

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF THE
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE**

[2023] SGIPOS 14

Trade Mark Nos. 40202013352R and 40202109370Q

IN THE MATTER OF TRADE MARK APPLICATIONS

IN THE NAME OF

YG ENTERTAINMENT INC

... Applicant

AND

OPPOSITIONS BY

MONSTER ENERGY COMPANY

... Opponent

GROUNDS OF DECISION

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Monster Energy Company
v
YG Entertainment Inc

[2023] SGIPOS 14

Trade Mark Nos. 40202013352R and 40202109370Q
IP Adjudicator Ravindran s/o Muthucumarasamy
19 October 2023

29 December 2023

IP Adjudicator Ravindran s/o Muthucumarasamy:


Introduction

1 This is not the Opponent’s first rodeo.

2 Since 2012 to the hearing date of this matter, the Opponent has filed 52 notices of opposition with the Registrar of Trade Marks. In 32 of these cases, the applicants either withdrew their applications or defaulted in filing their counter-statements or evidence (and hence were treated as having withdrawn their applications)¹. Seven cases were withdrawn by the Opponent. Seven cases (excluding the present proceedings, which involves two cases) went to a full hearing²; the Opponent was unsuccessful in each. It appealed to the High Court

¹ See rules 31(3) and 31A(9) of the Trade Mark Rules

² See *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12 (unsuccessful opposition against application mark “MONSTER STRIKE” in Classes 9 and 41); *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 17 (unsuccessful opposition against application

mark “” in Classes 30 and 43); *Monster Energy Company v Glamco Co., Ltd.* [2018] SGIPOS 7 (unsuccessful opposition against application mark “SWEET MONSTER” in Class 30); *Monster Energy Company v Tencent Holdings Limited* [2018]


in three of these cases but the appeals were dismissed in each case.³ Four other cases are still pending.

3 In respect of the matters before me, I find the oppositions unsuccessful and allow protection to be conferred on these international registrations designating Singapore for the detailed reasons given below.


Background facts

4 The Applicant is YG Entertainment Inc., a Korean pop (K-pop) entertainment company. According to the Applicant’s evidence⁴, the Applicant operates as a record label, talent agency, music production company, event management and concert production company, and music publishing house. Amongst other things, it recruits, trains and manages its talents.

5 The Applicant applied to protect in Singapore (a) the trade mark **BABYMONSTER** under International Registration No. 1537499 (Singapore TM No. 40202013352R) on 22 May 2020 and (b) the trade mark **BABYMONSTERS** under International Registration No. 1518394

SGIPOS 9 (unsuccessful opposition against application mark “” in Classes 9, 41 and 42); *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16 (unsuccessful

opposition against application mark “” in Classes 9, 16, 25, 28 and 41); *Monster Energy Company v Health and Happiness (H&H) Hong Kong Limited* [2021] SGIPOS 14

(unsuccessful opposition against application mark “” in Class 35); and *Monster Energy Company v IICOMBINED Co., Ltd.* [2023] SGIPOS 13 (unsuccessful opposition against application mark “GENTLE MONSTER” in Class 9).

³ *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 17 and *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16 were upheld on appeal with no public written grounds of decision). *Monster Energy Company v Glamco Co., Ltd.* [2018] SGIPOS 7 was upheld on appeal by the High Court in [2021] SLR 319).

⁴ See [12] below

(Singapore TM No. 40202109370Q) on 6 April 2021. For ease of reference, I will refer to both marks collectively as the “BABYMONSTER(S)” Marks. Both applications were filed in Classes 9, 25, 28 and 41 for almost but not quite identical specifications. In the circumstances, it bears setting out in detail the individual applications and their respective specifications.

Trade Mark No.	Mark	Class	Specification
40202013352R	BABYMONSTER	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.
		25	Outerclotthing; ready-made clothing; underwear; neck gaiters; caps being headwear; waterproof clothing; shirts; sweaters; scarves;

			skirts; sports wear; footwear; socks; clothing; belts [clothing]; gloves [clothing]; tee-shirts; pants; pullovers; bottoms [clothing].
		28	Toy LED light sticks; 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; electronic toys; jigsaw puzzles; plush dolls; play balloons; plastic character toys; toy figures.
		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; providing information in the field of entertainment; 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.
40202109370Q	BABYMONSTERS	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.
		25	Outerclotthing; 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].
		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].
		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.
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6 The Opponent, Monster Energy Company, opposed the conferment of protection in Singapore on the Applicant’s international registrations. According to the Opponent’s evidence⁵, the Opponent is a US company and a global leader in the energy drinks industry. The Opponent owns at least 33 registered trade marks in Singapore; many of them include the word “MONSTER”.

7 The oppositions were consolidated from the close of pleadings. As such, each party filed a single set of evidence in respect of the consolidated oppositions.

Grounds of opposition

8 The Opponent relies on section 8(2)(b) and section 8(7)(a) of the Trade Marks Act 1998 (“the Act”) in these oppositions.

⁵ See [11] below

9 The Opponent relies on the following marks (with TM Nos. 40201401724W and 40201501193T being the marks of primary focus) in these oppositions.

No.	Trade Mark No.	Mark	Class	Specification
1	40201401724W	MONSTER ENERGY	09	Protective clothing; protective footwear; protective headwear; protective eyewear, sports helmets; eye glasses; eye glass cases; sunglasses; sunglass cases; video recordings featuring sports, extreme sports, and motor sports; eyeglass cords.
			16	Printed matter and publications; posters; stickers; decals; transfers; cards; stationery; signboard of paper and cardboard; sticker kits comprising stickers and decals.
			18	Bags; backpacks; wallets; business card cases; attaché cases; card cases [notecases];

				carrying cases for documents; cases for cosmetic articles; cases for keys; cases for sporting articles (not fitted or shaped); cases for travel kits (not fitted); cases of imitation leather; cases of leather, or leatherboard; credit card cases; document cases; driving license cases; portfolio cases (briefcases); tie cases; travel cases; vanity cases (not fitted); overnight cases; music cases, and make-up cases; key cases; duffle bags; book bags; handbags; all-purpose sports bags; all-purpose bags; leather and imitations of leather, and goods made of these material and not included in other
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				classes.
			25	Clothing, footwear, and headgear.
2	40201501193T	MONSTER ENERGY	35	Promoting goods and services of others in the sports, motorsports, electronic sports, and music industries through the distribution of printed, audio and visual promotional materials; promoting sports and music events and competitions for others; retail and wholesale of food and beverage via a distributor; retail and wholesale services featuring foods and beverages; online retail store services in the field of beverages, clothing, headwear, calendars, posters, stickers, promotional items.
			41	Entertainment services;

				organizing, conducting and staging sports events, live musical performances, exhibitions and competitions; on-line publication and provision of multimedia content in the nature of multimedia files containing audio, video, text, still images, and graphics in the fields of sports, people, entertainment, and music; providing non-downloadable publications in the nature of multimedia content in the nature of multimedia files containing audio, video, text, still images, and graphics in the fields of sports, people, entertainment and music via a website.
3	40201614650U	MONSTER ENERGY	32	Non-alcoholic

				beverages; beer.
4	T0605639H	MONSTER	32	Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.
5	T1111969F	MONSTER	05	Nutritional supplements in liquid form.
			32	Non-alcoholic beverages.

10 In its written submissions, the Opponent referred to **MONSTER ENERGY** (TM No. 40201401724W) and **MONSTER ENERGY** (TM No. 40201501193T) as the “Registered ME Marks”. For clarity, I will refer to them as the Registered “MONSTER ENERGY” Marks and to **MONSTER** (TM No. T0605639H) and **MONSTER** (TM No. T1111969F) as the Registered “MONSTER” Marks.

Opponent’s evidence

11 The Opponent’s evidence comprises the following:

- (a) a re-executed Statutory Declaration made by Paul J Dechary, Executive Vice President and Deputy General Counsel of the Opponent, on 8 June 2022 in California, the United States of America; and

(b) a Statutory Declaration in Reply made by the same Paul J Dechary on 23 March 2023 in California, the United States of America.

Applicant's evidence

12 The Applicant's evidence comprises the following:

(a) a Statutory Declaration made by Yang Min Suk and Hwang Bo Kyung, Chief Executive Officers of the Applicant, on 7 November 2022 in the Republic of Korea; and

(b) a supplementary Statutory Declaration made by the same Yang Min Suk and Hwang Bo Kyung on 18 January 2023 in the Republic of Korea.

Applicable law and burden of proof

13 There is no overall onus on the Applicant before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

Grounds of opposition under section 8(2)(b)

14 Section 8(2)(b) of the Act reads:

(2) A trade mark shall not be registered if because —

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

15 The law in this area is well-settled and the parties were largely in agreement on the general principles of law in this area. The dispute is, as they

generally are in these cases, on the application of these general principles on the facts of the case.

16 The leading case on section 8(2)(b) is the Court of Appeal decision in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”). That case laid out the step-by-step approach to be followed in determining whether a mark should or should not be allowed to proceed to registration. The first step is to determine whether the marks in question are similar. The second is to determine whether or not the relevant goods or services are identical or similar to each other. The final step is to ask whether because of the first two steps being satisfied, there exists a likelihood of confusion. It is also clear that if any one of the three steps are not satisfied, the opposition must fail.

17 In its oppositions under this ground, the Opponent relied on its Registered “MONSTER” Marks as well as its Registered “MONSTER ENERGY” Marks. The Opponent combined both the different groups of registrations when making its written submissions. In its reply submissions, the Applicant stated that “the opposition must be assessed as against each of the Opponent’s marks as an individual registration, not against the marks as a group.” At the hearing, the Opponent conceded that this should be the case. In the circumstances, this decision will deal first with the oppositions based on the Opponent’s Registered “MONSTER ENERGY” Marks (being the primary marks it relies on here) and then subsequently with its Registered “MONSTER” Marks.

Oppositions based on reliance of the Registered “MONSTER ENERGY” Marks.

18 I will have to, as stated above, consider whether the marks are similar, whether the specifications are identical or similar and finally, if as a result of the aforementioned similarity, there is a likelihood of confusion.

Mark similarity

19 The Court of Appeal in *Staywell* stated that “a mark which has a greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.” Technical distinctiveness refers to a mark’s capacity to function as a badge of origin. It is noteworthy that the Opponent did not argue that its Registered “MONSTER ENERGY” Marks had a high level of inherent technical distinctiveness. In *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12 (“*Mixi*”), such an argument was made by the Opponent but the Registrar dismissed it. The Registrar stated at [44]:

Distinctiveness lies on a spectrum and on the high end – at least for plain word marks – lie invented (and hence meaningless) words and names. Word marks which are formed through the combination of two ordinary English words, and which are not descriptive of the goods or services in question, such as “MONSTER ENERGY” probably lie somewhere in the middle.

20 I agree with the Registrar in that case. In the circumstances, I find that the Opponent’s Registered “MONSTER ENERGY” Marks, not having a high level of inherent technical distinctiveness, will not enjoy the correspondingly high threshold before the Applicant’s “BABYMONSTER(S)” Marks are found to be different. With that, I now turn to the three aids to the issue of mark similarity i.e., the conceptual, visual and aural analysis.

Conceptual Similarity


21 I find it useful, when the marks in question can convey a meaning, to start with conceptual similarity. The Court of Appeal in *Staywell* cited (at [35]) Bently & Sherman, *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) (“*Bently & Sherman*”) at p 866 for the proposition that the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole.

22 The question is whether if the marks in question have a common component, as they do here, they must then necessarily convey a similar idea. The Court of Appeal in *Staywell* had a view on this issue:

Greater care is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts.

23 The Court of Appeal found this was well illustrated by the ECJ case of *Vedial SA v OHIM – France Distribution (HUBERT)* (Case C-106/03 P) [2004] ECR I- 9573. In that case, one of the questions before the court was whether



the mark  was conceptually similar to “SAINT-HUBERT 41”. In a passage cited by our Court of Appeal at [35], the Court of First Instance in that case stated:

With regard to conceptual analysis of the marks in question, it must be observed that the ideas suggested by the terms ‘SAINT-HUBERT’ and ‘HUBERT’ are different. The combination of the terms ‘SAINT’ and “HUBERT” with a hyphen between them creates a concept and logical unit that is distinct from those of its components. Thus the words ‘SAINT-HUBERT’ form an inseparable whole which is likely to evoke in the mind of the

targeted public a saint of the Catholic religion or a name of a place. The word 'HUBERT', on the other hand, corresponds to a common masculine French Christian name.

24 The question in the instant case is what is the dominant idea behind the marks taken as a whole. Both marks comprise two distinct English words without any stylization or accompanying device. The Opponent's Registered "MONSTER ENERGY" Marks comprise the words "MONSTER" and "ENERGY"; the Applicant's "BABYMONSTER(S)" Marks consist of the word "BABY" conjoined with "MONSTER" or "MONSTERS".

25 It is important to understand the meaning of the words which form the subject matter of the competing marks. In this regard, I take guidance from what has gone on before. In *Monster Energy Company v Glamco Co., Ltd.* [2021] 3 SLR 319 ("*Glamco*") at [48], Chan J defined "Monster" as:

- 1 A large, ugly, and frightening imaginary creature.
 - 1.1 An inhumanly cruel or wicked person.
 - 1.2 *humorous* A rude or badly behaved person, typically a child.
- 2 A thing of extraordinary or daunting size.
- 3 A congenitally malformed or mutant animal or plant.

26 In *Mixi*, the Registrar at [40] defined "Energy" as "... a common English word which refers to the source of strength or stamina or vitality needed for a physical or mental task. It could also refer to certain types of power e.g. kinetic energy, nuclear energy".

27 In the Oxford English Dictionary, "Baby" is defined as "A very young child, esp. one not yet able to walk and dependent on the care of others; an infant".

28 The Opponent argued that the marks in questions are conceptually similar as they have the same dominant concept of a monster and someone or something with a monstrous amount of energy.

29 On the other hand, the Applicant cited four local cases in which conceptual ideas behind the competing marks were found to be different even though a word was shared as between the marks. In other words, the dominant idea behind the marks taken as a whole was different from that conveyed by the individual components of the marks. Three of the cases involved the same Opponent as the instant case and so have some relevance to the case at hand.

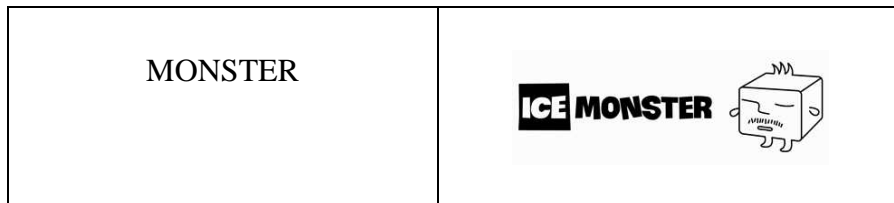
30 In *Glamco* at [65], the High Court found the marks “SWEET MONSTER” and “MONSTER” conceptually dissimilar. The learned judge stated the following:

Indeed, the word “sweet” is defined in the Oxford English Dictionary as “pleasing in general; delightful” and also “charming and endearing”. Therefore, when the word “sweet” is used as an adjective to describe the word “monster”, it changes the impression that a consumer would get from an image of a “large, ugly and frightening imaginary creature” (at [48] above) to a “delightful” and “endearing” imaginary creature.

31 In *Mixi*, the Registrar found the marks “MONSTER STRIKE” and “MONSTER ENERGY” to be conceptually different; “MONSTER STRIKE” refers to a great action and “MONSTER ENERGY” refers to huge potential.

32 In *Monster Energy Company vs Chun-Hua Lo* [2017] SGIPOS 17, the Registrar was of the opinion that the following marks were not conceptually similar:

Opponent’s Mark	Applicant’s Mark
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The Registrar found the ideas conveyed by the applicant’s mark to be that of cold and ice cubes, as well as a friendly and approachable creature which contrasted with the idea of a monster.

33 I am of the opinion that the conceptual meaning of the marks taken as a whole are not similar. “MONSTER ENERGY” gives the idea of something or someone which will provide or give off a large or “monstrous” amount of energy whilst “BABYMONSTER(S)” conveys the idea of a very young monster, not yet the frightening creature he or she (or, for completeness, they) is destined to be. In particular, the Applicant’s “BABYMONSTER(S)” Marks, being a composite of two words, each of which lie on the opposite spectrum of scariness, is especially memorable.

34 The Opponent had cited the corresponding EUIPO case, *Monster Energy Company v YG Entertainment Inc* (Opposition No. B3125519) (“Corresponding EU Case”) in which the court found that the marks were conceptually similar to an average degree. It should be noted that in that case, the court split the words up and stated that “the public will perceive BABY as a separate element and the contested sign will be mentally broken down into the elements BABY and MONSTERS”. As can be seen from the Singapore authorities cited by the Applicant, we should look at the marks as a whole and not split the marks into their individual components.

Visual Similarity

35 On visual similarity, the Opponent again splits the component words of the application marks and treats each separately. The Opponent argued that the word “BABY” should be accorded “little or no weight...given that it essentially serves a descriptive function in relation to the goods or services designated” i.e. the goods and services were intended for babies. On the other hand, according to the Opponent, the word “MONSTER” in the Applicant’s “BABYMONSTER(S)” Marks should “stand out” as it is not descriptive of the goods designated. The Opponent goes on to argue that the “MONSTER” component in the Applicant’s “BABYMONSTER(S)” Marks, being contained wholly in the Opponent’s Registered “MONSTER ENERGY” Marks, causes the marks to be more similar than dissimilar, taking into consideration the doctrine of imperfect recollection of the consumer.

36 The question is whether it is permissible to divide the Applicant’s “BABYMONSTER(S)” Marks in the manner which the Opponent has done. Is it more likely that the consumers will read both words together rather than chop the marks into two?

37 The Applicant referred to the High Court decision in *Glamco* where the Opponent in this case opposed the registration of the mark “SWEET MONSTER”. The learned judge gave short shrift to the Opponent’s attempt to cleave the mark “SWEET MONSTER” into two and deal with both words separately, instead stating (at [58]) that consumers would view “the Application Mark as a unitary whole rather than just focus on one part of it.”

38 The rationale for this was best put by the Registrar who heard the case when she said, at [76(i)], that “the word ‘sweet’ (an adjective) precedes the word

‘monster’ (a noun). This has the effect of causing the words ‘sweet’ and ‘monster’ to ‘hang together’ to form an indivisible unit.”

39 Although “BABY” is generally used as a noun, it can be used as an adjective when it is used before a noun as in this case: see Britannica.com.

² baby /'beɪbi/ adjective

Britannica Dictionary definition of BABY

always used before a noun

: very small : much smaller than usual

- a *baby* grand piano
- *baby* carrots/vegetables
- Take *baby* steps.

40 I am of the opinion that the word “BABY” in the Applicant’s “BABYMONSTER(S)” Marks directly injects a new meaning to the second word “MONSTER” or “MONSTERS” such that the public will look at the Applicant’s “BABYMONSTER(S)” Marks as a whole. The individual components “BABY and “MONSTER” would, therefore, “‘hang together’ to form an indivisible unit”.

41 Furthermore, the learned judge in *Glamco* stated that both words were equally prominent and there was no dominant element *per se*. In the instant case too, the words “BABY” and “MONSTER” or “MONSTERS” are equally prominent in that they use the same fonts and are of the same size and color. It is true that the word “BABY” is shorter than the word “MONSTER” but I think nothing turns on that given the other factors.

42 Last but not least, it is also worth mentioning that the Applicant’s “BABYMONSTER(S)” Marks are actually filed with the two words conjoined which does further encourage the public to look at the marks holistically.

43 Just as there is, in my opinion, no dominant visual component to the Applicant’s “BABYMONSTER(S)” Marks, there is similarly no dominant visual component to the Opponent’s Registered “MONSTER ENERGY” Marks. They are of similar font, size and colors.

44 Given the marks in question have no dominant element, the visual comparison is a fairly simple exercise. In *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 (“*Ozone*”), the High Court (citing *Bently & Sherman*) stated that a determination of visual similarity involved looking at the following:

- 1 length of marks
- 2 structure of the marks (i.e., whether there are same number of words); and
- 3 whether the same letters are used in the marks

45 It is not necessary to be pedantic in respect of this visual comparison. It is clear that the marks are visually more dissimilar than similar. Firstly, the letters M, O, N, S, T, E and R are the first letters of the Opponent’s Registered “MONSTER ENERGY” Marks whilst they are the last letters of the Applicant’s mark. From a visual point of view, this difference is striking. Secondly, even if one were to ignore the relative positioning of the “MONSTER” component, there are different and equally prominent letters in each mark which can hardly be ignored. These are the letters B, A, B and Y in the Applicant’s “BABYMONSTER(S)” Marks and the letters E, N, E, R, G and Y in the Opponent’s Registered “MONSTER ENERGY” Marks. These letters are completely different from each other. Thirdly, the Applicant’s

“BABYMONSTER(S)” Marks are one-word marks and the Opponent’s Registered “MONSTER ENERGY” Marks each comprise a two-word mark. For these reasons, I would conclude that the respective marks are visually dissimilar.

46 The Opponent had cited the Corresponding EU Case which found that the marks in question had an average degree of visual similarity. As stated earlier, the EUIPO had broken the mark into the individual component words. For reasons given above, I am not so inclined to split the marks as the EUIPO has done.

47 The Opponent also cited *Lancome Parfums et Beaute & Cie v Focus Magazin Verlag GmbH* Case R 238/2009-2 where the EUIPO found the marks FOCUS and COLOR FOCUS to be similar in respect of cosmetics. The court held that “the word element ‘COLOR’ will be perceived as being purely descriptive in relation to cosmetic products and, therefore, it is unlikely to leave a lasting impression on the consumer’s mind. Particularly so where the second word element ‘FOCUS’ is perfectly distinctive in relation to the goods in question.”

48 This case had been cited in *Monster Energy Company v Glamco Co., Ltd.* [2018] SGIPOS 7 and the Registrar in that case distinguished it on the basis that words “COLOR” and “FOCUS” are both nouns and so “the additional first word element ‘COLOR’ ... is not such so as to counteract the overall similarity of the signs.” The Applicant highlighted this point in comparison to an adjective-noun combination in the present case. I agree.

Aural similarity

49 The Opponent submitted that the marks were aurally similar to an average degree because “an overlap exists in the distinctive ‘MONSTER’ element of the marks.”

50 This, however, presupposes that “MONSTER” is to be considered the aurally distinctive or dominant component of both marks. In this regard, the cases of *Glamco* and *Mixi* are again instructive. The Registrar in *Mixi* found that there was no aurally dominant component when comparing the marks “MONSTER STRIKE” and “MONSTER ENERGY”. They were all common English words which were easy to pronounce. In *Glamco*, Chan J was also of the view that “SWEET MONSTER” did not have a dominant component and adopted a quantitative assessment in determining aural similarity.

51 In my view, there is no dominant component to the words “BABYMONSTER(S)” and “MONSTER ENERGY”. As in *Glamco*, I believe the quantitative approach is more appropriate in this case. The Applicant’s “BABYMONSTER(S)” Marks have four syllables each whilst the Opponent’s Registered “MONSTER ENERGY” Marks have five syllables each. Two of the syllables are identical. However, what is critical is the positioning of these identical syllables. In the Applicant’s “BABYMONSTER(S)” Marks, the identical syllables are found at the end of the mark whilst for the Opponent’s Registered “MONSTER ENERGY” Marks they are found at the very start. The other syllables found in the Applicant’s “BABYMONSTER(S)” Marks and the Registered “MONSTER ENERGY” Marks are completely different. In the circumstances, even though there are two identical syllables, the aural similarity of the marks, when taken as a whole, are more dissimilar than similar.

52 The Opponent had cited the EUIPO case of *Bobo Choses, S.L. v Jessica Bosio* (opposition B3161368) where the contested marks were “BOBO Choses”



and . The EUIPO held that the marks were aurally similar to an average degree. The contested goods were in Classes 25 and 28 and included, amongst other things, “infants’ clothing” and “infant toys”. The word “BABY” was clearly descriptive of the goods applied for. Under those circumstances, “BOBO” would be considered the dominant component of the marks and so their finding of the marks being aurally similar to an average degree may be understood in that context. However, in the instant case, “BABY” is not, in my opinion, descriptive of the goods or services applied for and there is no dominant component in either of the competing marks.

53 In conclusion, and having analysed the competing marks conceptually, visually and aurally, I find “BABYMONSTER(S)” to be more dissimilar than similar to “MONSTER ENERGY”. As mark similarity is an essential step to be satisfied under s 8(2)(b) of the Act, the oppositions must necessarily fail. However, for completeness, I will deal with the other two elements under this section as well.

Similarity of goods/services

54 The Applicant accepts that the goods and services it applied for in Classes 25 and 41 are identical or similar to the goods and services claimed in the Opponent’s Registered “MONSTER ENERGY” Marks in those respective classes. The Applicant also accepts that “sunglasses” found in their specification in Class 9 is identical or similar to the Opponent’s specifications in the same class i.e., “eye glasses” and “sunglasses”.

55 There is one area of dispute. The Applicant had filed for “golf bags” in respect of its TM No. 40202109370Q but not in respect of TM No. 40202013352R. The Opponent argued that their “bags, all-purpose sports bags, all-purpose bags” in Class 18 were similar to the Applicant’s “golf bags” in Class 28. The Applicant went through the “*British Sugar*” factors (as set out in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281) in detail and submitted that the goods were dissimilar but only addressed the factors for “all-purpose sports bags” and “all-purpose bags”. The Applicant did not deal with the Opponent’s wide specification of “bags”. I find that, at the very least, the Applicant’s “golf bags” will be encompassed within the Opponent’s specification for “bags”.

Likelihood of confusion

56 In my view, there is no likelihood of confusion between the respective marks for the following reasons:

(a) I have already found the marks to be more dissimilar than similar. Even if I am wrong on this score, the respective marks are, at the very most, only slightly similar, and this would militate against a finding of likelihood of confusion.

(b) As for the impression conveyed by the marks in question, I have to be mindful of the possibility of imperfect recollection. After having reminded myself of this possibility, I am still not convinced that there is a likelihood of confusion. As I have stated earlier, “MONSTER ENERGY” gives the idea of something which will provide or give off a large amount of energy whilst “BABYMONSTER(S)” conveys the idea of an infant monster.

(c) Another important consideration under this element is the reputation of the Registered “MONSTER ENERGY” Mark. The Opponent did file quite a bit of evidence to show reputation. However, most of the evidence was in relation to the Composite Mark: defined and shown in [74] and [75] below. This mark is quite different from the Opponent’s Registered “MONSTER ENERGY” Marks and so I do not consider the evidence of reputation filed by the Opponent to be helpful for it on this issue.

Opposition based on reliance of the Registered “MONSTER” Marks

57 The Registrar had, prior to the hearing, asked the Opponent to identify the primary marks on which it relies in the opposition proceedings, for more focus in the submissions. The Opponent accordingly identified its Registered “MONSTER ENERGY” Marks as its primary marks and I have completed the analysis of these marks in the foregoing paragraphs. For completeness, I will now deal with the remaining Registered “MONSTER” Marks too.

58 In terms of mark similarity, one would have thought that the Registered “MONSTER” Marks are closer to “BABYMONSTER(S)” than the Registered “MONSTER ENERGY” Marks. This is because “MONSTER ENERGY” has the additional word “ENERGY” which serves to further distinguish it from “BABYMONSTER(S)”. The question arises as to why the Opponent would not consider it a primary mark that it would rely on heavily in these proceedings.

59 The reason is, I believe, because the goods/services for which the respective marks are registered and applied for are clearly quite different. For ease, I will set down the respective marks, and the specifications that the Opponent submits are similar:

<p align="center">“BABYMONSTER(S)” Marks</p>	<p align="center">Registered “MONSTER” Marks</p>
<p>TM Nos. 40202013352R and 40202109370Q</p> <p>Class 41: Entertainment services in the form of performances by singers; night club entertainment services; entertainment services</p>	<p>TM No. T0605639H</p> <p>Class 32: Beverages</p>
	<p>TM No. T1111969F</p> <p>Class 32: Non-alcoholic beverages in Class 32.</p>

60 The Opponent argued that the respective goods and services should be considered similar as they share the same trade channels and users. In particular, as TM No. T0605639H has been registered for “beverages”, this could include beer and various beer-based beverages which are typically provided and sold during entertainment events and at night clubs. TM No. T1111969F was registered for “non-alcoholic beverages in Class 32”. In respect of this registration, the Opponent repeated the same argument that the Applicant’s Class 41 services share the same trade channels and users.

61 I am not persuaded that the respective goods and services are similar. In its reply submissions, the Applicant applied the “*British Sugar*” factors to the facts of the case. I will just mention three:

- (a) The respective uses are different. Beverages are for quenching thirst whilst entertainment services are for the purpose of amusement or recreation.

(b) In respect of trade channels, while beverages could be sold at entertainment events, this similarity is purely incidental. The core purpose of entertainment services is to provide amusement, not to provide beverages, and the Nice classification reflects this distinction (entertainment services are in Class 41, whereas bar services and restaurant services are in Class 43).

(c) Beverages and entertainment events are not complementary. While beverages and the provision of beverages could be considered complementary, the provision of entertainment services is a step removed from the provision of beverages. Moreover, unlike bar or restaurant services where a manufacturer of beverages may open a bar or restaurant to sell its beverages, manufacturers of beverages do not usually provide entertainment services.

62 The Applicant also referred to a UK IPO case *Hula One Ltd v Northern Hospitality (MCR) Limited O/917/22* (“*Hula*”). One of the questions in that case was whether “non-alcoholic beverages; soft drinks; energy drinks; guarana drinks” are similar to “entertainment and night club services”. A very similar issue seizes us in the instant case. The Registrar stated the following in that case:

Even if I were to accept that [beverages in Class 32] can be sold in premises providing [the opponent’s] entertainment and nightclub services and that the goods can be sold in bottles or cans (so that the average consumer will be exposed to the mark under which the goods are marketed), any similarity in trade channel is purely incidental and is neutralized by the fact that the purpose of the goods and services is different, entertainment versus quenching thirst. In my view **these goods and services are dissimilar.**” (emphasis in original)

63 I am in agreement with the Applicant’s submissions on this point and also with the Registrar in *Hula* in the passage cited above. In the circumstances,

I am of the opinion that the relevant specifications as found at [59] above are not similar and, consequently, I find that the ground of opposition which relies on the Registered “MONSTER” Marks under s 8(2)(b) will also not succeed.

Ground of opposition under section 8(7)(a)

64 The section reads as follows:

(7) A trade mark must not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) By virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign in the course of trade.

65 The trinity of elements for passing off are well known and are as follows: goodwill, misrepresentation and damage (or, in this case, likelihood of damage since there is no evidence that the allegedly offending use has commenced on the date of application).

Goodwill

66 The Opponent has been selling its energy drinks in Singapore since October 2012. In the circumstances, I have no difficulty in finding that the Opponent has the requisite goodwill in Singapore. Indeed, the Applicant does not dispute this.

Misrepresentation

67 The parties part company on this issue.

68 The Opponent stated that it had first started to sell its “MONSTER ENERGY” energy drinks in Singapore in October 2012. Sales of these drinks from October 2012 to March 2021 were US\$15.3 million. It also spent US\$7.5

million in marketing and promoting “MONSTER ENERGY” drinks during the period March 2012 to March 2021. These sales turnover figures were backed by invoices and shipping documentation showing that there was use in Singapore.

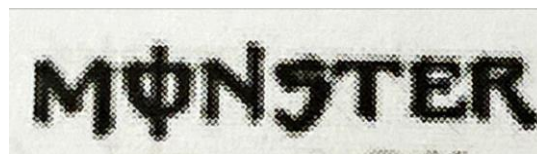
69 The Opponent also adduced evidence of printouts showing “MONSTER ENERGY” drinks being made available for sale at various outlets in Singapore. An example is found below:



70 The Opponent further stated that besides “MONSTER ENERGY”, there were variations of the drink with different names like “MONSTER ENERGY ABSOLUTE ZERO”, “MONSTER KHAOS”, “MONSTER ENERGY MANGO LOCO” and “MONSTER ENERGY ULTRA”. An example of the manner in which the different names are used is found below:



71 The Opponent submitted that all these various brands are subsumed under what they termed the “Stylised ‘MONSTER’ Mark”. It further argued that the Stylised “MONSTER” Mark is consistently incorporated as the unifying, common element as part of the beverage product names. The Stylised “MONSTER” Mark is reproduced below:



72 Identifying the mark (or any other indicia) under which the Opponent’s products are being sold is paramount under the tort of passing off as that provides the basis in assessing whether the Applicant’s use of its “BABYMONSTER(S)” Marks constitutes an actionable misrepresentation.

73 As stated by the Court of Appeal in *The Singapore Professional Golfers’ Association v Chen Eng Waye and others* [2013] 2 SLR 495 at [20], it is necessary to first consider if the mark (or other indicia) under which the claimant’s products are sold is distinctive of the claimant’s goods and services and, if so, then to consider whether “there is such a similarity between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other” such that there is a likelihood of confusion.

74 I have examined closely the exhibits which the Opponent states show the use of the Stylised “MONSTER” Mark. While it is true that the Stylised “MONSTER” Mark is found on the products in these exhibits, it is always used as part and parcel of a composite mark which includes a claw device and the words “MONSTER ENERGY” in a stylised form (the “Composite Mark”). In the circumstances, I am of the opinion that if there is any “unifying, common element” in respect of the Opponent’s energy drinks it must be this Composite Mark.

75 A representation of the mark is found below:



76 Indeed, the Composite Mark has been registered in Singapore in Class 32 under TM No. T0609605E since 2006. The Stylised “MONSTER” Mark, on the other hand, has not been registered in Singapore. It is clear therefore that the Opponent, who by all accounts is no stranger to branding and trade mark law, considers the Composite Mark a primary mark for its energy drinks. The constant and consistent use of the Composite Mark on energy drinks in Singapore that the Opponent adduced also bears that out.

77 In the circumstances, it is important to study the Composite Mark as it is the mark under which the Opponent sells its energy drinks. In use, the claw device in the Composite Mark is much larger than the stylized words “MONSTER ENERGY”. It is found at the top of the mark and, more often than not, in striking green. In the circumstances, the claw device dominates the Composite Mark. The device appears to be large, deep, serrated scratches made by a powerful animal with claws. As such, the device conveys a frightening image of pain and danger. It must have been intended by the Opponent to be memorable and, in my opinion, it certainly is.

78 The Composite Mark is quite at odds with the idea of a baby even if, admittedly, a baby monster. In the circumstances, and in respect of the Composite Mark, I find no likelihood of confusion with the Applicant’s

“BABYMONSTER(S)” Marks given the overall impression conveyed by each of the marks.

79 The Opponent also submits that it uses a stylized version of the “MONSTER ENERGY” mark on the cans and on the website. A representation of this mark is shown below:



80 In this regard, I make the following points. Firstly, the stylized version of the “MONSTER ENERGY” mark is again part and parcel of the Composite Mark. The claw device, being memorable, will always feature in the public’s recollection of the mark under which the energy drinks are being sold. Secondly, I have already concluded that the Registered “MONSTER ENERGY” Marks (which are in plain block letters) are different from the “BABY MONSTER(S)” Mark in my analysis of the opposition under s 8(2)(b). I think this applies with even more force for the stylized version of the mark.

81 The Opponent stated that its marketing strategy is to allocate the majority of its marketing, advertising and promotional budget on athlete endorsements and sponsoring athletic competitions and other events. It was in this connection that the Opponent filed substantial evidence of athletes, teams and events including the F1 race in Singapore, MotoGP, FIM Motocross World Championship, Asian X Games, Ultimate Fighting Championship, the National Association for Stock Car Auto Racing, DC South East Asia Tour and Tiger Woods. It also sponsored music tours and music festivals.

82 The marketing and promotional events and activities adduced by the Opponent are quite significant. However, the question which arises is what these events and activities are in aid of. The answer must be that they are to assist in the promotion and sale of the Opponent's "MONSTER ENERGY" drinks. Indeed, the Opponent has stated as much in its evidence:

Monster Energy has widely advertised, marketed and promoted its MONSTER ENERGY drinks bearing the MONSTER Marks through the sponsorship of athletes and athletic competitions around the world (which includes vast media and Internet coverage), on apparel and merchandise bearing the MONSTER Marks distributed in retail outlets, in magazines, on the MONSTER ENERGY and other Internet websites, through social media such as its Facebook page, in publications, through the sponsorship of music festivals and musicians, and through the distribution of point of sale ("POS") and promotional materials.

83 However, in my view, even if the Opponent's "MONSTER ENERGY" drinks are well known, there is no overlap and, in fact, some distance between energy drinks and the goods and services which the Applicant has claimed. In the circumstances, apart from the difference between the Composite Mark and the Applicant's "BABYMONSTER(S)" Marks, this factor further reduces the risk of confusion on the part of the Singapore public.

84 Finally, the Opponent did submit that it had goodwill in respect of apparel and merchandise. In this connection, the Applicant submitted that there was no or very little evidence of these goods actually being sold in Singapore. I agree. This may also be contrasted with the substantial evidence of goodwill that the Opponent had proffered in respect of the sale of its energy drinks in Singapore. Secondly, I have perused the evidence of the marks used on the apparel and merchandise and it would appear that many of the exhibits include the Composite Mark or, at least, the claw device. So, even if there is goodwill in respect of these products in Singapore, I believe the differences between the

marks are sufficient for there to be no likelihood of confusion. An example of the mark used on apparel and bags is found below:



85 In the circumstances, I am not convinced that the Opponent has shown on the balance of probabilities that there is likely to be any confusion on the part

of the Singapore public by the use by the Applicant of the “BABYMONSTER(S)” Marks on the goods and services which it has applied for.

Damage

86 Given my finding for the second element, it will not be necessary for me to deal with this third element of the tort.

Overall conclusion

87 Having considered all the pleadings and evidence filed and the submissions made in writing and during the hearing, I find that the oppositions fail on all grounds. Protection in Singapore is conferred on International Registration No. 1537499 (Singapore TM No. 40202013352R) and International Registration No. 1518394 (Singapore TM No. 40202109370Q).

88 Having considered the parties’ submissions and HMD Circular 6.1 at Part F, I award costs to the Applicant as follows:

Party and Party Costs: \$6,158.28

Disbursements: \$11,273.10

The total assessed costs to be paid by the Opponent to the Applicant are \$17,431.38.

89 Finally, I would like to record my appreciation for the well-researched and succinct written submissions of both parties’ counsel, and the clarifications provided to me by Ms Toh and Mr Loy during the hearing which were most helpful.

Ravindran s/o Muthucumarasamy
IP Adjudicator

Anna Toh, Bryan Ong (Amica Law LLC) for the Applicant;
Anan Sivananthan, Brendan Loy, Alison Tang (Bird & Bird ATMD
LLP) for the Opponent.
