

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2013887
of 30 August 2019

Opponent: **Monster Energy Company**
1 Monster Way
Corona California 92879
United States of America

Representative: **Brinkhof N.V.**
De Lairesestraat 111-115
1075 HH Amsterdam
Netherlands

Invoked right 1: **International registration 1048069**



Invoked right 2: **European trademark registration 12236436**

MONSTER REHAB

Invoked right 3: **European trademark registration 15438518**

MONSTER ARMY

against

Defendant: **Salamander Deutschland GmbH & Co. KG**
Wasserstraße 29
42283 Wuppertal
Germany

Representative: **Landmark B.V.**
Drentsestraat 4
3812 EH Amersfoort
Netherlands

Contested trademark: Benelux application 1364761

minimonster

I. FACTS AND PROCEEDINGS


A. Facts

1. On 17 November 2017 the defendant filed an application for a trademark in the Benelux for the wordmark minimonster for goods in classes 18 and 25. This application was processed under number 1364761 and was published on 29 November 2017.

2. On 29 January 2018 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- International registration 1048069, with designation of the European Union, of the combined



word/figurative mark , filed on 28 June 2010 and registered on 11 August 2011 for goods in classes 9, 16, 18 and 25.

- European registration 12236436 of the wordmark MONSTER REHAB, filed on 18 October 2013 and registered on 28 February 2014 for goods in class 25.
- European registration 15438518 of the wordmark MONSTER ARMY, filed on 16 May 2016 and registered on 20 September 2016 for goods and services in classes 25 and 41.

3. According to the registers the opponent is the actual holder of the trademarks invoked.

4. The opposition was originally directed against all goods of the contested application and based on all goods and services of the trademark invoked. In the course of the opposition proceedings, the defendant has limited the list of goods of the contested sign and as a consequence, the contested sign is now only applied to "*Shoes for children and youths*", mentioned in class 25. In response, the opponent has limited the scope of the opposition, meaning that the opposition is now only based on class 25 of the trademarks invoked.

5. The grounds for opposition are those laid down in article 2.14, 2 (a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").¹

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 31 January 2018. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed with regard to the first trademark invoked, International registration 1048069. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). In addition, the proceedings were suspended at the request of the parties. The administrative phase was completed on 6 February 2019.

¹ This decision shall always refer to the laws and regulations applicable on the date of the decision, except in the case of provisions which have undergone a material change during the proceedings and which are relevant to the decision.

II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 2 (a) BCIP, in accordance with the provisions of article 2.2ter, 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of trademark and sign and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent first limits the scope of the opposition, meaning that the opposition is now only based on the goods mentioned in class 25 of the trademarks invoked (see paragraph 4).

10. The opponent explains that Monster Energy is an American based leading marketer and distributor of energy drinks and alternative beverages. According to the opponent, the trademarks invoked are extensively used and as a result, the distinctive character of the marks is enhanced.

11. With regard to the comparison of the signs, the opponent argues that it is likely that the public will split up the contested sign MINIMONSTER into two words, MINI and MONSTER. According to the opponent, the word 'mini' is descriptive, because it refers to children and youth and accordingly to the small size of the shoe. Therefore, the word MONSTER is the dominant element of the contested sign. The opponent also states that the word MONSTER is the dominant element of the trademarks invoked, because of its prominent position.

12. The opponent argues that the signs are visually and aurally similar to the extent that they coincide in the identical word MONSTER. Furthermore, the opponent states that if the figurative element of the first trademark invoked is perceived as the letter M, this also causes a visual and aural similarity, because in that case the first element of both trademark and sign starts with the letter M. Conceptually, according to the opponent, the signs are similar because of the identical meanings of the word MONSTER.

13. The opponent states that the goods of the contested sign are identical and highly similar to the goods for which the trademarks invoked are registered.

14. Subsequently, the opponent concludes that there exists a likelihood of confusion and requests that the Office grants the opposition and refuses the contested sign.

15. At the request of the defendant, the opponent filed proof of use for the first trademark invoked.

B. Defendant's arguments

16. The defendant points out that the opponent has not submitted any evidence to substantiate his argument that the trademarks invoked are extensively used and therefore have an enhanced distinctiveness. Moreover, the word MONSTER as part of a trademark is quite common, because, according to the defendant, there are 95 Benelux registrations and applications concerning the word MONSTER for goods in class 25. For this reason, the defendant argues that the word MONSTER is not distinctive.

17. With regard to the comparison of the signs, the defendant disputes that the public will perceive the figurative element of the first trademark invoked as the letter M. According to the defendant, it is more likely that this element is perceived as the bloody imprint of a claw.

18. The defendant states that the word element MONSTER has several meanings. It is either a noun, meaning a hideous, ugly and frightening animal or human or it is an adjective, meaning 'very large'. With regard to the first trademark invoked, the defendant therefore argues that the words 'monster energy' could mean 'a very large amount of energy' or 'energy of a monster'. With regard to the second trademark invoked, MONSTER REHAB, the defendant states that this could refer to a rehabilitation clinic for monsters or a very large rehabilitation. However, the defendant also argues that it is doubtful whether the average Benelux public is familiar with the meaning of the abbreviation 'rehab'. The third trademark invoked, MONSTER ARMY, could mean a very large army or an army of monsters.

19. With regard to the contested sign, the defendant states that the combination of the words mini and monster in relation to the goods (children's footwear) will be understood by the public as a reference to children, who are sometimes also called 'little monsters'. The defendant disputes that the word 'mini' refers to the size of the shoes, because it relates to the second word 'monster'. Therefore, the signs are conceptually different.

20. Although the trademarks invoked as well as the contested sign share the word MONSTER, this word is positioned differently. With regard to the trademarks invoked, it is the first word in combination with another separate word. Furthermore, the defendant argues that the word MONSTER is an adjective and for this reason the second part (ENERGY, REHAB or ARMY) will receive at least the same attention from the public as the word MONSTER. In the contested sign, the word MONSTER is the second word/part of the combination minimonster. Furthermore, according to the defendant, the word MINI is not descriptive and because it is the first part of the sign, it usually receives more attention than the second part. For this reason, the defendant argues that the signs are visually and aurally only similar to a very low degree.

21. With respect to the proof of use, the defendant states that the documents submitted by the opponent are insufficient to prove use for the goods concerned in the relevant territory, the European Union. Furthermore, the defendant states that the opponent has also submitted evidence to substantiate the alleged reputation of the first trademark invoked. The defendant points out that this is not allowed and that these documents should therefore not be taken into consideration.

22. The defendant also argues that even if the trademarks invoked have a strong reputation, this only concerns the field of non-alcoholic beverages and not the goods concerned in these opposition proceedings.

23. According to the defendant, the goods of the trademarks invoked are not similar to the goods of the contested sign. Furthermore, the contested sign is intended for children's footwear. The defendant argues that parents and children only buy shoes after careful deliberation which leads to a considered purchase. For this reason, the level of attention is higher than average.

24. In the light of the above, the defendant concludes that the differences outweigh the similarities between the signs and that there exists no likelihood of confusion. Therefore, the defendant requests that the Office rejects the opposition.

III. DECISION

A.1 Likelihood of confusion

25. In accordance with article 2.14 BCIP, the holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the

application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.2ter BCIP.

26. Article 2.2ter, para. 1 BCIP stipulates that, *"A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*

27. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

28. The wording of Article 5, 1 (b) of the Directive (cf. article 2.2ter, 1 (b) BCIP) according to which "there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark" shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Sabel, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

29. Global assessment 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 (CJEU, Sabel and Lloyd, already cited).

30. For reasons of procedural economy, the Office will first compare the contested sign with the third trademark invoked (*EU trademark 15438518*), which is not subject to an obligation of use. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
MONSTER ARMY	Minimonster

Conceptual comparison

31. The contested sign, seen as a whole, has no meaning. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited), the fact remains that, when perceiving a verbal sign, he or she will break it down into elements which, for him or her, suggest a concrete meaning or which resemble words known to him (EGC,

Respicur, T-256/04, 13 February 2007, ECLI:EU:T:2007:46; Aturion, T-146/06, 13 February 2008, ECLI:EU:T:2008:33; Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and Ecoblue, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). For this reason the contested sign, although it is composed of one word, will be split by the relevant public into 'mini' and 'monster', because both of these verbal components will be recognised as either English or Dutch words.

32. The word MONSTER, which is present in both signs, inter alia means 'a large, ugly, and frightening imaginary creature' or, in combination with another noun, 'a thing of extraordinary or daunting size'. It could also indicate, in a humorous way, 'a rude or badly behaved person, typically a child'.² The word ARMY is an English word that means 'an organized military force equipped for fighting on land'.³ The combination MONSTER ARMY could therefore be perceived as 'an army which consists of monsters' or 'a very large army'.

33. The adjective or prefix 'mini' is used to denote a miniature version of something.⁴ For this reason, the Office finds that the public will understand that in the contested sign, the word mini refers to the size of the second component, namely 'monster'. Therefore, in the contested sign, the public will perceive the word 'monster' as creature or person. Although the Office considers that (contrary to what the opponent claims, see paragraph 11) the word mini in the contested sign will not be perceived in a descriptive way, due to the combination with the word 'monster', it will also not be perceived as the dominant element because it is the first part of the sign (as the defendant claims, see paragraph 20), because due to its grammatical construction, the word mini functions as an adjective to the noun monster. Therefore, the public will also pay attention to the second word monster.

34. Conceptually, and bearing in mind the abovementioned concepts with which the signs will be associated, there is at least a certain degree of conceptual similarity between the marks, insofar as both the marks could be associated with the concept of a 'MONSTER'. In this context, the Office points out that risk of confusion with part of the public is sufficient to justify the opposition (see EGC, Hai/Shark, already cited).

Visual comparison

35. Both signs are purely verbal marks. The trademark invoked is composed of two words of seven and four letters, 'MONSTER ARMY' and the contested sign consists of one word of eleven letters, 'minimonster'.

36. The fact that the trademark invoked is represented in capital letters, whereas the contested sign is represented in lower-case letters, is irrelevant for the purposes of a visual comparison of these marks (see BOIP, opposition decision HY-BOND RESIGLASS, 2000572, 8 April 2008 and EGC, babilu, T-66/11, 31 January 2013, ECLI:EU:T:2013:48).

37. Both signs contain the identical word MONSTER. However, while in the trademark invoked the word 'MONSTER' is a separate element, in the case of the contested sign 'monster' is fully integrated in the second part of the word 'minimonster'. The signs differ because of the addition of the word ARMY in the trademark invoked and the first part MINI in the contested sign. Although the consumer normally attaches more importance to the first part of words (MUNDICOR, already cited), that consideration cannot apply in every case (EGC, ALLTREK, T-158/05, 16 May 2007, ECLI:EU:T:2007:143). The first part of the

² <https://en.oxforddictionaries.com/definition/monster> and Van Dale Groot Woordenboek van de Nederlandse Taal, 14e editie.

³ <https://en.oxforddictionaries.com/definition/army>

⁴ <https://en.oxforddictionaries.com/definition/mini>

trademark invoked is completely included in the ending of the contested sign and even if it is not a dominant element, it still has an independent distinctive role (EGC, Life Blog, T-460/07, 20 January 2010, ECLI:EU:T:2010:18). Moreover, as also considered above, the visual impression could be influenced by the grammatical construction, in which the element mini functions as an adjective.

38. In the light of the above, the Office finds that the signs are at least visually similar to a certain extent.

Aural comparison

39. The trademark invoked consists of four syllables: "mon-ster-ar-my". The contested sign also consists of four syllables "mi-ni-mon-ster". Aurally, the pronunciation of the signs coincides in the sound of the identical word 'MONSTER'. The pronunciation differs in the sound of the letters which have no counterparts in the trademark of the other party, namely "army" and "mini".

40. As also considered with regard to the visual comparison, even though the beginnings of the signs are different, this does not change the fact that the pronunciation coincides in the sound of the word MONSTER, and to that extent the signs are aurally similar.

Conclusion

41. Trademark and sign are conceptually, visually and aurally similar to a certain extent.

Comparison of the goods and services

42. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

43. With the comparison of the goods and services of the trademark invoked and the goods against which the opposition is filed, the goods and services are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

44. The defendant has limited his list of goods (paragraph 4). In response, the opponent has indicated that the opposition is only based on the goods mentioned in class 25 of the trademark invoked (paragraph 9). Therefore, the goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 25 Clothing, namely, tops, shirts, t-shirts, hooded shirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely, hats and beanies; footwear.	CI 25 Shoes for children and youths.

45. The goods "Shoes for children and youths" of the contested sign are a type of footwear. Accordingly, they are included in the broader category of "footwear" of the trademark invoked and are therefore identical (see EGC, Fifties, T-104/01, 23 October 2002, ECLI:EU:T:2002:262; Arthur et Félicie,

T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and Prazol, T-95/07, 21 October 2008, ECLI:EU:T:2008:455).

Conclusion

46. The goods are identical.

A.2 Global assessment

47. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the signs are important factors.

48. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also 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. The present case concerns goods which are targeted at the public in general. Although the level of attention of part of the public could be higher than normal, because children's shoes are concerned and parents are often more observant when purchasing shoes for their children, the other part however will simply consider such purchases to be normal in the completion of a child's wardrobe and will have a normal level of attention. Therefore the lowest level of attention must be taken into account, which means that for these goods, the public is deemed to have a normal level of attention.

49. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken into account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited). In the case concerned, the goods are identical and the signs are similar to a certain extent.

50. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). In the present case, the third trademark invoked has a normal distinctiveness, as it is not descriptive of the goods and services concerned. Opponent also claims that the distinctive character of the trademarks invoked is enhanced. However, it is not necessary to discuss this argument, because it has no influence on the outcome of these proceedings.

51. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.

52. Based on the above-mentioned circumstances, given the interdependence between the identity of the goods and the certain degree of similarity of the signs, the Office is of the opinion that the relevant public might believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

B. Other factors

53. Regarding the defendant's argument concerning the fact that many other trademark registrations contain the word MONSTER (see paragraph 16), the Office admits that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between the two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings, the defendant has duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC, Top IX, T-57/06, 7 November 2007, ECLI:EU:T:2007:333 and Life Blog, already cited). In this case, however, no evidence of such a kind has been provided by the defendant.

54. The proof of use submitted by the opponent also contains documentation which refers to the reputation of the trademarks invoked (as the defendant also mentioned, see paragraph 21). However, according to Rule 1.14, 1 (c) IR, this documentation must be submitted together with the arguments. For this reason, the Office must disregard this material insofar it concerns the assessment of the reputation of the trademarks invoked. Furthermore, even if it were established that the trademarks invoked have a reputation, this would not affect the final decision in this case.

C. Conclusion

55. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

56. Since the opposition is already justified based on one of the trademarks invoked, it is not necessary that the Office conducts a comparison with the other trademarks invoked, nor a substantive assessment of the proof of use with regard to the first trademark invoked.

IV. DECISION

57. The opposition with number 2013887 is justified.

58. Benelux application with number 1364761 will not be registered.

59. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 30 August 2019

Eline Schiebroek
(*rapporteur*)

Pieter Veeze

Willy Neys



Administrative officer: François Veneri

