

Federal Patent Court: no well-known mark protection for Monster Energy's MONSTER

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GERMANY

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- The Monster Energy Company opposed the mark MONSTER in Class 9 based on its EUTMs MONSTER in Class 32 and MONSTER ENERGY in Classes 14 and 25
- The GPTO granted the opposition in part for mouse pads and laptop cases, arguing that the notoriety of the opponent's mark extended only to those goods
- Upon appeal by both parties, the Federal Patent Court rejected the opposition in its entirety

In [Case 30 W \(Pat\) 78/21](#) (23 August 2024), the Federal Patent Court has lifted the German Patent and Trademark Office (GPTO)'s decision and rejected The Monster Energy Company's opposition in its entirety, so that the contested MONSTER mark obtained protection in Germany for Class 9 goods.

Background

The applicant sought protection in Germany for its figurative, Turkish-based Intellectual Registration (IR) for the mark depicted below for "notebook computers, laptop computers, mice, mouse pads, laptop carrying cases, sleeves for laptops, notebook computer carrying cases, cases adapted for notebook computers" in Class 9:

MONSTER

Monster Energy contested this territorial extension based on its earlier EU trademark (EUTM) MONSTER, covering drinks in Classes 32, as well as its EUTM MONSTER ENERGY covering goods in Classes 14 and 25. The opposition was based on a likelihood of confusion, and the opponent also invoked the notoriety of its marks based on §9(1)(3) of the Trademark Act. The applicant contested the genuine use of the earlier marks.

The GPTO examiner allowed the opposition in part for mouse pads and laptop cases based on notoriety, while rejecting it in part due to a lack of a likelihood of confusion as the goods in Classes 14, 25 and 32 were dissimilar to the Class 9 goods. The opponent's mark MONSTER is well known and the second strongest brand in the product segment of energy drinks, after market leader Red Bull. The marks at issue were identical, but as 'monster' is a popular word, is used only in that very limited product segment and is not particularly well known, a conceptual link between the marks would be made only in special circumstances (eg, for typical merchandising goods for energy drinks). Such conceptual link would not be made with regard to computers, laptops and mice in Class 9.

In its appeal, the applicant relied on the non-use defence, arguing that the signs used by the opponent differed significantly from the marks as registered due to the use of additional device elements, which also applied to the mark MONSTER ENERGY. Further, the opponent could not rely on the notoriety of its mark due to this deviating use. The applicant also disputed that laptop bags and mouse pads were typical merchandising goods, so that no conceptual link with these goods could be inferred.

In turn, the opponent filed a counter-appeal and requested that the opposition be granted for all Class 9 goods. With regard to notoriety, especially in the gaming industry, the opponent argued that a conceptual link also existed between energy drinks and computers or laptops.

Patent Court decision

The Patent Court lifted the GPTO decision and rejected the opposition in its entirety.

The applicant's appeal was found to be well founded, as the opponent had not sufficiently substantiated the genuine use of its mark. For that reason alone, the territorial extension of the IR to Germany could not be refused. Although the applicant had originally restricted the non-use defence to Class 9 goods, such defence could later be extended to other goods and, in Germany, even raised for the first time on appeal. The court found that the deviating types of use changed the distinctive character of the opponent's mark (§26(3) of the Trademark Act) by adding graphic elements such as the 'claw' device (see below on the left), or by using combinations of the MONSTER mark and a device (see below on the right):



The court conceded that the use of 'energy' did not change the characteristics of the mark. Accordingly, the graphic design of the standard-typeface MONSTER mark went beyond a mere embellishment and developed its own distinctive and distinctive character.

Moreover, the court agreed with the lower instance that there was no likelihood of confusion due to a lack of similarity of the goods, simply referring to the correct reasoning delivered by the GPTO.

Finally, and leaving aside the genuine use issue, the court also refused to grant enhanced protection as a well-known mark. Even assuming that the opponent's MONSTER mark had a certain reputation, it could not be assumed that the public would establish a mental link between the parties' marks for goods in Class 9. When considering the uses of the opponent's mark with its graphic alterations, the similarity of the signs was only low and, when considering the distance between the goods, there was no conceptual link. The opponent did not show with substantive evidence that there was a connection between energy drinks and the Class 9 goods.

Comment

The decision shows that, in Germany, caution is advised when it comes to genuine use of word marks if device elements are added on the products. Although a word mark registered in standard typeface is generally not adversely affected by reproduction in another standard typeface, differing and unusual typefaces, fonts or device elements may change its distinctive character (unless those elements can be considered to be independently distinctive). Especially in the case of common words, deviating designs should be registered separately.

In contrast to EUIPO proceedings, the formal procedural requirements for raising the non-use defence at the GPTO or the Patent Court are rather low. The defence can be raised at any stage of the proceeding, even on appeal, and there are no specific formal requirements as long as it can be construed as a non-use defence.

Finally, it is worth noting that, just like in EUIPO proceedings, considerable evidence is necessary when asserting rights in a well-known mark in GPTO proceedings: reputation must be demonstrated in relevant parts of the European Union and in at least an economically not insignificant part of the domestic public, and evidence may include high market shares, the intensity, geographical scope and duration of use, as well as high levels of investment and advertising.

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