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General Court on genuine use: Coffee in Cl. 30, Coffee out Cl. 32

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As you may recall from our post on the 'Sony Vita' invalidation case, where a trade mark is registered for a product but only used for something viewed by consumers as a different product, the trade mark right for the registered product for which it is not used is lost, even if it resembles the actual marketed product, or is contained in it, or serves a secondary but commercially irrelevant function. In *Monster Energy v. EUIPO / Frito-Lay* (joined cases T-758/20 and T-759/20), the GC had the opportunity to reiterate this assumption on 10 November 2021. The **GC confirmed the rule that one product belongs to one category under the Nice Classification**, the only exception being that it is a composite product.

Frito Lay had applied to revoke EUTM no. 009492158 for 'MONSTER' in cl. 5, 29, 30 and 33 held by Monster Energy under Article 51(1)(a) EUTM Regulation (cancelation decision No 14 861 C), claiming that the trade mark had not been put to genuine use for any of those goods within five years. Having initially (but unsuccessfully) tried to hold on to classes 5 (based on energy drinks being at the same time nutritional supplements) and 30 (with respect to milk and coffee being ingredients of some of their products), the case before the GC only concerned "coffee". Monster Energy argued that their drinks, and more particularly their "X-PRESSO MONSTER" drink, were both coffee and energy drinks (cl. 30 and 32) at the same time in an attempt to maintain protection in class 30.

The General Remarks (to the 9th edition of the Nice Classification) provide that a finished product is one which is ready to be marketed (para. 37). The premise is that a finished product is classified in one of several classes based on its function or purpose (para. 38). In most cases it is not possible

to classify a product twice. The true function or intention of the 'X-PRESSO MONSTER' beverages was to be used as 'energy drinks' in Class 32, even if they are coffee-flavoured variations (para. 40). Monster's assertion that some customers buy the products not for a stimulating coffee-flavoured energy drink, but as 'coffee based beverages' under Class 30 was unsupported (para. 43). As the GC pointed out, 'energy drinks' in Class 32 were distinguished from 'coffee-based beverages' in Class 30 in terms of the Nice Classification. The explanatory notes on the various classes of that classification are important in determining the nature and purpose of the products in question. Non-alcoholic beverages are normally classified as Class 32, but beverages with a coffee base, which are classified as Class 30 and specifically excluded from Class 32, relate to beverages in which coffee is the dominating and distinguishing feature. Class 32 includes beverages that are merely "coffee-flavoured" but not "coffee-based." Monster Energy's assertion that the 'X-PRESSO MONSTER' products are' multi-purpose composite things was in vain. Multi-purpose composite products are goods that are sold as a whole, but each of their individual components has a separate and distinct market value and may be sold without the other components. Monster Energy canned beverages, on the other hand, are an inseparable homogeneous product that serves a single purpose, namely, to be a stimulating energy drink with a coffee flavour (para. 51).

Comment

This judgment has ramifications for trademark filing and enforcement, emphasizing the necessity for specification. The applicant must identify the goods and services for which trademark protection is sought with sufficient clarity and precision for competent authorities and economic operators to establish the scope of the protection requested solely on that basis (C-307/10, IP-TRANSLATOR, para. 49). Even though the Nice Classification has a purely administrative function, it **is based on the idea that a particular product belongs to only one of numerous classes**. A single (not composite) product may usually only be classified in one of several product categories, and which category it belongs to is determined by the product's major commercial function. Coffee and coffee-based items are classified as class 30. Class 32 includes beverages that are only coffee flavoured (but do not contain coffee as a base). "A coffee base' is what Monster was ultimately unable to prove in the absence of any evidence of usage of the contested trade mark in relation to coffee-based drinks.

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