove enhanced distinctiveness in relation to the earlier trade marks 3-8 (Article 8(1)(b) EUTMR), reputation claimed in relation to the earlier trade marks 9-13 (Article 8(5) EUTMR), and use in the course of trade of the earlier non-registered trade marks 14-18 (Article 8(4) EUTMR).

Under Article 8(1)(b) EUTMR, the opponent claimed that the earlier trade marks enjoy enhanced distinctiveness in the European Union in connection with the relevant goods. This

claim must be properly considered given that the distinctiveness of the earlier trade marks must be taken into account in the assessment of likelihood of confusion. Indeed, the more distinctive the earlier marks, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

This means that the ground of refusal of Article 8(5) EUTMR is only applicable when the opponent proves reputation of the earlier trade marks. The reputation must be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.

According to Article 8(4) EUTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for will not be registered where and to the extent that, pursuant to the Union legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the European Union trade mark, or the date of the priority claimed for the application for registration of the European Union trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Consequently, for the ground of refusal of Article 8(4) EUTMR to be applicable, the opponent must prove that the earlier non-registered trade marks were used in the course of trade of more than local significance prior to the filing of the contested trade mark.

Based on the opponent's claims in the notice of opposition and in the observations in support of the opposition, the opponent had to prove enhanced distinctiveness of the earlier marks 3-8 in the European Union (or the relevant Member State where the mark is registered) for the following goods and services:

Earlier mark 3

Class 41: Entertainment services, namely, providing online and non-downloadable video games and providing temporary use of non-downloadable computer games, electronic games, and interactive games; arranging contests featuring online gaming; providing a web-based system and on-line portal for customers to participate in online gaming operation, and coordination of game tournaments, leagues, and tours for recreational computer game playing purposes; entertainment services, namely, providing a website for online gaming; providing a website featuring information about online gaming and online gaming professionals; entertainment in the nature of live online gaming.

Earlier mark 4

Class 41: *Entertainment services in the nature of sporting events, performances and competitions, electronic sporting events and competitions, and music performances and events.*

Earlier mark 5

Class 25: *Clothing, namely, tops, shirts, t-shirts, hooded shirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely, hats and beanies; footwear.*

Class 41: *Providing a web site featuring information on athletes; organizing and conducting educational programs and activities for athletes; athlete development program.*

Earlier mark 6

Class 9: *Protective clothing; protective footwear; helmets; goggles, sports helmets; covers and cases for protection of electronic devices; earphones or headphones; glasses; glasses cases; sunglasses ; sunglasses cases; video recordings on sports, extreme sports and motor sports; Mobile phone cords; eyeglass cords; keeping cords for identity cards; keeping cords for certificates of credentials; keeping cords for keys as encoded cards; keeping cords for keys; keeping cords for sound recording devices; cords for portable media players.*

Class 25: *Clothing, footwear and headgear.*

Earlier mark 7

Class 25: *Clothing, footwear, headgear.*

Earlier mark 8

Class 9: *Sport helmets; video recordings featuring sports, extreme sports and motor sports.*

Based on the opponent's claims in the notice of opposition and in the observations in support of the opposition, the opponent had to prove reputation in the European Union in respect of the following goods:

Earlier mark 9

Class 32: *Fruit juice drinks, soft drinks, carbonated soft drinks, aerated water, soda water and seltzer water enhanced with vitamins, minerals nutrients, amino acids and/or herbs.*

Earlier mark 10

Class 32: *Drinks, including soft drinks, fruit juices and fruit drinks, carbonated soft drinks, aerated water, soda water and seltzer water; drinks with vitamins, minerals, nutrients, amino acids and/or herbs.*

Earlier mark 11

Class 32: *Non-alcoholic beverages, including carbonated drinks and energy drinks.*

Earlier mark 12

Class 32: *Non-alcoholic beverages, including carbonated drinks and energy drinks.*

Earlier mark 13

Class 32: *Non-alcoholic beverages, including carbonated drinks and energy drinks.*

Based on the opponent's claims in the notice of opposition and in the observations in support of the opposition, the opponent had to prove use in the course of trade in Germany and Spain of the following goods:

Earlier non-registered trade marks 14-18

Drinks.

The opponent had to prove enhanced distinctiveness / reputation / use in the course of trade of the earlier trade marks, respectively, before the priority date of the contested IR, namely before 12/12/2019.

The evidence submitted by the opponent in this respect on 09/09/2021 has already been listed above.

Evidence relating to the United Kingdom

A part of the above evidence relates to the United Kingdom (UK). However, it follows from Article 8(1)(b) and Article 8(5) EUTMR, worded in the present tense, that the conditions for applying it must also be fulfilled at the time of taking the decision. As the UK is no longer a member of the EU, the evidence relating to its territory cannot be taken into account to prove enhanced distinctiveness or reputation 'in the EU'.

However, there is still a large part of the evidence that concerns the European Union, excluding the UK.

Article 8(1)(b) EUTMR – enhanced distinctiveness

The evidence shows use only in relation to *energy drinks* in Class 32, not for the relevant goods and services in Classes 9, 25 and 41 protected by earlier trade marks 3-8, for which Article 8(1)(b) EUTMR is claimed. It proves a number of advertising and marketing activities carried out by the opponent to promote its own energy drink. However, the opponent did not prove any effective trade mark use or any degree of widespread public knowledge of earlier trade marks 3-8 for the relevant goods and services in Classes 9, 25 and 41. Although the evidence demonstrates that the opponent's various marks appeared e.g. on clothing articles, these were, rather, used to promote the opponent's energy drink and, therefore, enhance the recognition of the energy drink itself and not the clothing. Furthermore, the opponent did not submit any clear evidence of sales of the clothing articles. Consequently, the opponent failed to prove enhanced distinctiveness of earlier trade marks 3-8 for the relevant goods and services in Classes 9, 25 and 41.

Article 8(5) EUTMR – reputation

The opponent claimed reputation for the following earlier trade marks:

- Earlier mark 9 'MONSTER' (word mark);
- Earlier mark 10 'MONSTER ENERGY' (word mark);



- Earlier mark 11  (figurative mark);




- Earlier mark 12  (figurative mark);

- Earlier mark 13  (figurative mark).

Having examined the evidence listed above, the Opposition Division concludes that the



opponent proved reputation for earlier trade mark 11  (figurative mark) for *energy drinks* in Class 32 (under the registered goods *non-alcoholic beverages, including carbonated drinks and energy drinks* in this class). It is clear from the evidence that this earlier trade mark (in various colour variants) has been subject to long-standing and intensive use and is generally known in the relevant market, where it enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources. The sales figures, marketing expenditure and market share in the evidence, and the various references in the press to its success, all unequivocally show that the mark enjoys a solid degree of recognition among the relevant public.

Although the evidence mostly shows use of the mark in the green-black-white variant



, the black and white variant  as registered under earlier mark 11 fully reproduces all the elements of the mark as used, save for the colours. Consequently, the

Opposition Division considers that the public knows and recognizes the black and white sign




MΦNSTER
ENERGY as well.

However, no reputation was proved for earlier marks 9, 10, 12 and 13. Although the signs

'MONSTER', 'MONSTER ENERGY',  and 




(or their colour variants) have been used as an element in the composite mark  (or its colour variants), they are still outweighed to a large extent by the claw-like device



. Moreover, the evidence shows that the opponent's marketing and promotional



activities have been quite often undertaken using only the claw-like device  in

isolation, without the presence of the element  or . Moreover, the marks 'MONSTER' and 'MONSTER ENERGY' were not used as simple word marks, but rather in a particularly stylised way.

In principle, reputation proven for a complex sign refers to that sign as such and not a particular element alone. To establish the reputation of a trade mark on the basis of evidence relating to the use and well-known nature of a different trade mark, the former must be included in the latter and play a significant or even predominant role therein (21/05/2005, T-55/13, F1H20 / F1 et al., EU:T:2015:309, § 47). When the earlier mark has been used as part of another mark, it is incumbent on the opponent to prove that the earlier mark has independently acquired a reputation (12/02/2015, T-505/12, B, EU:T:2015:95, § 121).

Consequently, the Opposition Division considers that the opponent failed to prove reputation for earlier marks 9, 10, 12 and 13. There is insufficient evidence to prove that these earlier trade marks alone acquired a reputation independently.

Since the opponent did not demonstrate that earlier trade marks 9, 10, 12 and 13 had acquired reputation, and given that reputation is *sine qua non* for the application of Article 8(5) EUTMR, the opposition based on this ground and these earlier trade marks must be rejected.

Article 8(4) EUTMR – use in the course of trade

Under Article 8(4) EUTMR, the opponent claimed that the following non-registered trade marks have been used in the course of trade in Germany and Spain in relation to *drinks*:



- Earlier non-registered trade mark 14 'MONSTER' (word mark);
- Earlier non-registered trade mark 15 'MONSTER ENERGY' (word mark);
- Earlier non-registered trade mark 16  (figurative mark);

- Earlier non-registered trade mark 17  (figurative mark);


- Earlier non-registered trade mark 18  (figurative mark).



Having examined the evidence listed above, the Opposition Division concludes that it does not demonstrate that the earlier non-registered word marks 'MONSTER' and 'MONSTER ENERGY' (earlier marks 14 and 15) have been used in the course of trade in Germany and Spain.

The evidence shows that the marks 'MONSTER' and 'MONSTER ENERGY' themselves are never used in isolation on the marketplace, but always in combination with the claw-like

device , in colour and with the word 'ENERGY' depicted underneath the word 'MONSTER', which is never depicted in a standard font, but always in the specific stylistic font , with a bisected letter 'O'.

This use cannot be considered a slight variation of the earlier marks as invoked by analogy, Article 15(1)(a) EUTMR (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50), since the differing elements between the marks as used and as invoked are not negligible. It is obvious from the evidence submitted that the energy drinks themselves always essentially

bear the composite sign  (in various colour variants), while the marketing and


promotional activities have been mostly undertaken using the claw-like device  in isolation (mostly in green), or in combination with the words  and

'ENERGY', or other verbal elements. The claw-like device is always displayed in a prominent position and is the sign's dominant element.


That the words 'MONSTER' and 'MONSTER ENERGY' appear not to have been used either in isolation or in a standard font, but always in the particular highly-stylised font displayed above, demonstrates the importance of these figurative elements in the marketing, promotion and sale of 'MONSTER ENERGY' drinks. Therefore, the evidence submitted cannot prove that earlier non-registered trade marks 14 and 15 have been used in the course of trade (30/05/2016, R 478/2015-2, MONSTERS UNIVERSITY / MONSTER ENERGY (fig.) et al., § 114-137; 03/09/2018, R 480/2018-5, nickelodeon BLAZE AND THE MONSTER MACHINES (fig.) / Monster et al., § 43-64 and 78).

Furthermore, by analogy with the above findings on reputation, the following conclusions apply as regards the use in the course of trade of earlier non-registered marks 16, 17 and 18:



- Use of the non-registered trade marks  (earlier mark 16) and **MONSTER** (earlier mark 17) in the course of trade in Germany and Spain has not been proven. There is insufficient evidence to prove that these earlier trade marks alone were used independently in the course of trade in Germany and Spain.



- However, use of the non-registered trade mark  (earlier trade mark 18) in the course of trade in Germany and Spain has been proven. There is enough evidence on file proving a sufficient degree of use of this earlier trade mark in the course of trade in Germany and Spain, but only for *energy drinks* (under the broad category of *drinks* invoked by the opponent).

Since no use in the course of trade was proven for earlier non-registered trade marks 14, 15, 16 and 17, and given that use in the course of trade is *sine qua non* for the application of Article 8(4) EUTMR, the opposition based on this ground and on these earlier marks must be rejected.

Conclusion

It follows from the above findings that the opponent:

- did not prove any enhanced distinctiveness of earlier trade marks 3-8 (Article 8(1)(b) EUTMR);
- proved reputation only for earlier trade mark 11 for only *energy drinks* in Class 32 (Article 8(5) EUTMR);
- proved use in the course of trade in Germany and Spain only for earlier trade mark 18 (Article 8(4) EUTMR), and only for *energy drinks*.

The assessment of the opposition will now continue on the ground under Article 8(1)(b) EUTMR (likelihood of confusion) and on the basis of earlier trade marks 3-8.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods and services

The goods and services on which the opposition is based are the following:

Earlier mark 3

Class 41: Entertainment services, namely, providing online and non-downloadable video games and providing temporary use of non-downloadable computer games, electronic games, and interactive games; arranging contests featuring online gaming; providing a web-based system and on-line portal for customers to participate in online gaming operation, and coordination of game tournaments, leagues, and tours for recreational computer game playing purposes; entertainment services, namely, providing a website for online gaming; providing a website featuring information about online gaming and online gaming professionals; entertainment in the nature of live online gaming.

Earlier mark 4

Class 41: Entertainment services in the nature of sporting events, performances and competitions, electronic sporting events and competitions, and music performances and events.

Earlier mark 5

Class 25: Clothing, namely, tops, shirts, t-shirts, hooded shirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely, hats and beanies; footwear.

Class 41: Providing a web site featuring information on athletes; organizing and conducting educational programs and activities for athletes; athlete development program.

Earlier mark 6

Class 9: Protective clothing; protective footwear; helmets; goggles, sports helmets; covers and cases for protection of electronic devices; earphones or headphones; glasses; glasses cases; sunglasses ; sunglasses cases; video recordings on sports, extreme sports and motor sports; Mobile phone cords; eyeglass cords; keeping cords for identity cards; keeping cords for certificates of credentials; keeping cords for keys as encoded cards; keeping cords for keys; keeping cords for sound recording devices; cords for portable media players.

Class 25: Clothing, footwear and headgear.

Earlier mark 7

Class 25: *Clothing, footwear, headgear.*

Earlier mark 8

Class 9: *Sport helmets; video recordings featuring sports, extreme sports and motor sports.*

The contested goods and services are the following:

Class 9: *CDs; DVDs; USB cables; blank USB flash drives; downloadable multimedia file; downloadable video files; downloadable music files; downloadable image files; electronic publications, downloadable; computer software applications, downloadable; musical video recordings; sunglasses; protective cases for smart phones; phonograph records; compact discs featuring music; pre-recorded DVDs featuring music; ear phones; decorative magnets; rechargeable batteries; computer software.*

Class 25: *Outer clothing; ready-made clothing; underwear; mufflers [neck scarves]; caps being headwear; waterproof clothing; shirts; sweaters; scarves; skirts; sports wear; footwear; socks; clothing; belts [clothing]; gloves [clothing]; tee-shirts; pants; pullovers; bottoms [clothing].*

Class 28: *Toy sticks with LED light features for use in concerts [novelty items]; golf balls; golf bags; toy animals; stuffed toys; stuffed dolls; toys for pets; dolls; dolls' clothes; accessories for dolls; toys; masks [playthings]; teddy bears; toy sticks with glow-in-the-dark features; jigsaw puzzles; plush dolls; play balloons; plastic character toys; toy figures; novelty toys, namely, sticks with luminous features for fans and for entertainment [novelty items].*

Class 41: *Entertainment services in the form of performances by singers; night club entertainment services; dance instruction; presentation of live performances; modelling for artists; fan club services in the nature of entertainment; entertainment services; entertainer services; entertainment information; conducting of entertainment events; providing audio or video studio services; rental of sound recordings and video recordings; production of audio recordings; production of music; publication of printed matter; providing online videos, not downloadable; providing online music, not downloadable; songwriting; arranging and conducting of concerts; theme park services.*

An interpretation of the wording of the list of goods and services is required to determine the scope of protection of these goods and services.

The term 'namely', used in both lists of goods and services to show the relationship of individual goods and services to a broader category, is exclusive and restricts the scope of protection only to the goods and services specifically listed.

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition or complementary.

For reasons of procedural economy, the Opposition Division will not undertake a full comparison of the contested goods and services with the goods and services covered by the

earlier figurative marks 6, 7 and 8. The examination of the opposition will proceed as if all the contested goods and services were identical to the goods of earlier marks 6, 7 and 8 which, for the opponent, is the best light in which the opposition can be examined.

The Opposition Division will now compare the contested goods and services with the goods and services protected by the earlier word marks 3, 4 and 5.

Contested goods in Class 9

In general terms, teaching materials in Class 9 (e.g. *downloadable electronic publications, audio and video files, pre-recorded data carriers and audio/video cassettes*) are essential and thus complementary to *educational services* in Class 41. Generally, the materials are provided by the same undertaking, and share the same public and distribution channels. These goods are similar to the services in question (23/10/2002, T-388/00, ELS, EU:T:2002:260; 22/04/2008, T-233/06, El tiempo, EU:T:2008:121, § 36-37). For these reasons, the contested *CDs; DVDs; blank USB flash drives; downloadable multimedia file; downloadable video files; downloadable music files; downloadable image files; electronic publications, downloadable; musical video recordings; phonograph records; compact discs featuring music; pre-recorded DVDs featuring music* (which may all be considered to be teaching materials) are considered similar to the opponent's *organizing and conducting educational programs and activities for athletes* covered by earlier mark 5 in Class 41.

The contested *computer software applications, downloadable; computer software*, insofar as they cover games software, are considered similar to a low degree to the opponent's *entertainment services, namely, providing online and non-downloadable video games and providing temporary use of non-downloadable computer games, electronic games, and interactive games* protected by earlier mark 3. The contested goods are indispensable or, at the very least, important for the provision of the opponent's services since, in order to be able to offer such services, the relevant games software is required. Due to this close complementary relationship, it is likely that a significant part of the relevant public may believe that the goods and services concerned are produced/provided under the responsibility of the same undertakings. The goods and services also coincide in the relevant public.

The remaining contested goods in this class, namely *USB cables; sunglasses; protective cases for smart phones; ear phones; decorative magnets; rechargeable batteries*, have nothing relevant in common with the opponent's goods and services covered by the earlier word marks 3, 4 and 5 which are, in essence, clothing, footwear and headgear in Class 25 and entertainment services in the gaming, sports and music fields. The goods and services under comparison have a different nature, purpose and method of use. They are neither in competition nor complementary. Moreover, the usual commercial origin of the goods, their distribution channels and sales outlets are normally different. Consequently, they are considered dissimilar.

Contested goods in Class 25

Footwear is identically contained in the contested list of goods and in the earlier mark 5's list of goods.

The contested *outerclothing; ready-made clothing; underwear; mufflers [neck scarves]; waterproof clothing; shirts; sweaters; scarves; skirts; sports wear; socks; clothing; belts [clothing]; gloves [clothing]; tee-shirts; pants; pullovers; bottoms [clothing]* are at least similar to the opponent's *clothing, namely, tops, shirts, t-shirts, hooded shirts, sweat shirts, jackets,*

pants, bandanas, sweat bands and gloves covered by earlier mark 5. These goods coincide, at least, in their purpose, usual producer, relevant public and distribution channels.

For the same reasons, the contested *caps being headwear* are considered at least similar to the opponent's *headgear, namely, hats and beanies* covered by earlier mark 5.

Contested goods in Class 28

The contested *golf balls; golf bags* are sporting articles. The opponent's *entertainment services in the nature of sporting events, performances and competitions* in Class 41 covered by earlier mark 4 consist, in fact, in organizing sporting activities (including golf events and competitions). The General Court has held that the organization of sporting activities involves the use of 'games'—and, by extension, 'gymnastic and sporting articles'—hence, a degree of low similarity exists between them (16/09/2013, T-250/10, Knut – der Eisbär, EU:T:2013:448, § 68-76). Consequently, the goods and services under comparison are considered similar to a low degree as they have the same purpose, usually coincide in the relevant public and they are also complementary.

The remaining contested goods, namely *toy sticks with LED light features for use in concerts [novelty items]; toy animals; stuffed toys; stuffed dolls; toys for pets; dolls; dolls' clothes; accessories for dolls; toys; masks [playthings]; teddy bears; toy sticks with glow-in-the-dark features; jigsaw puzzles; plush dolls; play balloons; plastic character toys; toy figures; novelty toys, namely, sticks with luminous features for fans and for entertainment [novelty items]*, are dissimilar to all the goods and services covered by the earlier word marks 3, 4 and 5 in Classes 25 and 41, since they have nothing relevant in common that could justify finding a level of similarity between them. They have a different nature, purpose and method of use. They are neither in competition nor clearly complementary. Moreover, the usual commercial origin of the goods/services, their distribution channels and sales outlets are mostly different.

Contested goods in Class 41

The contested *entertainment services in the form of performances by singers; night club entertainment services; presentation of live performances; entertainer services; conducting of entertainment events; arranging and conducting of concerts* overlap with the opponent's *entertainment services in the nature of [...] music performances and events* covered by earlier mark 4 in Class 41. Therefore, they are identical.

The contested *entertainment services* include, as a broader category, the opponent's *entertainment services in the nature of [...] music performances and events* covered by earlier mark 4 in Class 41. Since the Opposition Division cannot dissect *ex officio* the broad category of the contested services, they are considered identical to the opponent's services.

The contested *entertainment information; production of audio recordings; production of music* are similar to the opponent's *entertainment services in the nature of [...] music performances and events* covered by earlier mark 4 in Class 41 as they usually coincide in provider, relevant public and distribution channels. They can also be complementary.

The remaining contested services, namely *dance instruction; modelling for artists; fan club services in the nature of entertainment; providing audio or video studio services; rental of sound recordings and video recordings; publication of printed matter; providing online videos, not downloadable; providing online music, not downloadable; songwriting; theme park services*, are dissimilar to all the goods and services covered by the earlier word marks 3, 4 and 5 in Classes 25 and 41, since they have nothing relevant in common that could

justify finding a level of similarity between them. They have a different nature, purpose and method of use. They are neither in competition nor clearly complementary. Moreover, the usual commercial origin of the goods/services, their distribution channels and sales outlets are mostly different.

b) Relevant public — degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods and services found to be identical or similar (to varying degrees) target the public at large. The degree of attention of the relevant public will be average.

c) The signs

Earlier marks 3 and 4

MONSTER ENERGY

Earlier mark 5

MONSTER ARMY

Earlier marks 6 and 7



Earlier mark 8



BABYMONSTERS

Earlier trade mark

Contested sign

The relevant territories are the European Union (earlier marks 3, 4, 5 and 8), France (earlier mark 6) and Croatia (earlier mark 7).

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The verbal element 'MONSTER', contained in all the earlier trade marks, will be perceived by the majority of the relevant public as meaning 'a large imaginary creature that looks very ugly and frightening' (information extracted from *Collins Dictionary* on 16/08/2023 at <https://www.collinsdictionary.com/dictionary/english/monster>), either because it exists in their own languages (e.g. English or German) or because it is similar to the equivalent word in other relevant languages, such as *monsteri* in Finnish, *monstre* in French, *monstrs* in Latvian, *monstras* in Lithuanian, *monstru* in Maltese and Romanian, *monstrum* in Polish and Czech, and *monštrum* in Slovak. However, for a part of the public in the European Union, namely Bulgarian-speaking consumers, the element 'MONSTER' has no meaning (10/02/2017, R 1062/2016-2, MONSTER DIP (fig.) / MONSTER ENERGY (fig.) et al., § 71; 30/05/2016, R 478/2015-2, MONSTERS UNIVERSITY / MONSTER ENERGY (fig.) et al., § 57). In any case, as this element has no particular meaning in relation to the relevant goods and services, it has an average degree of distinctiveness for all consumers in the European Union.

The Gothic-like script of the figurative element 'MONSTER' in earlier marks 6, 7 and 8 is quite peculiar and is, therefore, distinctive.

The verbal element 'ENERGY', contained in earlier trade marks 3, 4, 6, 7 and 8, is an English word, meaning, inter alia, 'the ability and strength to do active physical things and the feeling that you are full of physical power and life' or 'the power from sources such as electricity and coal that makes machines work or provides heat' (information extracted from *Collins Dictionary* on 16/08/2023 at <https://www.collinsdictionary.com/dictionary/english/energy>). This word has similar equivalents in other EU languages, such as *energie* in Czech, *énergie* in French and *Energie* in German. Therefore, the meaning of the word 'ENERGY' will be perceived, either directly or as an allusive word, throughout the European Union. As this element has no clear meaning in relation to the relevant goods and services, it has an average degree of distinctiveness for all consumers in the European Union.

The verbal element 'ARMY' contained in earlier mark 5 is an English word meaning, inter alia, 'a large, organized group of people who are armed and trained to fight on land in war. Most armies are organized and controlled by governments' (information extracted from *Collins Dictionary* on 16/08/2023 at <https://www.collinsdictionary.com/dictionary/english/army>). It has (more or less) similar equivalents in some other relevant languages, such as in French (*armée*). However, in yet other relevant EU languages, the element has no readily perceptible meaning. In any case, as this element has no particular meaning in relation to the relevant goods and services, it has an average degree of distinctiveness for all consumers in the European Union.

The claw-like device in earlier marks 6, 7 and 8 will be perceived by a part of the public as a purely figurative element depicting a claw-like scratch. However, another part of the public may perceive it as a highly stylised letter 'M'. In either case, this element has no particular meaning in relation to the relevant goods and services and is, therefore, distinctive.

The rectangular black background in earlier mark 8 is a commonplace label-like shape depicted in a basic colour. Consequently, it is non-distinctive.

The claw-like device in earlier marks 6, 7 and 8 is the dominant element, as it is the most eye-catching. Nevertheless, the stylised verbal element 'MONSTER' of these earlier trade marks is still perceptible and legible.

As to the contested sign, its beginning 'BABY' is an English word meaning 'a very young child, especially one that cannot yet walk or talk' (information extracted from *Collins Dictionary* on 16/08/2023 at <https://www.collinsdictionary.com/dictionary/english/baby>). As it is a basic English word, it will be understood throughout the European Union. Consequently, due to its meaning, the public will perceive 'BABY' as a separate element and the contested sign will be mentally broken down into the elements 'BABY' and 'MONSTERS'. With regard to most of the contested goods in Class 25 (which can potentially be used by or on babies), the element 'BABY' will be non-distinctive because it designates the targeted end users (e.g. clothing for babies/young children). However, the element has no clear and readily perceptible relation to the remaining contested goods and services, for which it is, therefore, distinctive to an average degree.

Concerning the element 'MONSTERS' in the contested sign (which is the plural of 'monster' in English), the above considerations regarding the element 'MONSTER' apply here as well. Therefore, for the majority of the relevant public it will be a meaningful or allusive word, whereas for the Bulgarian-speaking part of the public, the element has no meaning. In any case, as this element has no particular meaning in relation to the relevant goods and services, it has an average degree of distinctiveness for all consumers in the European Union.

Visually, the signs coincide in the sequence of letters 'MONSTER', which is a separate distinctive element in all of the earlier marks and forms almost the whole distinctive element 'MONSTERS' in the contested sign (save for the additional letter '-S' at the end). The marks differ in all their other elements, described in detail above, namely 'ENERGY', 'ARMY', the claw-like scratch and the stylisation of script in the case of the earlier marks, respectively, and 'BABY-' in the case of the contested sign.

Therefore, the contested sign is considered visually similar to an average degree to the earlier word marks 3, 4 and 5 and visually similar to a very low degree to the earlier figurative marks 6, 7 and 8 (where the dominant claw-like scratch has a very significant impact).

Aurally, the pronunciation of the signs coincides in the sound of the letters 'MONSTER', present identically in all the signs, although in a different position. The pronunciation differs in the additional sound of '-S' at the end of the contested sign and in the sound of the earlier marks' additional letters 'ENERGY' or 'ARMY', and the contested sign's letters 'BABY'. If the claw-like device in earlier marks 6, 7 and 8 is perceived as a single letter 'M', it is not likely to be pronounced separately. If it is perceived only as a figurative element and not as a stylised letter, it will not be pronounced.

Therefore, the signs are aurally similar to an average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. Even if the signs convey some concepts that are not present in the other signs, none of them will alter the concept conveyed by the coinciding distinctive element 'MONSTER(S)' (for the majority of the public). Therefore, as the signs will be associated with the same concept conveyed by the distinctive element 'MONSTER(S)', they are conceptually similar to an average degree for most of the public in the EU. Only in

Bulgaria does the coinciding element 'MONSTER' have no meaning; the marks are, therefore, not conceptually similar in this territory.

For all the above reasons, the marks cannot be considered visually, aurally and conceptually dissimilar, as the holder claims.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

d) Distinctiveness of the earlier marks

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier trade marks enjoy enhanced distinctiveness. However, as found earlier in this decision, enhanced distinctiveness has not been proven.

Consequently, the assessment of the distinctiveness of the earlier marks will rest on their distinctiveness per se. In the present case, the earlier trade marks as a whole have no meaning for any of the goods and services in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier marks must be seen as normal.

e) Global assessment, other arguments and conclusion

Compared to the earlier word marks 3, 4 and 5, the contested sign was found visually and aurally similar to an average degree. Conceptually, the marks are either similar to an average degree or not conceptually similar.

The goods and services are partially identical or similar (to varying degrees) and partially dissimilar. The level of attention of the relevant public, composed of the public at large, will be average. The earlier trade marks' degree of distinctiveness is normal.

Overall, it is considered that the contested sign is sufficiently similar to the earlier word marks 3, 4 and 5 to cause likelihood of confusion in respect of the goods and services found to be identical or similar to varying degrees. The degree of similarity of the marks is considered to be significant enough to cause confusion also for the goods and services found to be similar only to a low degree.

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings. Indeed, it is highly conceivable that the relevant consumer will perceive the contested mark as a sub-brand or a variation of the earlier marks based on the same core element 'MONSTER(S)', configured in a different way according to the type of goods or services that it designates (23/10/2002, T-104/01, Miss Fifties (fig.) / Fifties, EU:T:2002:262, § 49).

In its observations, the holder argues that there are many European Union trade marks which include the element 'MONSTER'. In support of its argument the holder refers to a number of EUTM registrations.

The Opposition Division notes that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of register data only, it cannot be assumed that all such trade marks have been effectively used. It follows that the evidence filed does not demonstrate that consumers have been exposed to widespread use of, and have become accustomed to, trade marks that include 'MONSTER'. Under these circumstances, the holder's claims must be set aside.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public and therefore the opposition is partly well founded on the basis of the opponent's earlier marks 3, 4 and 5.

It follows from the above that the contested trade mark must be rejected for the goods and services found to be identical or similar (to varying degrees) to those of these earlier trade marks.

The rest of the contested goods and services are dissimilar to the goods and services of earlier marks 3, 4 and 5. As the identity or similarity of goods and services is a necessary condition for the application of Article 8(1)(b) EUTMR, the opposition based on this Article, these earlier marks and directed at these goods and services cannot be successful.

As regards the opposition based on the earlier figurative marks 6, 7 and 8, the contested goods and services have been assumed to be identical to the goods and services protected by these earlier marks. Compared to the earlier figurative marks 6, 7 and 8, the contested sign was found visually similar only to a very low degree and aurally similar to an average degree. Conceptually, the marks are either similar to an average degree or not conceptually similar. It is considered that the overall impressions created by the contested sign and the earlier figurative marks 6, 7 and 8 are not sufficiently similar to cause confusion for the remaining contested goods and services. These remaining contested goods and services in Classes 9, 28 and 41 are not normally ordered orally by consumers, which means that the aural similarity between the marks should not be given decisive importance.

Considering all the above, even assuming that the goods and services are identical, there is no likelihood of confusion between the contested mark and the earlier figurative marks 6, 7 and 8. Therefore, the opposition based on the earlier figurative marks 6, 7 and 8 and directed against the remaining contested goods must be rejected.

As regards the remaining contested goods and services in Classes 9, 28 and 41, the opposition will now be examined on the ground of Article 8(5) EUTMR.

REPUTATION — ARTICLE 8(5) EUTMR

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

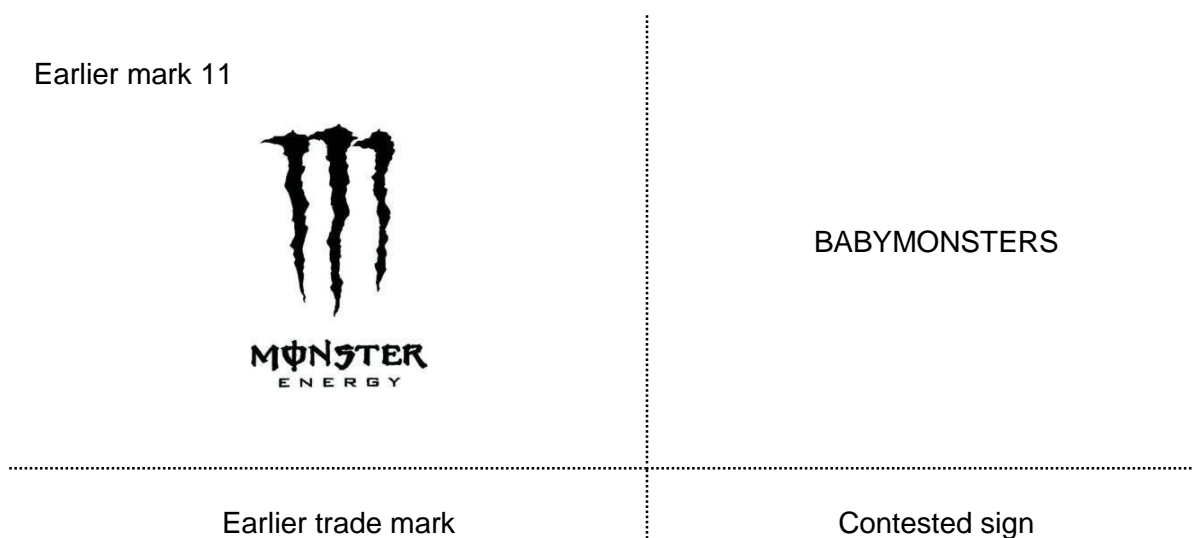
- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41

a) Reputation of the earlier trade marks

The opponent claimed reputation for earlier marks 9-13. However, as found earlier in this decision, reputation was proved only for earlier trade mark 11 and only for *energy drinks* in Class 32. The opposition based on earlier marks 9, 10, 12 and 13 and on the ground of Article 8(5) EUTMR has been rejected due to lack of reputation of the earlier marks.

b) The signs



Earlier mark 11 protects the same sign as that protected by earlier marks 6 and 7 which have already been compared with the contested sign above under the ground of Article 8(1)(b) EUTMR. Reference is made to those findings, which are equally valid for Article 8(5) EUTMR by analogy. It was found that the marks were visually similar only to a very low degree and aurally similar to an average degree. Conceptually, the marks are either similar to an average degree or not conceptually similar.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are similar to some extent. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

The degree of similarity of the marks is not very high because the marks have no more than an average degree of aural and conceptual similarity and, at the same time, only a very low degree of visual similarity, in particular on account of the dominant and distinctive claw-like scratch contained in the earlier mark.

The earlier mark enjoys a solid degree of reputation, but only for *energy drinks* in Class 32.

The opposition is directed against the following remaining goods and services:

Class 9: USB cables; sunglasses; protective cases for smart phones; ear phones; decorative magnets; rechargeable batteries.

Class 28: Toy sticks with LED light features for use in concerts [novelty items]; toy animals; stuffed toys; stuffed dolls; toys for pets; dolls; dolls' clothes; accessories for dolls; toys; masks [playthings]; teddy bears; toy sticks with glow-in-the-dark features; jigsaw puzzles; plush dolls; play balloons; plastic character toys; toy figures; novelty toys, namely, sticks with luminous features for fans and for entertainment [novelty items].

Class 41: Dance instruction; modelling for artists; fan club services in the nature of entertainment; providing audio or video studio services; rental of sound recordings and video recordings; production of audio recordings; production of music; publication of printed

matter; providing online videos, not downloadable; providing online music, not downloadable; songwriting; theme park services.

It is evident that the relevant goods are clearly dissimilar. The earlier mark is reputed for *energy drinks*, which are non-alcoholic beverages with a stimulating effect. On the other hand, the remaining contested goods and services encompass goods falling in the field of consumer electronics and their accessories, sunglasses and decorative magnets (Class 9), toys and novelty items (Class 28) and various entertainment and publication services (Class 41). By their nature, these goods and services are very far apart. There is nothing that would link the contested goods and services with the opponent's reputed goods in the consumer's mind. The goods are so different that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute, that is to say, establish a 'link' between them. Therefore, the opposition based on earlier mark 11 is not well founded under Article 8(5) EUTMR and must be rejected.

NON-REGISTERED MARK OR ANOTHER SIGN USED IN THE COURSE OF TRADE — ARTICLE 8(4) EUTMR

According to Article 8(4) EUTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for will not be registered where and to the extent that, pursuant to the Union legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the European Union trade mark, or the date of the priority claimed for the application for registration of the European Union trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Therefore, the grounds of refusal of Article 8(4) EUTMR are subject to the following requirements:

- the earlier sign must have been used in the course of trade of more than local significance prior to the filing of the contested trade mark;
- pursuant to the law governing it, prior to the filing of the contested trade mark, the opponent acquired rights to the sign on which the opposition is based, including the right to prohibit the use of a subsequent trade mark;
- the conditions under which the use of a subsequent trade mark may be prohibited are fulfilled in respect of the contested trade mark.

These conditions are cumulative. Therefore, where a sign does not satisfy one of those conditions, the opposition based on a non-registered trade mark or other signs used in the course of trade within the meaning of Article 8(4) EUTMR cannot succeed.

a) Use in the course of trade

The opposition under the ground of Article 8(4) EUTMR is based on earlier marks 14-18. However, as found earlier in this decision, use in the course of trade (in Germany and Spain) was proved only for earlier trade mark 18 and only for *energy drinks*. The opposition based on earlier non-registered marks 14, 15, 16 and 17 and on the ground of Article 8(4) EUTMR has been rejected due to the lack of use in the course of trade.

b) Earlier non-registered trade mark 18 in Germany

According to the law governing the signs in question, as substantiated by the opponent, an earlier non-registered trade mark used in trade is protected against a later trade mark on the condition that it acquired recognition as a trade mark within the relevant trade circles (Section 4(2) of the German Trade Mark Act) and there is either (i) a 'double identity' (identity of the marks and of the goods/services); (ii) a likelihood of confusion (based on the identity or similarity of the marks and of the goods/services); or (iii) the use of the sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark which has a reputation (provided there is identity or similarity between the marks) (Section 14 of the German Trade Mark Act).

Irrespective of whether the earlier non-registered trade mark 18 actually acquired recognition under German law and practice within the affected trade circles, or whether it is reputed, the opposition under Article 8(4) EUTMR must fail. The remaining contested goods and services in Classes 9, 28 and 41 (as listed above) are clearly dissimilar to the opponent's *energy drinks* as they have nothing relevant in common that could justify finding a level of similarity between them. Therefore, there cannot be any 'double identity' or likelihood of confusion. Furthermore, it follows by analogy from the reasoning above that the contested mark cannot possibly take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier non-registered trade mark 18 because the public will not establish the necessary mental link between the marks.

Therefore, the opposition is not well founded under Article 8(4) EUTMR on the basis of earlier non-registered trade mark 18 in Germany.

c) Earlier non-registered trade mark 18 in Spain

According to Article 95(1) EUTMR, the Office will examine the facts of its own motion in proceedings before it; however, in proceedings relating to relative grounds for refusal of registration, the Office will restrict this examination to the facts, evidence and arguments submitted by the parties and the relief sought.

According to Article 7(2)(d) EUTMDR, if the opposition is based on an earlier right within the meaning of Article 8(4) EUTMR, the opposing party must provide, inter alia, evidence of its acquisition, continued existence and scope of protection, including where the earlier right is invoked pursuant to the law of a Member State, a clear identification of the content of the national law relied upon by adducing publications of the relevant provisions or jurisprudence.

Therefore, the onus is on the opponent to submit all the information necessary for the decision, including identifying the applicable law and providing all the necessary information for its sound application. According to case-law, it is up to the opponent '... to provide [EUIPO] not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application ... but also particulars establishing the content of that law' (05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452, § 50).

The information on the applicable law must allow the Office to understand and apply the content of that law, the conditions for obtaining protection and the scope of this protection, and allow the applicant to exercise the right of defence.

As regards the provisions of the applicable law, the opponent must provide a clear identification of the content of the national law relied upon by adducing publications of the relevant provisions or jurisprudence (Article 7(2)(d) EUTMDR). The opponent must provide the *reference* to the relevant legal provision (Article number and the number and title of the law) and the *content* (text) of the legal provision by adducing publications of the relevant provisions or jurisprudence (e.g. excerpts from an official journal, a legal commentary, legal encyclopaedias or court decisions). If the relevant provision refers to a further provision of law, this must also be provided to enable the applicant and the Office to understand the full meaning of the provision invoked and to determine the possible relevance of this further provision. Where the evidence concerning the content of the relevant national law is accessible online from a source recognised by the Office, the opponent may provide such evidence by making a reference to that source (Article 7(3) EUTMDR).

According to Article 7(4) EUTMDR, any provisions of the applicable national law governing the acquisition of rights and their scope of protection as referred to in Article 7(2)(d) EUTMDR, including evidence accessible online as referred to in Article 7(3) EUTMDR must be in the language of the proceedings or accompanied by a translation into that language. The translation must be submitted by the opposing party of its own motion within the time limit specified for submitting the original document.

As regards Spain, the opponent did not sufficiently substantiate the content (text) of the Spanish law protecting the earlier non-registered trade mark.

The opponent submitted documents including several articles of law in Spanish from an unknown origin, without any title of the law and in the form of an edited text. The English translation of the Spanish text forms part of the same edited document. The opponent also submitted a document in Spanish, which, according to the opponent, is the Guidelines of the Spanish Patent and Trade Mark Office, with a partial translation into English. The opponent failed to provide an original publication of the law from an official source. The Guidelines of the Spanish national office provide only a commentary on the relevant provisions of Spanish trade mark law, but not the official text of the law itself.

It follows from the above that the evidence submitted by the opponent is not sufficient to prove the content of the law.

Therefore, the opposition is not well founded under Article 8(4) EUTMR on the basis of earlier mark 18 in Spain.

In any case, even if the opponent sufficiently substantiated the applicable Spanish law, the opposition under Article 8(4) EUTMR would also fail. This is because, according to the information provided by the opponent, earlier non-registered trade marks are protected against later trade marks in Spain on the condition that they are well known and that double identity (identity of the marks and of the goods/services) or a likelihood of confusion (based on the identity or similarity of the marks and of the goods/services) exists.

Similarly to the reasons explained above in relation Germany, the remaining contested goods and services in Classes 9, 28 and 41 (as listed above) are clearly dissimilar to the opponent's *energy drinks* as they have nothing relevant in common that could justify finding a level of similarity between them. Therefore, there cannot be any 'double identity' or likelihood of confusion and the earlier non-registered trade mark cannot succeed in any case

against the contested mark. Therefore, the opposition is not well founded under Article 8(4) EUTMR on the basis of earlier mark 18 in Spain also for this reason.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. According to Article 109(3) EUTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division will decide a different apportionment of costs.

Since the opposition is successful for only some of the contested goods and services, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Opposition Division

Gracia TORDESILLAS
MARTÍNEZ

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Sarah DE FAZIO
MADDOCKS

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.