

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2010155
of 31 December 2015

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

Representative: **Bird & Bird LLP**
Zuid-Hollandplein 22
2596 AW Den Haag
Netherlands

Invoked right 1: **European registration 8445711**

X-PRESSO MONSTER

Invoked right 2: **European registration 8815722**

HAMMER M X-PRESSO MONSTER ESPRESSO + ENERGY

Invoked right 3: **European registration 8815748**

MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY

against

Defendant: **Unilever N.V.**
Weena 455
3013 AL Rotterdam
Netherlands

Representative: **Baker & McKenzie Amsterdam N.V.**
Claude Debussylaan 54
1082 MD Amsterdam
Netherlands

Contested trademark: Benelux application 1290759



I. FACTS AND PROCEEDINGS**A. Facts**

1. On 5 June 2014 the defendant filed an application for a trademark in the Benelux for the combined



word/figurative mark, for goods in class 30. This application was processed under number 1290759 and was published on 17 June 2014.

2. On 15 August 2014 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- European registration 8445711 of the word mark X-PRESSO MONSTER, filed on 23 July 2009 and registered on 28 January 2010 for goods in classes 5 and 32.
- European registration 8815722 of the word mark HAMMER M X-PRESSO MONSTER ESPRESSO + ENERGY, filed on 18 January 2010 and registered on 5 July 2010 for goods in classes 5 and 32.
- European registration 8815748 of the word mark MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY, filed on 18 January 2010 and registered on 5 July 2010 for goods in classes 5 and 32.

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

4. The opposition is directed against all goods relating to the contested application and is based on all goods in class 32 of the trademarks invoked.

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

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified to the parties on 25 August 2014.

8. The adversarial phase of the procedure started on 26 October 2014. The Benelux Office for Intellectual Property (hereinafter: "the Office") sent the notification of the commencement of the proceedings on 21 November 2014 to the parties, giving the opponent the opportunity to substantiate the opposition by submitting arguments and documents no later than 21 January 2015.

9. On 21 January 2015 the opponent submitted arguments to substantiate the opposition. These arguments were sent by the Office to the defendant on 2 February 2015, giving the defendant the opportunity to submit a reply no later than 2 April 2015.

10. The defendant filed a reply on 2 April 2015. This reply was sent by the Office to the opponent on 7 April 2015.

11. Each party filed its observations within the time limits imposed by the Office.

12. The Office has sufficient information to come to a decision on the opposition.

II. ARGUMENTS

13. The opponent filed an opposition at the Office under article 2.14, 1 (a) BCIP, in accordance with the provisions of article 2.3 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

14. The opponent argues that the contested sign is registered for drinks and beverages which also include non-alcoholic beverages for which the trademarks invoked are registered. These goods are therefore identical or highly similar. According to the opponent, there is also a high degree of similarity between 'edible ices' and the goods for which the trademarks invoked are registered, because these goods are distributed through the same sales channels, are directed to the same end user and fulfil the same purpose (to refresh and reactivate).

15. According to the opponent, the figurative elements of the contested sign are weak. The opponent also states that the verbal component usually has a stronger impact on the consumer than the figurative component. For this reason, the verbal element EXXXPRESSO dominates the visual impression of the contested sign. The opponent also states that the word element X-PRESSO is the dominant element of the trademarks invoked. For this reason, the opponent limits the comparison between the signs to the word elements X-PRESSO and EXXXPRESSO.

16. With regard to the aural comparison, the opponent argues that the letter X is pronounced as "eks" and the letters EX are also pronounced as "eks". Furthermore, according to the opponent, the presence of a hyphen does not influence the aural identity of the trademarks invoked and the fact that the disputed sign is written with three X's also does not alter the pronunciation of the sign. For this reason, the opponent concludes that the marks are aurally identical or that there exists in any event a high degree of aural similarity.

17. Regarding the visual comparison between the word elements X-PRESSO and EXXXPRESSO, the opponent argues that the letter X is a dominant feature in both signs. The opponent also argues that the endings of both signs are completely identical and that the relevant public will not pay attention to the figurative elements of the contested sign, because they are weak. For these reasons, according to the opponent, the signs have a strong visual similarity.

18. The opponent states that both signs refer to the word "espresso", which is a type of strong black coffee. Although both signs do not spell the word "espresso" correctly, due to the use of the letter X, the opponent states that the public will understand that the signs refer to an espresso. For this reason, the opponent argues that the signs are conceptually similar.

19. The opponent also argues that any possible lesser degree of similarity between the trademarks is compensated by a high degree of similarity of the goods in question.

20. The opponent concludes that there exists a likelihood of confusion with the relevant public and requests that the Office should allow the opposition and order the defendant to pay the costs of these proceedings.

B. Defendant's arguments

21. The defendant argues that the dominant elements of the trademarks invoked are the words MONSTER, HAMMER and MIDNIGHT and not the low distinctive term X-PRESSO, which refers to the term 'espresso' (a cup of concentrated coffee) and is descriptive for the goods for which the trademarks invoked are registered. According to the defendant, the spelling of the word X-PRESSO cannot be seen as an expression of high creativity.

22. With regard to the visual comparison, the defendant states that the signs differ in length, structure and figurative elements. The defendant also states that the second and third trademarks invoked start with the words HAMMER M, and MIDNIGHT M respectively. For this reason, these two trademarks are also not similar to the contested sign. According to the defendant, the first trademark invoked is also different, because the word MONSTER is a dominant element which will catch the eye of the relevant public. The defendant argues that the triple X in the contested sign is also eye-catching and highly distinctive. The defendant emphasises that the figurative elements of the contested sign, because of their particular shape and contrasting colours, also create an important visual difference.

23. According to the defendant, the signs have a different rhythm and sonority. Furthermore, the trademarks invoked are different due to the use of the elements MONSTER, HAMMER, MIDNIGHT and ENERGY. The defendant also argues that the degree of aural similarity is of less importance if the goods are marketed in such a way that the relevant public, when making a purchase, perceives the sign which designates the goods visually.

24. With regard to the conceptual comparison, the defendant argues that the contested sign, as well as the trademarks invoked contain an element that refers to the drink espresso. However, due to the elements MONSTER, HAMMER, MIDNIGHT and ENERGY, there is no conceptual similarity.

25. Furthermore, with reference to the Common Communications on the Common Practice of Relative Grounds of Refusal – Likelihood of Confusion of 2 October 2014, the defendant argues that a coincidence only in non-distinctive components does not lead to likelihood of confusion.

26. With regard to the comparison of the goods, the defendant states that the use of the term 'namely', in the list of goods for which the second and third trademarks invoked are registered, means that these goods are limited to specific energy drinks. These types of drink are not similar to the iced coffee drinks and/or ice based beverages referred to in the contested sign. Furthermore, the defendant also states that edible ices are not similar to the goods for which the trademarks invoked are registered.

27. With reference to the decision from the French Institut National de la Propriété Industrielle (INPI) regarding the opposition filed by the opponent against the French registration of the sign EXXXPRESSO & Device, based on the first trademark invoked, the defendant points out that the INPI rejected the opposition, because there was no likelihood of confusion between the signs.

28. The defendant concludes that points of similarity between the signs are neutralized because of the significant and eye-catching differences between the signs. For this reason, according to the defendant, there is no likelihood of confusion. The defendant requests that the Office should reject the opposition and the opponent should bear the fixed costs of the proceedings.

III. DECISION

A. Likelihood of confusion

29. In accordance with article 2.14, 1 BCIP, the applicant or 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 2.3 (a) and (b) BCIP.

30. Article 2.3 (a) and (b) BCIP stipulates that *“In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: a. identical trademarks filed for identical goods or services; b. identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark.”*

31. According to case law of the Court of Justice of the European Union (hereinafter: the “CJEU”) concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 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, Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999; 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; Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

32. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) “there exists a likelihood of confusion on the part of the public” 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).


33. 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).

34. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by

comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002 and El Charcutero Artesano, T-242/06, 13 December 2007).

35. The signs to be compared are the following:

With regard to the first trademark invoked (European registration 8445711)

Opposition based on:	Opposition directed against:
X-PRESSO MONSTER	

36. The trademark invoked is a purely verbal mark consisting of two words, X-PRESSO and MONSTER. The contested sign is a combined verbal/figurative mark, consisting of the word EXXPRESSO displayed in yellow letters and framed in a black box. Above and below the first letter X a chain of identical figures, shaped like one half of an X, is displayed from the top to the bottom of the black box.

37. Both signs refer to a drink called espresso which could be descriptive for the goods under discussion. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003).


38. For this reason the public will also pay attention to the word MONSTER, which causes a visual and aural difference between the signs. Furthermore, although in complex signs (verbal and figurative elements), word elements often have a greater impact on the public than figurative elements (see EGC, Selenium-Ace, T-312/03, 14 July 2005), in the matter at hand, because of the weak distinctiveness of the word EXXPRESSO, the figurative elements of the contested sign will not be ignored by the public. For this reason, the colours, font and figurative elements, as well as the spelling also provide a strong visual difference.

39. Conceptually, the Office considers that part of the relevant public could perceive the combination X-PRESSO MONSTER as a reference to a machine that provides espresso or to a person who drinks many espressos. In this regard, there is a degree of conceptual similarity. With regard to the other part of the public, who will interpret the word MONSTER as a frightening imaginary creature, part of the trademark invoked is conceptually different.

Conclusion


40. The similarities between both signs, which only lie in a weak distinctive verbal element, are outweighed by the visual and aural differences. For this reason, the Office concludes that the overall impression given by the marks is not similar, at least not sufficiently so to determine the existence of a likelihood of confusion.

With regard to the second trademark invoked (European registration 8815722)

Opposition based on:	Opposition directed against:
HAMMER M X-PRESSO MONSTER ESPRESSO + ENERGY	

41. The difference with the first trademark invoked consists of the additional words HAMMER M, ESPRESSO and ENERGY, including a plus sign between the words ESPRESSO and ENERGY. These verbal elements are visually, aurally and conceptually different from the contested sign. Furthermore, the arguments mentioned above also apply to the second trademark invoked, provided that there are even more differences in relation to the contested sign.

With regard to the third trademark invoked (European registration 8815748)

Opposition based on:	Opposition directed against:
MIDNIGHT M X-PRESSO MONSTER ESPRESSO + ENERGY	

42. Regarding the third trademark invoked, the difference consists of the additional words MIDNIGHT M, ESPRESSO and ENERGY, including a plus sign between the words ESPRESSO and ENERGY. In line with the previous paragraph, the Office considers that the arguments regarding the first trademark invoked also apply to this trademark and that there are even more differences in relation to the contested sign.

Conclusion

43. In the light of the weak distinctive character of the terms X-PRESSO and EXXPRESSO and the visual, aural and conceptual differences, the Office considers that their overall impression is that the trademarks invoked are not similar to the contested sign.

Comparison of the goods

44. As the overall impression of the signs is not similar, the Office will – for procedural reasons – not proceed with the comparison of the goods. After all, likelihood of confusion cannot exist if there is no similarity between the signs (see Article 2.3 (b) BCIP, as well as EGC decisions, easyHotel, T-316/07, 22 January 2009 en YOKANA, T-103/06, 13 April 2010). The goods are displayed below to enhance the readability of this decision.

Opposition based on:	Opposition directed against:

	Class 30 Iced coffee drinks; ice based beverages; edible ices.
Class 32 Non-alcoholic beverages, including, energy drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, excluding perishable beverage products that contain fruit juice or soy. <i>(European registration 8445711)</i>	
Class 32 Non-alcoholic beverages, namely, energy drinks flavored with coffee and enhanced with vitamins, minerals, nutrients, amino acids and/or herbs. <i>(European registrations 8815722 and 8815748)</i>	

B. Other factors

45. Regarding the defendant's reference to the decision from INPI, concerning, in the defendant's view, similar oppositions (paragraph 27), the Office points out that it is obliged to render a decision based on regulation and case law applicable in the Benelux. The Office is not bound by decisions from other offices, whether they refer to similar cases or not (see, by analogy with, EGC, Curon, T- 353/04, 13 February 2007).

46. The defendant refers to the Common Communications on the Common Practice of Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components) of 2 October 2014 (paragraph 25), which are also communicated by the Office. Although it is not an official source of law, the Office obviously also endorses these recommendations.

C. Conclusion

47. Based on the foregoing the Office is of the opinion that there is no likelihood of confusion.

IV. DECISION

48. The opposition with number 2010155 is rejected.

49. Benelux application with number 1290759 will be registered for all goods for which it has been applied.

50. The opponent shall pay the defendant 1,000 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 Implementing Regulations, as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 31 December 2015

Eline Schiebroek
(rapporteur)

Saskia Smits

Diter Wuytens

Administrative officer: Anna Dina Dikken