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

Trade Mark No. 40201506548Y

Hearing Date: 13 June 2017

IN THE MATTER OF A TRADE MARK APPLICATION BY

MIXI, INC.

AND

OPPOSITION THERETO BY

MONSTER ENERGY COMPANY

Hearing Officer: Ong Sheng Li, Gabriel Assistant Registrar of Trade Marks

Representation:

Mr Just Wang (Bird & Bird ATMD LLP) for the Opponent Mr William Ong and Ms Amanda Soon (Allen & Gledhill LLP) with Ms Dhiviya Mohan (Marks & Clerk Singapore LLP) for the Applicant

GROUNDS OF DECISION

Introduction

1 In *Joseph Crosfield & Sons' Application* (1909) 26 RPC 837 at 854, an old English case where an application to register "Perfection" as a trade mark for soap was refused by the Court of Appeal, Cozens-Hardy M.R. pithily observed that:

"Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure"

2 The present trade mark opposition, of course, is set in a different context. But stripped of the legalese, this dispute is, at heart, also about one trader's battle to fence off an ordinary English word – "monster" – for itself, and to exclude others – specifically, another trader seeking to register a trade mark containing that word, from access to the metaphorical enclosure that is the Trade Marks Register.

Background to the dispute

3 Mixi, Inc. (the "Applicant") was founded in Japan in 1999 and is headquartered in Tokyo. It is in the business of digital media and mobile gaming. According to the Applicant, it has a paid-up capital of over 9 billion Japanese yen, and has over 500 fulltime employees.

4 "MONSTER STRIKE", which was first launched in October 2013, is the Applicant's most popular mobile game, and has been a big hit in Japan and elsewhere. In its first year of release, "MONSTER STRIKE" exceeded 14 million users, and was ranked within the top 3 Japanese mobile games for over a year on both Google Play and the Apple App Store. Evidence was tendered in relation to the commercial success of the "MONSTER STRIKE" game, but I need not go into detail about that here.

5 On 23 June 2014, the Applicant applied to register "MONSTER STRIKE" (Trade Mark No. 40201506548Y) in Classes 9 and 41 (the "Application Mark") in respect of the following goods and services:

Class 9

Downloadable computer game programs; downloadable programs for personal computers; downloadable computer program for smart phones; downloadable computer programs for cellular phones; downloadable computer game programs for hand-held games with liquid crystal displays; downloadable arcade video game programs; downloadable consumer video game programs; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for personal computers; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for smart phones; electronic circuits, magnetic disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for smart phones; electronic circuits, magnetic disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for smart phones; electronic circuits, magnetic disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for smart phones; electronic circuits, magnetic disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for smart phones; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs,

DVD-ROMs and other data media, all featuring recorded programs for cellular computers; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for hand-held games with liquid crystal displays; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for consumer video game programs; electronic machines, apparatus and their parts; telecommunication machines and apparatus; straps, covers, earphone jack and other accessories for cellular phones and tablet computers; stylus pen for telecommunication machines; downloadable image files; downloadable music files; downloadable character data; electronic publications (including also downloadable and recorded in electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media).

Class 41

Providing non-downloadable video games using communication by an electronic computer terminal, and consultation and providing information thereof; providing non-downloadable video games using communication by a PDA, and consultation and providing thereof; providing non-downloadable video games via a smart phone, and consultation and providing information thereof; providing non-downloadable video game using communication by hand-held games with liquid crystal displays, and consultation and providing information thereof; providing non-downloadable games for consumer video games and arcade video games via Internet, and consultation and providing information thereof; providing non-downloadable games via on-line, and consultation and providing information thereof; providing information about providing video games; providing amusement facilities; providing electronic publications about video games; providing electronic publications, and providing information thereof; services of reference libraries for literature and documentary records; providing images, motion pictures, music and audio materials via on-line, and consultation and providing information thereof; providing images, motion pictures, music and audio materials using communication by a PDA, and consultation and providing information thereof; movie showing, movie film production, or movie film distribution; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of videotape film in the field of education, culture, entertainment or sports [not for movies or television programs and not for advertising or publicity]; organization, arranging and conducting an event about video games; organization of entertainment events excluding movies, shows, plays, musical performances, sports, horse races, bicycle races, boat races and auto races.

6 Monster Energy Company (the "Opponent") is a company incorporated in Delaware, USA. It was previously in the general beverage trade: apart from developing, producing, marketing and selling energy drinks, it was also involved in products such as natural sodas, fruit juices, smoothies, lemonades and iced teas. The Opponent enjoyed considerable success in the field of beverages generally, winning industry accolades and recognition from publications such as Forbes, Fortune Magazine and Business Week. In June 2015, it transferred its non-energy drinks business to The Coca-Cola Company. Presently, its business revolves around a core line-up of energy drinks marketed and sold under various

trade marks. Each of the Opponent's energy drink cans bears the claw device " Π " together with the stylised word "**MUNSTER**"

7 On 29 September 2015, the Opponent filed this opposition against the Application Mark.

Grounds of Opposition

8 The grounds of opposition that the Opponent relies on are: Section 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii)(A), 8(4)(b)(ii)(B) and 8(7)(a) of the Trade Marks Act (Cap. 332, 2005 Rev Ed) ("TMA").

9 Although the Opponent initially pleaded bad faith under Section 7(6) TMA as a ground of opposition, this was later withdrawn by way of a letter dated 17 April 2017.

Relevant date

10 The relevant date in these proceedings is the application date of the Application Mark: 23 June 2014. This is the date by reference to which the parties' rights are to be assessed.

The Opponent's Earlier Trade Marks

11 The Opponent is the registered proprietor of the trade marks set out below. Each of them are "earlier" trade marks in that they were each registered *prior to* the relevant date of 23 June 2014.

- a. "MONSTER ENERGY" registered as:
 - i. T0603081Z in Class 32
 - ii. T0813668B in Classes 9, 16, 18 and 25

T

b. "**MUNSTER**" registered as:-

- i. T0609605E in Class 32
- ii. T0813672J in Classes 9, 16, 18 and 25
- c. "MONSTER" registered as:
 - i. T0605638Z in Class 5
 - ii. T0605639H in Class 32
 - iii. T1111969F in Classes 5 and 32

- d. "MONSTER DETOX" registered as T1206503D in Classes 5, 30 and 32
- e. "MONSTER REHAB" registered as T1107597D in Classes 5, 30 and 32
- f. "MONSTER REHABITUATE" registered as T1210719E in Classes 5, 30 and 32
- g. "JAVA MONSTER" registered as:
 - i. T0611182H in Class 32
 - ii. T1402722I in Class 32
- h. "X-PRESSO MONSTER" registered as T1009880F in Classes 5 and 32

I refer to the above collectively as "the Opponent's Earlier Trade Marks".

12 It is the Opponent's case that the Opponent's Earlier Trade Marks form part of what it termed as the "MONSTER" family of trade marks.

Evidence filed

- 13 The following Statutory Declarations ("SD(s)") were tendered in evidence.
 - a. Mr Rodney Cyril Sacks, Chairman and Chief Executive Officer of Monster Beverage Corporation, gave evidence on behalf of the Opponent by way of SD. I refer to Mr Sacks' first SD, dated 16 August 2016, as "RCS-SD1".
 - b. Mr Kanji Kobayashi, legal manager of the Applicant, gave evidence on its behalf by way of SD. I refer to Mr Kobayashi's SD, dated 16 August 2016, as "KK-SD".
 - c. The Opponent's evidence in reply was also given by Mr Sacks. I refer to his second SD, dated 9 March 2016, as "RCS-SD2".

14 Neither party applied to cross-examine the other side's deponent. As such, the abovementioned SDs form the totality of the evidence in these proceedings.

The hearing

15 During oral argument, it was common ground that the doctrine of a family or series of marks: (a) applies in Singapore; and (b) can be taken into account in the likelihood of confusion assessment, but not when comparing the marks for similarity.

16 A number of points were made and/or emphasised in oral argument. I will address these submissions, where necessary and relevant, in the course of the decision below.

MAIN DECISION

Opposition under Section 8(2)(b) TMA

17 Section 8(2)(b) TMA provides that:

''8.

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

(a) -

(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."

The key earlier trade mark: "MONSTER ENERGY"

18 Out of all of the Opponent's Earlier Trade Marks, the Opponent placed key reliance on one: T0813668B. This is the plain word mark "MONSTER ENERGY", registered in Classes 9, 16, 18 and 25 for the following goods:

Class 9

Protective clothing; protective footwear; protective headwear; protective eyewear; all included in Class 9.

Class 16

Printed matter and publications; posters; stickers; transfers; cards; stationary; signboards; all included in Class 16.

Class 18

Bags; backpacks; wallets; cases; key cases; leather and imitations of leather, and goods made of these materials and not included in other classes; all included in Class 18.

Class 25

Clothing; footwear and headgear; all included in Class 25.

According to the Opponent, while many of the other Opponent's Earlier Trade Marks cited are highly similar to the Applicant Mark (in different ways), it is "MONSTER ENERGY" (T0813668B) that is the most similar overall;¹ hence its primary reliance on this mark.

19 While the Applicant did not agree that "MONSTER ENERGY" is similar to the Application Mark "MONSTER STRIKE", it likewise took the position that the rest of the Opponent's Earlier Trade Marks are even more dissimilar.

¹ Opponent's Written Submissions at [40].

In my judgment, the Opponent's case under Section 8(2)(b) TMA essentially stands or falls on "MONSTER ENERGY" (T0813668B). This is where the battle lines are drawn. It is clear that out of all of the Opponent's Earlier Trade Marks, "MONSTER ENERGY" comes closest in terms of similarity. If "MONSTER ENERGY" is found to be dissimilar to "MONSTER STRIKE", the rest of the Opponent's Earlier Trade Marks would be even more dissimilar.

21 I now proceed to conduct the analysis by reference to "MONSTER ENERGY".

The step-by-step approach

22 It is well established that the analysis under Section 8(2)(b) TMA takes the form of a "step-by-step" approach.

23 Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round. (*Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc.* [2014] 1 SLR 911 ("*Staywell*") at [15]; *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 ("*Caesarstone*") at [26].)

Each step, or element, in the sequence must be cleared before moving on to the next. If the marks are found to be dissimilar, the inquiry ends, and the opposition under Section 8(2)(b) TMA will fail. The same applies for the second step: if the respective goods/services are found to be dissimilar, the opposition under this section will likewise fail. It is only if these first two steps are crossed that it falls to be considered, under the third step, whether there exists a likelihood of confusion on the part of the public.

First step: whether the marks are similar?

General principles

25 Under this first step, the court or tribunal must conclude whether the marks, when observed in their totality, are similar rather than dissimilar. (*Caesarstone* at [27].) This is inevitably a matter of impression. (*Staywell* at [17].)

There are three aspects of similarity: the visual, aural, and conceptual. These aspects do not invite a formulaic consideration; rather, they are signposts towards answering the question of whether the marks are similar overall, and trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. Thus, there is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. (*Staywell* at [17] - [18]; *Caesarstone* at [27].) 27 The marks similarity assessment is mark-for-mark, without consideration of any external matter (sometimes referred to as "extraneous" matter or factors). At this stage, I am not permitted to consider the relative weight and importance of each aspect of similarity having regard to the goods or services, because that is a matter for the confusion stage of the inquiry. (*Staywell* at [20].) The prohibition against taking into account external or extraneous matter merits further discussion in the context of distinctiveness, and I will return to it shortly (see [33] – [37] below).

In the assessment for marks similarity, the viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry. Further, it is assumed that the average consumer has imperfect recollection. As such, the competing marks are not to be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, what I have to consider is the general impression that will likely be left by the essential or dominant features of the marks on the average consumer. (*Caesarstone* at [27]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 ("*Hai Tong*") at [40(c)-(d)].)

In certain circumstances, the overall impression conveyed by a composite trade mark may be dominated by one or more of its components. (*Hai Tong* at [62(c)].) But this need not always be so: it cannot and must not be assumed that there will always be a feature of the mark which dominates the mark's landscape. In many cases, no particular feature will stand out. Micro-analysing a mark for particular distinctive features in such cases is unhelpful. (*Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 (HC) at [30].²)

Distinctiveness

30 Distinctiveness is integral to the assessment for marks similarity. In *Staywell*, the Court of Appeal explained the two senses of the term.

- a. <u>Distinctiveness in the ordinary and non-technical sense</u>: This refers to what is outstanding and memorable about the mark in question. These distinctive (in the non-technical sense) and memorable components of the mark are those that tend to stand out in the consumer's imperfect recollection. That is why the court (or tribunal) is entitled to have special regard to the distinctive or dominant components of a mark, even while it assesses the similarity of the two marks as composite wholes. (*Staywell* at [23].)
- <u>Distinctiveness in the technical sense</u>: Here, distinctiveness carries a meaning that stands in contradistinction to descriptiveness. It refers to the capacity of the mark to function as a badge of origin. Technical distinctiveness can be inherent that is to say, where the words comprising the mark are meaningless and can say nothing about the goods or services. Or, it can be acquired that is, where

² Although this decision of the High Court was reversed on appeal, the Court of Appeal did not comment on this particular passage and I see no reason, in principle, to doubt its correctness.

words may have a descriptive meaning, but yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use. (*Staywell* at [24]; *Hai Tong* at [32] – [33].)

It is important, however, not to lose sight of the fact that distinctiveness must be assessed by looking at the mark as a whole. The distinctiveness of a particular *component* of a mark is but one factor feeding into the ultimate question of whether the mark, in the form it is registered and/or used, has strength as an indicator of trade source. (*Staywell* at [29].)

31 *Staywell* is also authority for the proposition that what is distinctive in the *ordinary and non-technical sense* for one aspect of similarity may not necessarily be so for another aspect of similarity. In *Staywell* the competing marks were "ST. REGIS" and " PARK REGIS

PARK REGIS ". The Court of Appeal's decision in relation to the assessment for aural and conceptual similarity³ was as follows:

- a. <u>Aural</u>: The High Court had found that "Regis" was the dominant and distinctive component of both marks when each is read out (aurally). The Court of Appeal agreed that the High Court was perfectly entitled to come to this view (see *Staywell* at [31]), and found that there was a high degree of aural similarity between the competing marks because of the distinctiveness of the common "Regis" component in both the technical and non-technical senses (see *Staywell* at [33]).
- b. <u>Conceptual</u>: The Court of Appeal did not agree that "Regis" was a dominant component on a conceptual analysis. The court cautioned that greater care is 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 (see *Staywell* at [35]). It was ultimately held that the competing marks were conceptually similar in that they both evoked the idea of a place or location.⁴ (*Staywell* at [37].)

32 As regards technical distinctiveness, the Court of Appeal in *Staywell* reaffirmed the principle that this "*is an integral factor in the marks-similarity inquiry*", and that "*a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it*". (*Staywell* at [25].)

33 The interplay of the principles set out above gives rise to an interesting but important question: how can the principle that technical distinctiveness "*is an integral factor in the marks-similarity inquiry*" be reconciled with the prohibition against taking into account "*external matter*" at the marks-similarity stage? (See *Staywell* at [25] and [20]

³ The issue of whether the marks were visually similar was not before the Court of Appeal.

⁴ Specifically, although "ST. REGIS" might conjure the image of a saintly person, in Singapore the most common manifestation of saintly names is in relation to places, ranging from schools, roads, hospitals, condominums, to an assortment of other public places. As for "PARK REGIS", the word park connoted the idea of a geographical location (although not necessarily of any particular type).

respectively.) After all, in certain cases the inherent distinctiveness of a sign may depend on the goods or services to which it relates. (An example is the sign "soap", which would be devoid of distinctive character in relation to soap, but may be distinctive for other goods/services.)

34 In addressing the above question, it is useful to start with *Beats Electronics, LLC v LG Electronics Inc.* [2016] SGIPOS 8 ("*Beats*"),⁵ a decision of the learned Professor David Llewelyn which he heard in this tribunal *qua* IP Adjudicator.

- a. There, the application mark was "QuadBeat" in Class 9 for a range of audio equipment and related goods. The opponent relied primarily on the plain word mark "BEATS", registered in Class 9 for a range of goods, including audio products. The opponent argued that "BEATS" possesses a high level of inherent distinctiveness in relation to the goods, but this submission was rejected by the learned IP Adjudicator, who held that this was not a fact (which he did not accept, in any event, as being correct) which may be taken into account at the marks similarity stage having regard to the prohibition against taking into account any other matter. (See *Beats* at [21].)
- b. How then did the learned IP Adjudicator reconcile the prohibition against taking into account any other matter at the marks similarity stage as against the principle that technical distinctiveness is an integral factor in the marks-similarity inquiry? His approach was that the "technical distinctiveness of the two marks must be considered in the abstract at this [marks-similarity] stage, ie without reference to the actual goods/services at issue".⁶ He took pains to stress that he was not suggesting that the opponent's BEATS mark was without distinctive character as a trade mark for the audio electronic products in respect of which it is registered merely that the level of distinctiveness of the earlier mark in relation to the goods for which it is registered is an issue reserved for the likelihood of confusion enquiry, if it is reached. (See Beats at [22].)

35 With respect to the learned IP Adjudicator's decision in *Beats*, I do not read *Staywell* at [20] as standing for the proposition that the technical distinctiveness at the markssimilarity stage is confined to an abstract assessment only. Pertinently, later in the *Staywell* decision, and in the context of aural similarity, the Court of Appeal stated (at [31]) that: "*At least in relation to hotels and hospitality services, "Regis" enjoys a substantial degree* of technical distinctiveness". (The marks were ultimately found to be aurally similar, having regard to the common dominant element "Regis" in both marks.) To my mind, this shows that technical distinctiveness in the abstract. The services (or goods) can be taken into account insofar as they relate to distinctiveness.

⁵ *Beats* was appealed to the High Court, and the hearing is fixed for a date after the issue of this decision.

⁶ Applying that approach, the learned IP Adjudicator found "QuadBeat" to be an invented word and therefore having a considerable degree of inherent technical distinctiveness due to the fact that it is "meaningless", although not without allusive impact in relation to audio products. As for "BEATS", he considered that it could range from being inherently distinctive to being devoid of distinctive character depending on the goods/services in question.

36 I now turn to *Caesarstone*, a trade mark opposition dispute which reached the Court of Appeal.

- a. The application mark was "Ocaesarstone" and the opponent's mark was "·CÆSAR·". In the result, the opposition was allowed by the Court of Appeal under Section 8(2)(b) TMA. This meant, of course, that the marks were held to be similar.
- b. At the first step (*i.e.* the assessment for marks-similarity), the Court of Appeal agreed with the opponent-appellant's argument that the differentiating word "stone" in the application mark was merely descriptive of the goods in Class 19 (for which registration was sought).⁷
- c. The Court of Appeal held that because the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark, its presence could not "fairly be regarded as being effective to displace similarity". (See *Caesarstone* at [41].) And, being merely descriptive of the goods in question, the "stone" element did not "sufficiently and substantially distinguish" the application mark from the opponent's mark. (See *Caesarstone* at [42].)

Although the focus in *Caesarstone* was on the application mark rather than the opponent's earlier trade mark, the point remains that in the course of the marks-similarity assessment, the Court of Appeal analysed the "stone" element by reference to the goods for which registration was sought. (See also *Caesarstone* at [47] and [52], which concern the role of "stone" in the aural and conceptual aspects of similarity respectively.)

37 To summarise, in my reading of *Staywell* and *Caesarstone*, it is clear that while the similarity of marks comparison is to be undertaken mark-for-mark, without consideration of any external matter, to the extent that the respective goods/services are relevant to the issue of the distinctiveness (in both its technical and non-technical senses) of the competing marks, they may be taken into account.

38 Although the abstract assessment approach applied by the learned IP Adjudicator in *Beats* may have its merits, I am bound by the Court of Appeal's decision in *Caesarstone*. For the avoidance of doubt, none of the parties' submissions dealt with *Beats* and the reason I have discussed it at length is that I am respectfully departing from an earlier decision of this tribunal and giving my detailed reasons therefor.

Examining the word elements

⁷ Being: Non-metallic tiles, panels for floors, floor coverings, wall cladding, flooring, and ceilings; nonmetallic covers for use with floors and parts thereof; non-metallic profiles and floor skirting boards; slabs and tiles formed of composite stone for building panels, counter tops, vanity tops, floors, stairs, and walls.

39 I now proceed to apply the above principles to the present case.

40 Although the competing marks "MONSTER ENERGY" and "MONSTER STRIKE" must be assessed and compared as wholes, it is useful to begin the analysis by examining each of their components, given that they are each made up of two word elements.

- a. <u>MONSTER</u>: The word "monster" could refer to a mythical or abnormal creature, usually large and possessed of some fearsome qualities. Some commonly encountered examples from popular culture would include: the Loch Ness Monster, Godzilla, and Frankenstein. The word "monster" could be applied to a person of particularly objectionable character or exhibiting immoral behaviour. (For example: "He was an absolute monster!") There are also various other definitions and shades of meaning that could be accorded to it. For instance, in videogames, it refers to virtual creatures within the game's environment. Other closely related words include "monstrous" and "monstrosity". By any measure, "monster" is an ordinary English word.
- b. <u>ENERGY</u>: This is also 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. In the context of the Opponent's energy drinks, it refers to beverages which, when consumed, have a stimulating or rejuvenating effect and which may be used to overcome physical or mental tiredness. All told, "energy" is a commonly encountered word in the English language.
- c. <u>STRIKE</u>: Among the most well utilised words in the English language are action words. The word "strike" is one such action word. In this sense, it refers to hitting forcibly, as in "strike a blow", "strike a piano key", or "when the clock strikes ten". Such an action could also be non-physical, for example: "it strikes me that such-and-such". There are also many other definitions and shades of meaning of the word. The point is that "strike" too, is a common English word.

Distinctiveness of "MONSTER ENERGY"

41 What about the words "MONSTER ENERGY" together?

42 In *Hai Tong*, the words in the plaintiff's registered trade mark were "LADY" and "ROSE".⁸ Separately, each word was found to be not inventive, but the juxtaposition of the words, when used together – as in "LADY ROSE" – was found to engender distinctiveness in that they did not convey a sensible meaning. (See *Hai Tong* at [35].)

43 Here, the words "MONSTER" and "ENERGY" are not invented words.⁹ And, when used together they are not descriptive of any of the goods in Classes 9, 16, 18 or 25. I have

⁸ The registered trade mark also contained a rose device, but that is a separate point.

⁹ I agree that "MONSTER" is not descriptive of the goods or services in question: see [40] of this decision.

no difficulty concluding therefore that "MONSTER ENERGY" possesses inherent distinctiveness.

44 However, I cannot agree with the Opponent's submission that "MONSTER ENERGY" has a high level of inherent distinctiveness.¹⁰ 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. Here, the fact that there is a space between "MONSTER" and "ENERGY" only serves to ensure that each would be read as a separate word.

In summary, I find the technical distinctiveness of "MONSTER ENERGY" to be normal, or ordinary, in nature. While "MONSTER ENERGY" does not describe the goods for which it is registered, it certainly does not qualify as a mark that has greater technical distinctiveness. Consequently, it does not enjoy a high threshold before a competing sign (here: "MONSTER STRIKE") will be considered dissimilar to it.

(1) Visual similarity

- 46 I now compare the marks visually.
 - a. The words are in plain font with no stylisation or differences in font size. The first word "MONSTER" in both marks is made up of 7 letters. The second word "ENERGY" in the Opponent's mark also contains 7 letters. The second word "STRIKE" in the Application Mark contains 6 letters. Visually, each of the word elements in the competing marks are well balanced in that they are both equally visually prominent. For the foregoing reasons, no element in either mark can be said to be more outstanding or memorable than the others visually. This also means that "MONSTER" cannot be said to be the distinctive and dominant feature of either mark.
 - b. The words "MONSTER", "ENERGY" and "STRIKE" are all relatively common words in the English language. They are not invented words. While "MONSTER" is not descriptive of the goods in question, the same can also be said for "ENERGY" and "STRIKE". Thus, it is doubtful that consumers would accord "MONSTER" any greater trade mark significance (*i.e.* as a badge of origin) even if it is the first word. Instead, what would stick in the mind's eye of the consumer would be "MONSTER ENERGY" as a whole, especially since this term has no ordinary meaning when used in relation to the goods for which the mark is registered. Similarly for "MONSTER STRIKE".

¹⁰ Opponent's Written Submissions at [42]. Note: The Opponent did not make submissions on whether "MONSTER ENERGY" has acquired distinctiveness through use in relation to the goods for which it is registered.

c. It is self-evident that the word "STRIKE" in the Application Mark is not at all similar to "ENERGY" visually.

47 At this juncture, it is convenient to discuss two cases that the Opponent relied on in written submissions.¹¹

48 The first is the Court of Appeal's decision in *Caesarstone*, which I have touched upon at [36] above. For convenience, I again reproduce the competing marks: " **Caesarstone** " and "**CÆSAR**•". The court considered "caesar" to be the distinctive and dominant component of both marks, and it bears repeating that the word "stone" in the application mark was found to be merely descriptive of the goods in Class 19 (for which registration was sought). That being the case, the differences between the two marks (i.e. the device and the word "stone") did not serve to distinguish the marks sufficiently and substantially. The overall impression conveyed by both marks was dominated by "caesar". In the premises, the marks were held to have a *moderate level of visual similarity*. (See *Caesarstone* at [43] – [44].)

49 In the Opponent's submission, this case is similar to *Caesarstone* in that "MONSTER" is the dominant and distinctive element of both marks whereas the words "ENERGY" and "STRIKE" in the respective marks are subsidiary word elements that do not drastically or sufficiently differentiate the marks visually. In this connection, it was argued that the words "STRIKE" and "ENERGY" are descriptive. Therefore, so the argument goes, the marks ought to be found to be similar to a high degree.

50 I am of the view that *Caesarstone* does not assist the Opponent.

51 As the Applicant correctly pointed out, unlike "stone" which was found to be descriptive of the relevant goods in *Caesarstone*, "STRIKE" is not descriptive of the goods and services for which registration is sought, ¹² and can serve to sufficiently and substantially distinguish the Application Mark.¹³ And as I have found above, "ENERGY" is clearly not descriptive of the goods in Classes 9, 16, 18 and 25 for which T0813668B is registered. Furthermore, unlike the word "caesar" in the case relied upon, "MONSTER" cannot be said to be the distinctive and dominant feature of either mark in this case.

52 The second case which the Opponent relied on is *Lancôme Parfums et Beauté & Cie v Focus Magazin Verlag GmbH* (Case R 238/2009-2) ("*Lancôme*"), a trade mark cancellation action against a European Community Trade Mark (CTM) registration heard by the Second Board of Appeal. In *Lancôme*, the competing marks were "COLOUR FOCUS" (in Class 3 for cosmetic and make-up preparations) and "FOCUS" (also in Class 3 for cosmetics). It was held that "FOCUS" was distinctive in relation to cosmetic products, whereas "COLOUR" would be perceived as purely descriptive. This finding was not disturbed on appeal.

¹¹ Opponent's Written Submissions at [43] – [48].

¹² See goods and services at [5] above.

¹³ Applicant's Written Submissions at [13].

As with *Caesarstone*, *Lancôme* does not assist the Opponent for similar reasons. That case involved a mark with one descriptive element ("COLOUR") and one distinctive element ("FOCUS"). In this case, the elements in both marks are not descriptive of the respective goods (and in the case of the Application Mark, services as well).

54 In conclusion, while it is true that the competing marks each contain the same first element "MONSTER" and are thus visually similar to that extent, overall the marks are visually *more dissimilar than similar*, having regard to the fact that the second word in each mark is not at all similar to the other. Integral to my decision on this point is the finding that the element "MONSTER" is not the distinctive (in both the technical or non-technical senses of the word) and dominant component of either of the marks, and should *not* be given additional weight in the assessment.

(2) Aural similarity

55 Next, are the marks aurally similar?

There are two possible approaches in the assessment: the first is to undertake the analysis by reference to the dominant components of the marks; whereas the second is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. (*Staywell* at [31] - [32].) It is also important to bear in mind that the aural analysis involves the utterance of the syllables without exploring the composite meaning embodied by the words. (*Staywell* at [35].)

57 As with the visual assessment, the Opponent's case on the aural comparison focused on the common element "MONSTER", whereas the Applicant presented arguments to the effect that "STRIKE" was a distinguishing feature.

Above, I have held that "MONSTER" is *not* the distinctive (in both senses of the word) and dominant component of the respective competing marks. This holds true for the aural analysis as well. The present case is different from *Staywell* where the "REGIS" component was found to be technically distinctive in relation to hotels and hospitality services as well as distinctive in the non-technical sense because it is what will stand out in the imperfect recollection of the consumer.

59 Where then does this leave the analysis under the first approach? In my judgment neither "MONSTER" nor "ENERGY" can be said to be the aurally dominant component in the Opponent's mark "MONSTER ENERGY". Similarly, for "MONSTER STRIKE": neither "MONSTER" nor "STRIKE" can be said to be aurally dominant. Notably, each of the words: "MONSTER", "ENERGY" and "STRIKE" are commonly encountered words in the English language. (At least much more so than, say, "REGIS".) Each of them is not difficult to pronounce and the public in Singapore would be well acquainted with them. To the ear, "ENERGY" and "STRIKE" sound completely different. It is true that there would be commonality in the element "MONSTER". But once a speaker moves on to the next word in each mark, "ENERGY" and "STRIKE" would be aural points of distinction that would set the respective marks apart.

- 60 I reach a similar result following the second path.
 - a. The Opponent's "MONSTER ENERGY" would be pronounced as "MON-STER EN-ER-GY" (5 syllables). As for "MONSTER STRIKE", this would be "MON-STER STRI-KE" (4 syllables, with the "k" or "ke" sound at the end, as in the word "like"). The marks cannot be said to have more syllables in common than not. In any event, the Application Mark has less syllables than the Opponent's "MONSTER ENERGY" mark.
 - b. It is fair to say that some speakers in Singapore might pronounce the word "STRIKE" in a manner such that the "k" or "ke" sound at the end is silent. Following this line of argument, "MONSTER STRIKE" would be 3 syllables, as compared to the 5 syllables in "MONSTER ENERGY". Out of a total of 8 syllables (across the competing marks), 4 are common. Since the numbers are even, the marks once again cannot be said to have more syllables in common than not.

61 To conclude, although I note that the competing marks both contain the same first word "MONSTER", this word cannot be taken to be the dominant and distinctive element of the competing marks. Equal attention would be paid to the words "ENERGY" in the Opponent's trade mark and "STRIKE" in the Application Mark. Those words, when spoken, are aurally different both in the way they are pronounced and in terms of the number of syllables they contain. In conclusion, the marks are aurally more dissimilar than they are similar.

(3) Conceptual similarity

The analysis for conceptual similarity seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole. (*Caesarstone* at [48]; *Staywell* at [35].)

63 Here as before, the Opponent focused on "MONSTER" whereas the Applicant focused on "STRIKE". In response, the Opponent stressed that "STRIKE" does little to differentiate the marks conceptually since the meaning of "STRIKE" conveys the same meaning as that of "ENERGY", *i.e.* an impression of force and strength.

64 In my view, it is not helpful to break down the respective marks into their constituent parts because the words must be read in context. Without context, one would not be able to properly uncover the ideas that lie behind and inform the understanding of the marks as wholes. The first word can completely change the complexion of the next. For instance, "nuclear energy" or "kinetic energy" or "high energy" is obviously different from "monster energy", just like "monster strike" is different from "air strike".

I am mindful of the Court of Appeal's exhortation in *Staywell* that greater care is 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. (*Staywell* at [35].)

66 All things considered, "MONSTER" cannot be said to be the distinctive and dominant component of the marks for the conceptual comparison.

67 Here, "MONSTER ENERGY" could mean one of two things. It could refer to some sort of mythical monster or bestial creature that is great, powerful, and full of energy. Or it could refer to someone or something possessed of such great and powerful energy that is akin to that which is possessed by a monster.

As for "MONSTER STRIKE", it could refer to a mythical monster that is carrying out a striking action (*i.e.* hitting something with great force), or a striking action that is of such great force as if a figurative monster had initiated that strike. The Applicant also proffered another meaning: that of hitting or attacking monsters (as in the case of its mobile game).¹⁴

69 When distilled to their respective essences, "MONSTER ENERGY" brings to mind something or someone that contains or possesses a great deal of energy, whereas "MONSTER STRIKE" evokes the image of awesome hitting force. Granted, energy is required to carry out a striking action, but the two are completely different concepts altogether. "MONSTER STRIKE" refers to a great action, whereas "MONSTER ENERGY" speaks of huge potential.

70 Overall, I find the marks to be conceptually more dissimilar than similar.

Conclusion on marks similarity

71 The Opponent's case on marks similarity hinged on the contention that "MONSTER" is the distinctive and dominant portion of both marks. I have rejected this submission for the reasons set out above. Having assessed the marks visually, aurally, and conceptually, I find that the marks are more dissimilar than similar overall.

My conclusion that "MONSTER ENERGY" (T0813668B) is overall more dissimilar than similar to "MONSTER STRIKE" applies, with the appropriate modifications, to the rest of the Opponent's Earlier Trade Marks as well, each of which is even more dissimilar to the Application Mark (albeit to differing degrees).

73 Consequently, the opposition under Section 8(2)(b) TMA fails at this first step. Although my conclusion that the competing marks are more dissimilar than similar means that I am not required to go on to the next step, I will do so for completeness and in case I am wrong on marks similarity.

Second step: whether the goods/services are similar?

¹⁴ Applicant's Written Submissions at [23].

The second step is to compare the goods and services for which registration is sought as against the goods for which the Opponent's earlier trade mark "MONSTER ENERGY" (T0813668B) is registered.

To It is undisputed that in assessing the similarity of goods and services, I should have regard to the factors, or guidelines, set out in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 at 296 (*"British Sugar"*). They are as follows:

- a. the respective uses of the respective goods or services;
- b. the respective users of the respective goods or services;
- c. the physical nature of the goods or acts of service;
- d. the respective trade channels through which the goods or services reach the market;
- e. in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- f. the extent to which the respective goods or services are competitive, including how the trade classifies them.

The *British Sugar* guidelines (or factors) been looked to and applied in a number of local cases. In *Staywell*, the Court of Appeal stated that some of these factors would be relevant at the goods-similarity stage of the inquiry, in particular the consideration of the uses and end-users of the services (or, in this case, goods as well). The question is how the services (or goods) are regarded, for the purposes of trade. (See *Staywell* at [43].)

"MONSTER ENERGY"	"MONSTER STRIKE"
(T0813668B)	(40201506548Y)
(Goods)	(Goods / Services)
Class 9	<u>Class 9</u>
Protective clothing; protective footwear; protective headwear; protective eyewear; all included in Class 9.	Downloadable computer game programs; downloadable programs for personal computers; downloadable computer program for smart phones; downloadable computer programs for cellular phones; downloadable computer game programs for hand-held games with liquid crystal displays; downloadable arcade video game programs; downloadable consumer video game programs; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for personal computers; electronic circuits, magnetic disks, optical

77 I now set out the respective goods and services in table form below.

disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for smart phones; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for cellular computers; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD- ROMs, DVD-ROMs and other data media, all featuring recorded programs for hand-held games with liquid crystal displays; electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media, all featuring recorded programs for consumer video game programs; electronic machines, apparatus and their parts; telecommunication machines and apparatus; straps, covers, earphone jack and other accessories for cellular phones and tablet computers; stylus pen for telecommunication machines and electronic machines; downloadable image files; downloadable music files; downloadable character data; electronic publications (including also downloadable and recorded in electronic circuits, magnetic disks, optical disks, ROM cartridges, CD-ROMs, DVD-ROMs and other data media).
Note: Mark is not applied for in Classes 16, 18 and 25
<u>Class 41</u> Providing non-downloadable video games using communication by an electronic computer terminal, and

downloadable video games using communication by a PDA, and consultation and providing thereof; providing non- downloadable video games via a smart phone, and consultation and providing information thereof; providing non- downloadable video game using communication by hand-held games with liquid crystal displays, and consultation and providing information thereof; providing non-downloadable games for consumer video games and arcade video games via Internet, and consultation and providing information thereof; providing non-downloadable games via on-line, and consultation and providing information thereof; providing information about providing video games; providing amusement facilities; providing electronic publications about video games; providing electronic publications, and providing information thereof; services of reference libraries for literature and documentary records; providing images, motion pictures, music and audio materials via on-line, and consultation and providing information thereof; providing images, motion pictures, music and audio materials using communication by a PDA, and consultation and providing information thereof; movie showing, movie film production, or movie film distribution; presentation of live show performances; direction or presentation of plays; presentation of musical performances; production of videotape film in the field of education, culture, entertainment or sports [not for movies or television programs and not for advertising or publicity]; organization, arranging and conducting an event about video games; organization of entertainment events
publicity]; organization, arranging and conducting an event

78 It is plain and obvious from a straightforward comparison of the respective goods/services that they are dissimilar. But I must elaborate a little further.

a. I start with the Applicant's goods in Class 9, since here the respective goods are in the same class. Just because the goods are in the same class does not make them similar: it all depends on the actual specifications. Here, the Application Mark is sought to be registered for a variety of goods in Class 9 which can broadly be described as computer and mobile game software, and related accessories and hardware. On the other hand, the Opponent's "MONSTER ENERGY" (T0813668B) is registered in Class 9 respect of protective clothing, protective footwear, protective headwear and protective eyewear. To my mind, the uses are different, the users are different, and the physical nature of the goods are different. The trade channels through which they would reach consumers would also be different. The goods are not at all in competition with one another. As for the Opponent's goods in Classes 16, 18, and 25, they are also dissimilar to the Applicant's goods in Class 9.

- b. Turning to Class 41, the Applicant Mark is sought to be registered in this class for a variety of services, including the service of providing video games through various media. I do not need to examine each of them in detail because none of them are even remotely similar to the goods in Classes 9, 16, 18 and 25 for which the Opponent's mark "MONSTER ENERGY" (T0813668B) is registered. By this, I am not suggesting that goods can never be similar to services. Rather, what I am saying is that a finding of similarity cannot be made between the respective goods and services on the present facts.
- 79 I now address the Opponent's submissions on this issue.

The respective users of the respective goods or services

80 In advancing the submission that the respective goods or services are similar, the Opponent focused on Class 9 and contended that the users of the goods in this class (*viz.* protective clothing, footwear, headwear and eyewear) would primarily consist of "*young adults aged 18 to 34 years old, who are primarily males*". It was then submitted that this demographic of the public in Singapore would "*likely be the respective users of the Class 9 goods and services for which the Application Mark is sought to be registered (i.e. computer game programs video games and related entertainment goods".*¹⁵

81 With respect, this argument misses the woods for the trees.

In *Staywell* the Court of Appeal emphasised that registration of a trade mark confers the exclusive right on the proprietor to use the mark not only for the goods and services which he might actually have contemplated at the time registration was granted, but also for the whole spectrum of goods and services within the specification for which the mark is registered (or a penumbra of notional fair uses). For this reason, in opposition proceedings the inquiry must take into account the actual and notional fair uses of the opponent's mark and compare them against the full range of such rights sought by the applicant by reference to the applicant's actual use of the mark (if any) as well as notional fair uses to which the applicant may put his mark should registration be granted. (See *Staywell* at [58] - [60].)

83 Although the abovementioned statements were made by the Court of Appeal in the context of the likelihood of confusion assessment, they are nonetheless applicable here.

a. <u>"MONSTER ENERGY" (Class 9)</u>: While it is true that men aged 18 to 34 years old would form part of the end-users of protective clothing, footwear, headwear and eyewear, there is no reason why women and men of any other age cannot be the end-users of such products. The Opponent may have chosen to market itself to a specific segment of the public, but in reality the end users of the goods as set out in the specification cannot be restricted as such. (Surely the Opponent cannot be suggesting that women are not end users of protective gear?)

¹⁵ Opponent's Written Submissions at [62].

b. <u>"MONSTER STRIKE" (Class 9)</u>: It also cannot be said that men aged 18 to 34 would be the primary end users of the goods for which registration is sought by the Applicant in Class 9. These are goods that are used by all and sundry. Common experience would inform that with the ubiquity of cell phones and easy access to a plethora of downloadable mobile game applications, men, women, and children of all ages in Singapore can be seen "glued to their screens", so to speak. And it would not be surprising if at least some of them were engaged in playing one mobile game or another.

For goods that are not specialised and can be used by any segment of the market, when one drills down into the minute details, one will always be able to find some commonality in the users here and there. But that does not mean that the goods are therefore similar. Moreover, even if there is some small overlap in the users, on these specific facts, this factor is outweighed by the other factors in the *British Sugar* guidelines.

The respective trade channels

85 It was argued by the Opponent that it is not uncommon for goods for which the Opponent's "MONSTER ENERGY" mark is registered in Class 9 to be distributed or sold at events which feature the goods and services for which the Application Mark is sought to be registered in Class 9.¹⁶ As an example of this, the Opponent pointed to the fact that its marketing strategy is to distribute apparel and merchandise bearing various "MONSTER" trade marks at retail outlets (and to be given free at events). According to the Opponent, due to its involvement in the sponsorship of E-Sports, competitions, video games and computer gaming festivals, there is a likelihood that the respective trade channels would be the same.

86 I am not persuaded by this submission.

87 The Opponent may have executed its marketing strategy in a way that takes aim at its core target audience and cuts across trade channels. But, it does not follow that the usual trade channels for the products in question are therefore the same or similar. Taking a step back, one could expect to purchase protective gear in a sports shop, or a speciality store. On the other hand, the goods for which the Application Mark is sought to be registered would be obtained either through downloads from the internet or purchased in electronics or computer stores. Even from the e-commerce perspective (*i.e.* where one makes purchases from a website) I have no doubt that the respective goods would be categorised differently.

Conclusion on similarity of goods/services

88 For the reasons set out above, I have no trouble arriving at the conclusion that the respective goods/services are dissimilar to a substantial degree. With the exception of Class 9, the goods and services are not even in the same classes. As for Class 9, the specification of the respective goods are obviously different.

¹⁶ Opponent's Written Submissions at [63] – [64].

89 Although I have undertaken the analysis above in relation to the "MONSTER



ENERGY" (T0813668B), for completeness, I should mention that save for "**MUNTER**," (T0813672J), which is also registered in Classes 9, 16, 18 and 25 for the same goods as "MONSTER ENERGY" (T0813668B), the rest of the Opponent's Earlier Trade Marks are not registered in the same class as the classes for which the Application Mark is applied for and in each case there is no similarity of goods/services.

90 Thus, even if I am wrong on marks similarity, given my conclusion that the goods/services are dissimilar to a substantial degree, the opposition under Section 8(2)(b) TMA will fail at this second step.

Third step: is there a likelihood of confusion?

91 There are at least two specific aspects to the element of likelihood of confusion. The first is mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods bearing the two marks emanate from the same source or from sources that are economically linked or associated. (*Caesarstone* at [57]; *Hai Tong* at [74].)

92 But whatever the case may be, the only relevant type of confusion for the purposes of grounding an opposition action is that which is brought about by the similarity between the competing marks *and* the similarity (or identity) between the respective goods and services in question. (*Staywell* at [15].)

Above, I have found the marks to be more dissimilar than similar; and the respective goods and services to be dissimilar to a substantial degree. In the circumstances, the issue of likelihood of confusion does not arise because the opposition under Section 8(2)(b) TMA fails at the first step, and even if I am wrong, it will fail at the second step .

I decline to undertake a hypothetical analysis on likelihood of confusion because the extent to which: (a) the marks are similar; and (b) the goods and services are similar, *both* have an impact on the likelihood of confusion assessment and it would be impractical and artificial to examine each degree of similarity in the alternative. Moreover, this is a case where the respective goods and services are simply too distant and in such circumstances the likelihood of confusion would be far more illusory than real.

A "MONSTER" family of marks?

Nevertheless, given that the "MONSTER" family of marks submission was a focal point for the Opponent's case, I will make some observations.

I begin by outlining briefly how the family of marks doctrine operates. The IPOS Trade Mark Registry's Trade Mark Work Manual, Version 4 (November 2015), under Chapter 7 for "Relative Grounds for Refusal of Registration" (at p 38) helpfully fleshes out the key points, and I reproduce the relevant part below:

"Where a number of similar marks in the same ownership incorporate an identical element as a family of marks and another party also applies for registration of a mark incorporating that element, the public may assume that the new mark originates from the same undertaking as an addition to the family of marks and be confused or deceived if that is not the case."

97 In *Lacoste v Carolina Herrera, Ltd* [2014] SGIPOS 3 ("*Lacoste*"), an earlier decision of this tribunal, the learned Assistant Registrar had occasion to consider whether certain earlier marks could be considered to be a family or a series of marks. After examining a number of EU, UK and local authorities, she summarised the general principles as follows.

- a. *Prima facie*, registration of a number of marks each bearing the same element in common, does not automatically give rise to the presumption that the consumer would perceived them as being a family or series of marks, such that the registered proprietor of the marks is entitled to have protection of that common element. The registered proprietor who claims additional protection of that common element will have to adduce sufficient evidence to show use of a sufficient number of these marks as to be capable of constituting a family or series of trade marks, for the purposes of the assessment of the likelihood of confusion. (*Lacoste* at [38].)
- b. When deciding whether a family or series of marks is in existence in the market place, the relevant audience to consider is the consumer or the public. This follows from the principle that at the end of the day the query goes towards establishing whether there is a likelihood of confusion as a result of the applicant's use of a common element in the registered proprietor's trade marks. (*Lacoste* at [39].)

According to the Opponent, the evidence shows that there is a "MONSTER" family or series of marks, and this factors into the likelihood of confusion analysis in that it: (a) adds to the reputation of the Opponent's Earlier Trade Marks; and (b) increases and exacerbates the likelihood of confusion given the possibility of imperfect recollection by the consumer.¹⁷

As touched on briefly above at [15], the Applicant did not dispute that the family of marks doctrine applies in Singapore. It also accepted, in principle, that a family or series of marks *could* be taken into account in the likelihood of confusion element (although not

¹⁷ Opponent's Written Submissions at [69] – [72].

in the similarity of marks comparison). However, it strenuously resisted the notion that on the evidence, consumers in Singapore would have regarded the Opponent's Earlier Trade Marks or in particular the sign "MONSTER" as being a family or series of marks. The Applicant's submissions concerning the evidence were presented along two lines.

- a. First,¹⁸ the Opponent is not the only company that uses "MONSTER". My attention was drawn to the evidence concerning the state of the register and the various trade mark applications and registrations in Classes 9 and 41 which contained the word "MONSTER" or a representation of a monster.¹⁹ This showed, in the Applicant's submission, that the public is accustomed to seeing MONSTER-formative marks belonging to various proprietors.
- b. Second, ²⁰ the evidence shows that "MONSTER ENERGY" consistently appears not as the plain word mark but rather in stylised form and accompanied by the "M" claw device, as follows:



100 Both lines of attack are sides of the same coin: in essence, the Applicant's case was that the plain "MONSTER" was not distinctive of the Opponent. As such, when consumers in Singapore encounter the Application Mark, they would *not* be confused or deceived into believing that the Application Mark is one that belongs to or is part of, the Opponent's family or series of marks.

The state of the Trade Marks Register

101 I begin with the evidence relating to the Trade Marks Register.

102 The Applicant tendered a printout of a search of the Trade Marks Register in Class 9 and 41 for any word or image that contains the word "monster" (see KK-SD at [44] and Exhibit KK-6). It shows that there various registrations for "MONSTER" formative marks in Classes 9 and 41 owned by entities that are not related to the Opponent. Some of them pre-date the Opponent's Earlier Trade Marks in Class 9. The following are just some examples: "MONSTER CENTRAL", "MONSTER COMPUTER", "MONSTER POWER", "MONSTER QUEST", "MONSTER WORLD", "MONSTER ROCK", and "MONSTER HUNTER".

¹⁸ Applicant's Written Submissions at [37].

¹⁹ KK-SD at Exhibit KK-6.

²⁰ Applicant's Written Submissions at [34].

103 Evidence relating to the state of the register may, in certain circumstances, be relevant. However, in cases like this, it usually does not carry the matter much further. In British Sugar both parties entreated the court to have regard to certain registered marks which consisted of or incorporated the word "treat". Jacob J declined to do so, stating (at 305) that:

"... I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register."

104 Here, the fact that a number of other traders have registered various trade marks containing "MONSTER" in Classes 9 and 41 does not, in and of itself, negate the Opponent's argument that it has a "MONSTER" family of marks. Conversely, the fact that the Opponent has a number of trade mark registrations in various classes (including Class 9) containing "MONSTER" (viz. the Opponent's Earlier Trade Marks) does not necessarily assist the Opponent's case either.

105 But the state of the register is not wholly irrelevant either. Against that backdrop, I am reminded that unless there is sufficient evidence of use of "MONSTER" (by itself) in the course of trade by the Opponent, in relation to the relevant goods and/or services, I should be slow to find that that element as being or comprising a family or series of trade marks for the purposes of the likelihood of confusion assessment.

The Opponent's evidence of use

106 And so I come to the next question: is there is sufficient evidence of use to support a finding of a "MONSTER" family of marks?

107 I will go through the Opponent's evidence of use in greater detail when I address the "well known" grounds of opposition (viz. Section 8(4)(b)(i), 8(4)(b)(ii)(A), and 8(4)(b)(ii)(B) TMA) below.²¹ It suffices to make the following observations here.

a. The Opponent's evidence shows that what has been widely used, advertised and promoted is *not* the plain word mark "MONSTER" but rather the claw device " as well as the composite mark represented below:

²¹ The reason I do not set it out here in full is that I have already come to the conclusion that the opposition under Section 8(2)(b) TMA fails. Thus it is more meaningful to deal with the evidence of use in those other grounds of opposition.

- b. The above composite mark is used in relation to the Opponent's energy drinks. The Opponent's energy drinks come in large cans, and each of them bears the claw device " III" as well as the stylised "MONSTER" 22
- c. The Opponent engaged in what it describes as an unconventional marketing strategy. It focused on endorsements and sponsorships of activities ranging from (extreme) sports and atheletic events, competitions, music festivals and musicians and even video games. Although there is a great deal of evidence in this vein, I was unable to locate any instance where the plain word "MONSTER" appeared alone (i.e. not in "MUNSTER" stylised form). On the other hand, in certain instances the claw device "III" appears alone.

d. Critically, all of the Opponent's advertising, marketing, and promotional efforts were directed back to its energy drinks. As far as the evidence goes, the Opponent has never traded in any goods or engaged in the provision of any services in Classes 9 or 41 for which the Application Mark is sought to be registered.

108 Ultimately, I am not persuaded that there is sufficient evidence of use so as to be capable of constituting a "MONSTER" family or series of marks for the purposes of the assessment of the likelihood of confusion in this case. If the Applicant was applying to register the Application Mark for energy drinks, I could see how it could be arguable that there exists a "MUNTER" family of marks which should be taken into account. (Although, of course, the earlier relevant trade marks in such a case would presumably be those registered in Class 32.) But the instant case is simply too far removed.

Opposition under Sections 8(4)(b)(i), 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B) TMA

109 Section 8(4) TMA provides that:

"(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if -

(a) the earlier trade mark is well known in Singapore; and

²² RCS-SD at [30] and Exhibit RCS-2.

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or

(ii) if the earlier trade mark is well known to the public at large in Singapore —

- (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
- (B) would take unfair advantage of the distinctive character of the earlier trade mark."

110 As it can be seen from the above, there are three sub-grounds of opposition within Section 8(4) TMA, namely: 8(4)(b)(i); 8(4)(b)(i)(A); and 8(4)(b)(ii)(B). Two elements are common to all three sub-grounds.

- a. First, the whole or essential part of the later trade mark must be shown to be identical with or similar to the earlier trade mark.
- b. Second, the earlier trade mark must be shown to be well known in Singapore. (Although Section 8(4)(b)(ii)(A)-(B) TMA concerns marks that are *well known* to the public at large in Singapore, it goes without saying that a mark that is not well known in Singapore cannot be well known to the public at large in Singapore.)

If either (or both) of these elements cannot be established, the opposition under all three sub-grounds of Section 8(4) TMA will fail.

Similarity of marks?

111 The earlier trade mark that the Opponent relied on for the purposes of all sub-grounds of Section 8(4) TMA is "MONSTER ENERGY".²³ This is the same mark I have found to be overall more dissimilar than similar to the Application Mark under the Section 8(2)(b) TMA ground of opposition.

112 There is no material difference between the similarity of marks enquiry under Section 8(2)(b) TMA as compared to Section 8(4) TMA. Accordingly, the opposition under all three sub-grounds of Section 8(4) TMA fails.

Whether "MONSTER ENERGY" was well known in Singapore?

113 For completeness and in case I am wrong on marks similarity, I will deal with the further issue of whether "MONSTER ENERGY" is well known in Singapore.

²³ Opponent's Written Submissions at [87], [88] and [121].

114 As to what constitutes a "well known trade mark", the relevant part of Section 2(1) TMA states:

···2.—(1)

•••

"well known trade mark" means —

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore"

Here I only need concern myself with the (a) limb because the Opponent has relied on the *registered trade mark* "MONSTER ENERGY".

115 Sections 2(7) to 2(9) TMA are the starting point in the assessment of whether a trade mark is "well known in Singapore". They provide:

"(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of —

(i) any use of the trade mark; or

(ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;

(c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;

(d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;

(e) any value associated with the trade mark.

(8) Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

(9) In subsections (7) and (8), "relevant sector of the public in Singapore" includes any of the following:

(a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;

(b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;

(c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied."

116 In Novelty Pte Ltd v Amanresorts Ltd and anor [2009] 3 SLR(R) 216 ("Amanresorts"), the Court of Appeal held (at [137] and [139] – [140]) that the factors in Section 2(7) TMA are not exhaustive. A court (or tribunal) is ordinarily free to disregard any or all of the factors as the case requires – except for Section 2(7)(a) TMA – and to take additional factors into consideration. That said, Section 2(7)(a) TMA has been described as "arguably the most crucial factor when determining whether a trade mark is well known in Singapore". This is because of the deeming provision in Section 2(8) TMA which provides that once a trade mark has been found to be well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore. (Amanresorts at [139].)

117 For a time, there were some who interpreted the Court of Appeal's observation in *Amanresorts* at [229] that: "... *it will be recalled that it is not too difficult for a trade mark to be regarded as "well known in Singapore*"" as standing for the broader proposition that the threshold for a trade mark to be regarded as well known in Singapore was relatively low. In *Caesarstone*, the Court of Appeal took pains to clarify that this is not the case:

"102 We do not think that this comment in *Amanresorts* was made to lay down a general principle. In this regard, we agree with the Respondent's submission that the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be *any* relevant sector of the Singaporean public, and this sector need not be large in size. Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one."

- 118 I now turn to address two issues.
 - a. First, what is the relevant sector of the public in this case?
 - b. Second, was the Opponent's registered "MONSTER ENERGY" trade mark well known to that relevant sector of the public?

The relevant sector of the public in this case

119 When identifying the relevant sector of the public, I must look at the actual and/or potential consumers of the goods the Opponent offers and not consumers of everything that may fall under the type of goods or services to which the Opponent's mark is applied. (See

Section 2(9)(a) TMA; *Amanresorts* at [142] – [152]; and *Alphasonics* (*Ultrasonic Cleaning Systems*) *Ltd.* v *Alphasonics* (*Pte*) *Ltd.* [2013] SGIPOS 6 at [31]).

120 In the Opponent's submission, the relevant public in this case would "*include actual and potential consumers of*, inter alia, *beverages, energy drinks, as well as participants of computer gaming events and festivals*".²⁴ As for the Applicant, while it agreed that the relevant public would include actual and potential consumers of beverages and energy drinks in Singapore,²⁵ it was not clear that it would have accepted that participants of computer gaming events and festivals should be included within this category.

121 The evidence shows that the Opponent's trade marks are no stranger to the video gaming world.

- a. Mr Sacks' evidence was that the Opponent sponsors e-sports teams such as Evil Geniuses (since 2011), The Alliance (since 2013), and Team EnVyUs (since 2014). Other teams were named but they were sponsored after the relevant date of 23 June 2014. It was also Mr Sacks' evidence that these teams carry its trade marks on their uniforms and there is a can of its energy drink by their keyboards (see RCS-SD2 at [13] [14]). There was also a photograph provided in RCS-SD2 at [13] that appears to have been taken 2017 during a "HALO" video game competition. Pictured in that photograph is a person in front of a computer screen wearing jacket or shirt bearing a number of signs. Although partially obscured by the computer screen, I can make out what appears to be the Opponent's device """ as well as the stylised "MINSTER." While I am mindful that 2017 would be after the relevant date, it is nevertheless reasonable to conclude that the other sponsored teams would have worn apparel (prior to the relevant date) during e-sports competitions that displayed the Opponent's device that the other sponsored teams would have worn apparel (prior to the relevant date) during e-sports competitions that displayed the Opponent's device that the other sponsored teams would have worn apparel (prior to the relevant date) during e-sports competitions that displayed the Opponent's device that the other sponsored teams would have worn apparel (prior to the relevant date) during e-sports competitions that displayed the Opponent's device that the other sponsored teams would have worn apparel (prior to the relevant date) during e-sports competitions that displayed the Opponent's device that the other sponsored teams would have worn apparel (prior to the relevant date) during e-sports competitions that displayed the Opponent's device that the other sponsored teams would have worn apparel (prior to the relevant date) during e-sports competitions that displayed the Opponent's device that the other sponsored teams would have worn apparel (prior to
- b. It was also Mr Sacks' evidence that the Opponent's trade marks have appeared in the game environment of various racing games such as "Need for Speed – SHIFT 2 UNLEASED" (a car racing video game where players can drive a 2011 Ford Mustang bearing the Opponent's trade marks); "Skate 2" and "Skate 3" (skateboarding video games where the Opponent's trade marks are featured on ramps and billboards); and "Dirt 2", "Dirt 3" and "Dirt Showdown" (rally car video racing games where the physical packaging of the game, as well as the physical disk, featured a rally car bearing the Opponent's trade marks). (See RCS-SD1 at [159] – [162].)
- c. Evidence was also provided by Mr Sacks relating to cross-promotional activity in respect of the popular Call of Duty franchise (see RCS-SD1 at [163(a)-(e)]) and also the "Aliens – Colonial Marines" video game where players could, if they so wished, obtain a code that allowed their in-game avatar to wear armour

trade marks in a similar fashion.

²⁴ Opponent's Written Submissions at [129].

²⁵ Applicant's Written Submissions at [48] referencing RCS-SD1 at [3] – [5].

bearing the Opponent's trade marks. (See RCS-SD1 at [163(d)] and printout at Exhibit RCS-46.)

d. According to Mr Sacks, the Opponent has also been involved in entertainment fairs and festivals such as the 2012 Animation-Comic-Game (ACG) entertainment fair in Hong Kong. During the course of that 5 day event, the samples of the Opponent's energy drinks were distributed to attendees. (See RCS-SD1 at [163(e)] and Exhibit RCS-47.)

122 Be that as it may, there is no evidence that the Opponent actually sold or traded in computers or parts or indeed any "tech" product. Neither is there evidence that it produced and sold video games. There is also no evidence that it was engaged in the provision of services in this field (or at all). Ultimately, all of its advertising, sponsorships, and other marketing activities comes back to one thing and one thing only: energy drinks.

123 In my view, because energy drinks are not a specialised good by nature, some of the actual and potential consumers of energy drinks would also be gamers, or attendees of computer gaming events and festivals. It is reasonable to extrapolate that gamers engaged in long marathon gaming sessions may wish to maintain their alertness and thus consume the Opponent's energy drinks. That is likely why the Opponent targets this demographic in the first place.

124 But it does not follow that participants of computer gaming events and festivals *in general* are *therefore* the actual and potential consumers of the Opponent's goods. In my judgment, the relevant sector of the public for the purposes of the assessment would be the actual and potential consumers of energy drinks in Singapore (although some of them would also be participants of computer gaming events and festivals).

Was "MONSTER ENERGY" well known to the relevant sector of the public?

125 In the paragraphs that follow, I examine the Opponent's evidence by reference to the broad categories in which they fall. As the documents are voluminous, I do not propose to go through each of them in detail. Instead, I set out the more salient points which are integral to my conclusion: that "MONSTER ENERGY" in plain word mark form was *not* well known to the relevant sector of the public (being actual and potential consumers of energy drinks) as at the relevant date.

Design of the Opponent's energy drink cans

126 The Opponent's energy drinks are sold in cans. Apart from the obvious function of acting as a container for and protecting the liquid within until such time as it is consumed, drink cans also serve a function from a branding perspective. For it is on every drink can that the trader's trade mark is placed. Thirsty (or perhaps, in the case of energy drinks: tired) would-be consumers are faced with an array of choices even as they approach the shelves or refrigerator. Should they pick this energy drink or the other? And they make their choices primarily by reference to the trade marks that are present on each can. That is

the indicator of origin; the means by which consumers recognise and are assured that this drink that they have in their hand comes from a certain trader. Without the trade mark emblazoned on each can, consumers would not know what exactly it is they are purchasing.

127 And so it is of great importance that I examine what appears on each of the cans of the Opponent's energy drinks. There is, of course, evidence on this. From the evidence I can see that for the Opponent's core product offering (which Mr Sacks referred to in his SDs simply as "MONSTER ENERGY"), what one would see is *not* the plain word mark "MONSTER ENERGY" but rather the following composite mark displayed prominently on each can:



128 Aside from the core "MONSTER ENERGY" product offering referred to above, the Opponent also sold three other lines of energy drinks in Singapore, "MONSTER ENERGY ABSOLUTELY ZERO", "MONSTER ENERGY EXPORT" and "MONSTER KHAOS".²⁶ From the localised segment of the Opponent's website, located at the following link: <u>http://www.monsterenergy.com/sg/en/products/</u>, it can be seen that the claw device and the word "ENERGY" on the cans of "MONSTER ENERGY" appear in green whereas "Absolutely Zero" bears a blue colour scheme and "Khaos" an orange colour scheme.²⁷

a. Extract from Opponent's localised website (RCS-SD1, Exhibit RCS-2 at p 609)



²⁶ RCS-SD1 at [30].

²⁷ Exhibit RCS-2. Larger, clearer photographs of each of these cans can be also found at Exhibit RCS-45. It also appears that the design of the "Absolutely Zero" range has changed over time: compare the website extract with the illustration of "Absolutely Zero" at Exhibit RCS-45 at p 1050.



b. Extract from Opponent's photographs (RCS-SD1, Exhibit RCS-45 at p 1056)²⁸



129 It is one thing to describe the goods as "MONSTER ENERGY", but how they are actually marketed and sold is another matter. And from the evidence, although there were minor variations for each product range, each drink can invariably bears the claw device "

"and the words "MONSTER ENERGY" always appear as "MONSTER ENERGY". The words "MONSTER ENERGY" in plain font are nowhere to be seen.

130 For the avoidance of doubt, I am by no means suggesting that the Opponent did not use the plain word mark "MONSTER ENERGY". Of course it did so at certain points, including on its website (see [128(a)] above). But, as far as I can tell, it did not use the plain word mark "MONSTER ENERGY" on the actual energy drink cans themselves.

131 Importantly, on each energy drink can, the word "ENERGY" appears much smaller in size as compared to the stylised **MONSTER**. And in the case of the "Khaos" line of beverages, the words "ENERGY+ JUICE" appear which suggests that "ENERGY" (like "JUICE") serves a descriptive purpose (see [128(b)] above). Although there does not appear to be evidence from consumers in Singapore on the specific point, *because of* the way the drink cans are designed, it seems more likely than not that consumers would refer to the Opponent's energy drinks as "MONSTER" energy drinks rather than "MONSTER ENERGY" energy drinks. After all, "ENERGY" is descriptive of energy drinks and the Opponent appears to have used "ENERGY" to designate a particular product line to distinguish it from its other product lines (such as "Khaos").

²⁸ I am aware, of course, that this is supposed to be a "sticker" but I have no doubt that this design reflects what the product looks like in reality.

Sales of the Opponent's energy drinks in Singapore

132 The Opponent's local subsidiary in Singapore is Monster Energy Singapore Pte Ltd. This company sold the Opponent's energy drinks to the Opponent's local distributor: Pacific Beverage Pte Ltd.

133 Monster Energy Singapore Pte Ltd's invoices issued to Pacific Beverage Pte Ltd each MANSTER Enerby

bore a variant of the claw device and stylised "MONSTER", as follows: ²⁹ Similarly, at the bottom of Pacific Beverage Pte Ltd's Goods Receipt Note indicating receipt of the Opponent's goods on 24 November 2014 the same mark appeared, indicating that this is one of the brands which the former distributed.³⁰ Although the goods were referred to in these documents as "MONSTER ENERGY" or "Monster Energy Regular", this is not unusual given the nature of these documents (invoices and documents acknowledging receipt of goods). The point here is that the Opponent's local subsidiary

took the step of placing "

" on each of its invoices.

134 The Applicant criticised the lack of evidence proving that the Opponent's goods were indeed sold at retail stores, gas stations and other outlets.³¹ In this connection, it argued that the Opponent could have tendered photographs of retail displays, or invoices issued by Pacific Beverages Pte. Ltd. to local retail outlets in evidence, but did not do so. Although I agree with the Applicant that there are gaps in the evidence, I do not think that this criticism carries the matter much further in either direction.

135 Instead, I would focus on the various invoices issued by Monster Energy Singapore to Pacific Beverage Pte Ltd, the latter's receipt notes, and shipping documents such as Sea Waybills (issued by Blue Anchor Line).³² When taken together, they show that a sizeable quantity of the Opponent's energy drinks have been imported into Singapore since 2012.

136 This squares with Mr Sacks' sworn evidence that since launch in Singapore in October 2012 through 31 March 2016, the Opponent has sold more than 4.7 million cans of its energy drinks, amounting to sales of approximately US\$ 4.2 million.³³ Without evidence relating to what the size of the energy drinks market is in Singapore in general, it is difficult to put these numbers into perspective. But at the very least it shows there was (as at the relevant date of 23 June 2014) a sizeable market for the Opponent's energy drinks in Singapore.

²⁹ RCS-SD1 at Exhibit RCS-3, pp 612 – 616, 625 – 627.

³⁰ RCS-SD1 at Exhibit RCS-3 at p 617.

³¹ Applicant's Written Submissions at [53].

³² RCS-SD1 at Exhibit RCS-3.

³³ RCS-SD1 at [30].

137 It is here that I return to my earlier point above: because each of the Opponent's energy drink cans do not bear the plain words "MONSTER ENERGY" but instead are



marketed as "MONSTER" (and in certain cases with the word "ENERGY" substituted by or used in conjunction with "KHAOS" or "ABSOLUTELY ZERO" or "EXPORT"), I am inexorably led to the conclusion that "MONSTER ENERGY" as a plain word mark would not have been "known to or recognised by any relevant sector of the public" as at the relevant date.

138 An argument could certainly be made that the composite stylised mark with the claw device was well known to the relevant sector in Singapore. But that is not the case that the Opponent has advanced, and for obvious reason: it bears precious little similarity (if any) to the Applicant's plain "MONSTER STRIKE" mark.

Sponsorships and endorsements of athletes, teams and sporting events

139 I note that the Opponent adopts a somewhat unconventional approach to marketing. By its own admission, the Opponent did not use direct television or radio advertising in the traditional sense. Instead, its marketing strategy involved indirect advertising through athlete endorsements and sponsorships for athletic competitions, sports teams, and other events, which may be webcast over the internet and on television.

140 Mr Sacks, in his first SD, gave a number of reasons for this approach, including that the Opponent is interested in cultivating a specific image of being "edgy and aggressive" or "extreme".³⁴ I understand from his evidence that this is designed to be appealing to the Opponent's primary target market of young adults, primarily male, aged 18 to 34 years old. (Although, by its own assessment, the demographic of its consumers has now grown to include more females and older persons.)³⁵

141 There is no need to name all of the athletes and individuals that the Opponent has sponsored.³⁶ It suffices to give a few examples: Formula One racers Michael Schumacher (March 2010 to 2012) and Jenson Button (2009), Supercross and Motocross racer Ricky Carmichael (January 2006 onwards), and rally car driver Ken Block (since 2007).

142 How do these endorsements and sponsorships work? In exchange for its money, the Opponent gains exposure for its trade marks, which are prominently displayed on banners, posters, accessories, and various signage.³⁷ To give some other examples, the Opponent's

³⁴ RCS-SD1 at [37].

³⁵ RCS-SD1 at [37].

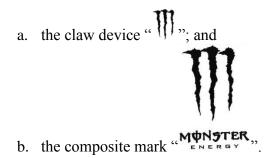
³⁶ RCS-SD1 at [108] – [128].

³⁷ RCS-SD1 at [44], [48] and Exhibit RCS-5.

trade marks appear on apparel worn by sponsored athletes (e.g. sporting gear³⁸ and caps³⁹), and on helmets and racing suits of drivers of Formula One racing cars.⁴⁰ The Opponent's trade marks also appear on decals on the body of racing rally cars⁴¹ and motorbikes.⁴²

143 In addition, at events, the Opponent offers samples of its energy drinks and gives out merchandise bearing its trade marks. According to Mr Sacks, between 2012 to 2015, over 273,768 sample 473mL cans of the Opponent's energy drinks were distributed to consumers in Singapore, mainly at sporting and music events.⁴³ There are also photographs in evidence where the individuals sponsored by the Opponent are pictured with a can of the Opponent's energy drink nearby.⁴⁴

144 What is of paramount importance, however, is that in all of these modes of marketing and exposure, there are only two trade marks that appear. They are:



In other words, the trade mark: "MONSTER," never appears without the claw device, and in any case "MONSTER ENERGY" never appears in plain word mark form.

145 Evidence was tendered that apart from Formula One racing (where the Opponent has sponsored the MERCEDES AMG PETRONAS F1 Team since March 2010),⁴⁵ the Opponent was also involved in sponsoring a team, an individual, or the actual event for the following (where available, the date of the Opponent's first involvement as sponsor is listed as well):

- a. MotoGP (involvement since 2007), a motorcycle racing world championship;⁴⁶
- b. FIM Motocross World Championship;⁴⁷

³⁸ RCS-SD1 at [37] and Exhibit RCS-4.

³⁹ Exhibit RCS-4 at p 634.

⁴⁰ Exhibit RCS-7 generally.

⁴¹ Exhibit RCS-4 at p 636.

⁴² Exhibit RCS-6 generally.

⁴³ RCS-SD1 at [49].

⁴⁴ RCS-SD1 at Exhibit RCS-24, p 883.

⁴⁵ RCS-SD1 at [51] – [61].

⁴⁶ RCS-SD1 at [62] – [69], [129] – [133], and Exhibit RCS-8.

⁴⁷ RCS-SD1 at [70] and [134].

- c. Asian X Games / Kia World Extreme Games (involvement since 2012);⁴⁸
- d. Ultimate Fighting Championship, a mixed martial arts competition more commonly known as "UFC" (involvement since 2015);⁴⁹
- e. Dakar Rally (involvement on various dates, as far back as 2007);⁵⁰
- f. X Games, which are extreme sporting events (involvement as presenting sponsor from 2014 onwards);⁵¹
- g. MONSTER ENERGY AMA Supercross Series, an off-road motorcycle racing event (involvement as title sponsor since 2008);⁵²
- h. MONSTER ENERGY Pipeline Pro, a surfing event in Hawaii (involvement between 2005 to 2009);⁵³
- i. the Billabong XXL Wave Awards;⁵⁴ and
- j. an event in Singapore's Somerset Skate Park on 7 December 2013, as part of a leg of the (skating) DC South East Asia Tour.⁵⁵

However, when I sieved through the evidence, I could not find any use of "MONSTER ENERGY" in plain word mark form. Conversely, as noted above, the claw device " II" " sometimes appeared on its own.

146 To summarise the effect of the evidence on this part: given that what was extensively marketed and exposed to the world was not the plain "MONSTER ENERGY" word mark, I am unable to see how this evidence supports a finding that "MONSTER ENERGY" was well known to the relevant sector of the public in Singapore.

147 In cases where evidence of marketing, advertising and promotional efforts take place outside of Singapore, a sufficient link must be established in order to tie that evidence back to Singapore. After all, the assessment is primarily concerned with whether the trade mark(s) relied on were well known to the relevant sector of the public *in Singapore*. In the present case, some of these links were made out, whereas for others the connection was a bit more tenuous. However, I need not go into detail, given my conclusion that ultimately what was marketed and exposed was not the plain "MONSTER ENERGY" word mark.

⁴⁸ RCS-SD1 at [71] – [72].

⁴⁹ RCS-SD1 at [73] – [74].

⁵⁰ RCS-SD1 at [75] – [83] and Exhibits RCS-9 and RCS-10.

⁵¹ RCS-SD1 at [84] – [90] and Exhibits RCS-11, RCS-12 and RCS-13.

⁵² RCS-SD1 at [91] – [99] and Exhibits RCS-14 and RCS-15.

⁵³ RCS-SD1 at [100] – [104] and Exhibits RCS-16, RCS-17 and RCS-18.

⁵⁴ RCS-SD1 at [105] – [106].

⁵⁵ RCS-SD1 at [107] and Exhibit RCS-19.

Evidence relating to the internet and social media

148 I now turn to the evidence relating to the internet and social media. It is common knowledge that Singapore has one of the highest rates of internet penetration in the world, and the internet is now an inextricable part of most of our lives, especially given the ease with which we can access it through our cell phones and other electronic devices.

149 The evidence shows that the Opponent was highly active on the internet and on various social media channels such as Facebook, YouTube and Twitter.⁵⁶

- a. <u>Website</u>: There is a printout from the Opponent's localised segment of its website where the words "MONSTER ENERGY" appear in plain white font.⁵⁷ And elsewhere on that website there is a line which reads: "*use the hashtag #MONSTERENERGY*".⁵⁸ I note that the printout that is in evidence is dated July 2016, and do not place much weight on this document, but when read in light of the other documents which I will come to shortly, it seems likely that there was some use of the plain "MONSTER ENERGY" word mark on the Opponent's website prior to the relevant date. According to the Opponent, between 1 September 2010 and 1 September 2012, the website received more than 10.1 million visits, with 13,000 of them from Singapore.⁵⁹ There were also other figures provided, but I need not go into detail. The main point is that there were individuals who accessed the website from Singapore.
- b. <u>Facebook</u>: The page name of the Opponent's Facebook page is "Monster Energy". As such, every time there is a post, the words "Monster Energy" will appear. Based on the printout, the page was accessed in December 2014 (*i.e.* after the relevant date). However, I note from the timeline that the page was first created in 2008 and I very much doubt that the name of the page was something other than "Monster Energy" at the point of the relevant date. At the time the page was accessed it had more than 25 million "likes".⁶⁰
- c. <u>Twitter</u>: The handle, or account name, of the Opponent's Twitter is "Monster

T

"MONSTER,

Energy", but the profile picture is that of the composite mark: "ENERGY". Based on the printout, the page was also accessed in December 2014 (*i.e.* after the relevant date). However, I note that the account was created in August 2009

⁵⁶ RCS-SD1 at [140] – [140] and Exhibits RCS-31 to 36.

⁵⁷ Exhibit RCS-32 at p 924.

⁵⁸ Exhibit RCS-32 at p 926.

⁵⁹ RCS-SD1 at [141].

⁶⁰ RCS-SD1 at [145] and Exhibit RCS-35.

and again I find it hard to imagine that the name of the account would have been anything other than "Monster Energy" at the point of the relevant date.⁶¹

d. <u>YouTube</u>: The Opponent has various YouTube channels, but its main channel has received more than 270,000 views from Singapore to date (meaning the date of Mr Sacks' first SD), and from launch to 1 October 2012 there were more than 83,000 views from Singapore.⁶²

150 In my assessment, the Opponent's website and social media accounts do show *some* use of the plain "MONSTER ENERGY". However, there are two important qualifications that must be made.

151 First, individuals who access these pages or accounts would already be familiar with the Opponent. Even if they were not, upon navigating to or around these sites, they would

be educated of the Opponent's: " $M \oplus N \oplus TER$ ". The words "MONSTER ENERGY" may appear in certain limited cases, but always in conjunction with that stylised composite mark and/or the claw device. It is those elements that would, more likely than not, be recognised as a badge of origin designating the Opponent's goods rather than the plain "MONSTER ENERGY".

152 Second, in this day and age, as the saying goes, "content is king". And the content on the Opponent's website and social media platforms was not so much about energy drinks (although there is *some* evidence of that on the website at least) but more of sporting events, athletes and the like. I am certain that this was by design, and intended to go hand in hand with the Opponent's sponsorships and endorsements which I have discussed at length above (see [139] to [147]).

153 But it also cuts both ways, because the numerous photographs, videos and news updates concerning sponsored athletes, events and teams tell me very little about whether the plain "MONSTER ENERGY" trade mark (as opposed to the composite mark) is known to or recognised by consumers of *energy drinks* in Singapore. One could be a sports fan and not a consumer of energy drinks and *vice versa*. The point is that I am not sure how I can draw any meaningful conclusions from pure eyeball numbers or mouse-clicks or finger-taps alone when I do not know whether individuals from Singapore follow the Opponent's website and social media accounts *for* the sports content or *because* they are consumers of energy drinks who wish to show their support for the Opponent by "liking" and "following" its social media pages.

⁶¹ Exhibit RCS-35.

⁶² RCS-SD1 at [148].

154 For the above reasons, I am not sufficiently persuaded that the evidence from the internet and social media necessarily assists the Opponent's case.

Magazine articles

155 I move to another area of the Opponent's evidence: magazine articles featuring the Opponent's commercial success in the field of energy drinks.⁶³ Such publications included: the Wall Street Journal (June 3, 2002), Time (July 2003), Business Week Online (June 6, 2005 and January 4, 2006), Fortune (September 5, 2005), Forbes.com (October 2005), Forbes magazine (October 31, 2005), and Newsweek (March 20, 2006). There was also an



Adweek article featuring the Opponent's "**MONSTER** " mark alongside that of its competitor, RED BULL.⁶⁴

156 I do not propose to go into each of them in detail. It suffices to say that it is not surprising that these publications referred to the Opponent as "Monster" or "Monster Energy" given that those words are part of the Opponent's "doing business as" trading name (Monster Energy Company). But as always the essential question is: how are the goods marketed? And the answer, as it can be seen from the photographs which accompany



the articles is that what is always prominently featured was the Opponent's "ENERBY" mark, and not the plain "MONSTER ENERGY" word mark.

Other evidence relating to exposure of the Opponent's trade marks

157 There was also other evidence such as that of the Opponent's sponsorship of the socalled "MONSTER train" on the Las Vegas monorail (in 2003);⁶⁵ and the manner in which the Opponent's goods were sold (at point of sale) in the USA.⁶⁶

158 I do not think that there was sufficient evidence to connect the "MONSTER train" back to the relevant sector of the public in Singapore, but even if I am wrong in this regard,

⁶³ RCS-SD1 at [150] and Exhibit RCS-37.

⁶⁴ Exhibit RCS-38.

 $^{^{65}}$ RCS-SD1 at [155] – [157] and Exhibits RCS-39 to RCS-44. It appears that this train was still in operation up to the relevant date, but I cannot be certain on the evidence before me.

⁶⁶ RCS-SD1 at [158] and Exhibit RCS-45.

MUNSTER

the point remains that what was displayed on the train was the Opponent's "ENERBY mark and not the plain words "MONSTER ENERGY".

159 As regards the evidence relating to the manner in which the Opponent's goods were sold (at point of sale) abroad, the same point can be made: the words "MONSTER ENERGY" never appear in plain word mark form and instead it was the stylised composite mark that was used.

Evidence relating to trade mark applications and registrations

160 The Opponent tendered a great deal of documents relating to its trade mark applications and registrations worldwide.⁶⁷ Some of these applications and registrations are in respect of the plain word mark "MONSTER ENERGY".

161 However, as the Applicant rightly submitted,⁶⁸ even if a mark has been registered in many countries and the duration of the registration has been substantial, that does not *per se* prove that it is well known, particularly in Singapore. (See *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [95] ("*City Chain*").) Moreover, trade mark registrations do not automatically equate to trade mark use. (*Formula One Licensing BV v Idea Marketing SA* [2015] 5 SLR 1349.⁶⁹)

Conclusion on whether "MONSTER ENERGY" was well known to the relevant sector

162 For the reasons above, I find that the Opponent's plain "MONSTER ENERGY" was not well known to the relevant sector of the public in Singapore.

163 Consequently, even if I am wrong in finding that "MONSTER ENERGY" and "MONSTER STRIKE" are more dissimilar than similar overall, the opposition under Section 8(4)(b)(i) TMA fails at this element.

Confusing connection

164 Even if I am wrong on marks similarity and in concluding that "MONSTER ENERGY" was not well known to the relevant sector of the public, Section 8(4)(b)(i) TMA further requires that it be shown that the "use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered" would "indicate a connection between those goods or services and the [Opponent]". In case law, this is sometimes known as the "confusing connection" requirement.

⁶⁷ Exhibit RCS-1.

⁶⁸ Applicant's Written Submissions at [74].

⁶⁹ Upheld on appeal to the Court of Appeal with no written grounds of decision issued.

165 In *Staywell* (at [120]) the Court of Appeal reaffirmed its earlier holding in *Amanresorts* that the "confusing connection" requirement will be satisfied where there is a likelihood of confusion. The opposite also holds true: if there is no likelihood of confusion, there cannot be a confusing connection.

166 The parties did not address me as to whether, in the assessment, I ought to have regard to the goods in Classes 9, 16, 18 and 25 for which the Opponent's "MONSTER ENERGY" (T0813668B) is registered, or whether I should also take into account the Opponent's "MONSTER ENERGY" (T0603081Z) mark in Class 32, or whether I should undertake the comparison by reference to the goods sold by the Opponent (*i.e.* energy drinks). But in any case nothing turns on it because I have taken the view that the respective goods and services are substantially dissimilar (see [88] above). In these circumstances, I cannot see how the element of confusing connection could possibly be made out.

Likelihood of damage to the Opponent's interests?

167 The final element in Section 8(4)(b)(i) TMA is likelihood of damage. This element only falls to be considered if I am wrong in respect of all of the other elements of the provision.

168 It is clear that damage in this context refers to something other than the perception of a confusing connection (see *Staywell* at [122]). The heads of damage that are recognised under this provision are essentially the same as those for the element of damage under the tort of passing off. (See Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet and Maxwell Asia, 2nd Ed, 2014) ("*Law of Intellectual Property of Singapore*") at [21.5.40].)

169 Here, the Opponent has relied on damage by blurring or alternatively by restriction on expansion.⁷⁰

Damage by blurring?

170 To summarise the general position: Blurring takes place when party A uses a confusingly similar sign to B and as a result, consumers buy A's goods thinking that they originate from B. The distinctiveness of B's sign becomes blurred in that it is no longer indicative only of B's goods, and consequently B's goodwill is 'spread over' A's goods. This head of damage is essentially about loss of sales because custom meant for B is diverted to A. It occurs when the parties are trade rivals (*i.e.* in direct competition with each other) or when their products or services are substitutes. (See *Law of Intellectual Property of Singapore* at [19.2.1] and *Amanresorts* at [97].)

171 In the present case, there is no evidence that the parties are trade rivals; neither are the products and services for which registration is sought under the Application Mark in

⁷⁰ Opponent's Written Submissions at [138] – [143].

any way substitutes of the goods in question. It is patently obvious that damage by blurring cannot possibly be established on these facts.

Damage by restriction on expansion?

172 A party that enjoys goodwill in one form of commercial activity may be entitled to protection from passing off in respect of another form of commercial activity which is a natural expansion (or extension) of the first. However, the two fields of activity must share a close connection for there to form a foundation for this head of damage. (See *Amanresorts* at [117] - [118].)

173 The Opponent argued that many of the specifications for which the Application Mark is sought to be registered are closely related to the specifications for which the Opponent's "MONSTER ENERGY" trade mark is registered. According to the Opponent, specifications such as "*computer game programs*" and "*video games*" represent registrations in fields which are closely related to its interests.⁷¹

174 In my judgment this submission was completely untenable. Although the Opponent may have engaged in marketing efforts tied to video games (see discussion at [121] above), there is no evidence that it is interested in entering that market at all. Indeed, in June 2015, the Opponent transferred its non- energy drinks business to The Coca Cola Company; if it is not even in the business of selling any beverages outside of energy drinks, it is simply too far-fetched to see the Opponent as a would-be entrant into the computer games industry.

Whether "MONSTER ENERGY" was well known to the public at large?

175 Under Section 8(4)(b)(ii)(A)-(B) TMA, it must be shown that the trade mark relied on was well known to the public at large in Singapore as at the relevant date.

176 In *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 the Court of Appeal held that in order for a mark to be "well known to the public at large in Singapore" it had to be more than merely well known in Singapore. Such a mark had to necessarily enjoy a much higher degree of recognition, and be recognised by most (although not necessarily all) the sectors of the public.

177 I have found that "MONSTER ENERGY" was not well known to the relevant sector of the public in Singapore. Surely this higher threshold cannot be satisfied on the evidence. As such, I need say no more about it. The opposition under this ground fails as well.

Opposition under Section 8(7)(a) TMA

178 Section 8(7)(a) TMA provides that a trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented "by any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade".

⁷¹ Opponent's Written Submissions at [142].

179 To succeed, the Opponent must establish a *prima facie* case of passing off (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]). There are three elements in the tort of passing off: goodwill, misrepresentation, and damage. (*Staywell* at [130]; *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 at [80].) All three elements are disputed by the Applicant.

180 In Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading) [2016] 4 SLR 86 ("Singsung") the Court of Appeal restated the law (at [32] - [41]) concerning each of these elements. The court also took the opportunity to clarify certain aspects of the law which, in its view, suffered "from a lack of precision" (see [36]). The sub-paragraphs that follow are a summary of the key points (some of them paraphrased) drawn from Singsung. (I have recently set them out elsewhere: see Louis Dreyfus Commodities MEA Trading DMCC v Orco International (S) Pte Ltd [2017] SGIPOS 8 ("Louis Dreyfus") at [90].)

- a. Goodwill: This is "the legal property that the law of passing off protects". It is an "amorphous idea that does not sit well with strict definitions", but is essentially a term to describe "the state of the trader's relationship with his customers". Some other formulations include: "benefit and advantage of the good name, reputation, and connection of a business", and more famously, "the attractive force which brings in custom". (Singsung at [32].) It is also useful to appreciate what goodwill - for the purposes of the tort of passing of - is not. Because passing off "protects a trader's relationship with his customers", goodwill is ultimately concerned with the "business as a whole", and not in its "constituent elements, such as the mark, logo or get-up" used by the business. Put another way, the goodwill relevant to passing off is not "in the mark, logo or get-up" per se. (Singsung at [33] – [34].) Goodwill "does not exist on its own, but attaches to a business in the jurisdiction, and is manifested in the custom that the business enjoys". (Singsung at [34].) It may be proved "by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear". (Singsung at [34].)
- b. <u>Distinctiveness</u>: Previously, the courts have taken one of two broad approaches when analysing distinctiveness. On occasion, it "has been considered as part of the analysis of goodwill". At other times, it is analysed "in the context of misrepresentation". (Singsung at [36].) In most cases, whether one takes one approach or the other, the outcome is inconsequential. This is because the elements of the tort are connected and interdependent. (Singsung at [37].) But, "as a matter both of principle and conceptual clarity, the issue of whether a mark or getup is distinctive of the plaintiff's products or services" is "a question that is best dealt with in the context of the inquiry as to whether the defendant had made a misrepresentation". (Singsung at [37].) The "issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable

misrepresentation". If "a mark or get-up is not distinctive of the plaintiff's products or services", the "mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant's products or services are the plaintiff's or are economically linked to the plaintiff". If "it is found that the mark or get-up is distinctive of the plaintiff, then the next question is whether the use of similar indicia by the defendant amounts to a misrepresentation". (Singsung at [38])

- Misrepresentation: The misrepresentation inquiry "typically begins with a c. consideration of how the defendant is said to be doing this". In general, it entails "the use of some element that serves as a badge or identifier marking the goods or services in question as emanating from the claimant". It will then be "necessary to consider whether that element does serve as a badge or identifier, or, in the parlance of the action, whether it is 'distinctive' of the claimant's goods and services, and whether the claimant's goodwill (established under the first stage of the inquiry) is in fact associated with that element". Next, it falls to be considered, among other things, "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 in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant's goods or services are, or emanate from a source that is linked to, the claimant's" (Singsung at [39] citing The Singapore Professional Golfers' Association v Chen Eng Waye [2013] 2 SLR 495 at [20]). Ultimately, whether misrepresentation has occurred "is a question to be determined by the court in the light of the surrounding circumstances". In order to be actionable, the misrepresentation "must give rise to confusion or the likelihood thereof. Whether this is so is a question to be determined by the court/tribunal in the light of the surrounding circumstances. This is not to be determined on a visual side-by-side comparison. Rather, it is to be assessed from the perspective of a notional customer with imperfect recollection". (Singsung at [40].)
- d. <u>Damage</u>: The claimant need not show actual damage as long as a real tangible risk of substantial damage is present. This could occur by way of blurring or tarnishment. (*Singsung* at [41].)
- 181 I now turn to the facts.

Goodwill

182 I only need concern myself with the question of whether the Opponent enjoys goodwill in its business as a whole, and not specifically in its constituent elements: *Singsung* at [34]. Here, I do not examine the question of whether the indicia relied on (here:

"MONSTER ENERGY")⁷² was distinctive of the Opponent because that is a threshold issue under the second element, misrepresentation: *Singsung* at [37] - [38].

183 The Opponent has a business presence in Singapore in the form of a local subsidiary, and it has sold its energy drinks in Singapore through a local distributor: see [132] - [136] above. I have no trouble finding that goodwill has been established on this basis.

Misrepresentation

184 I have emphasised elsewhere (see *Louis Dreyfus* at [99]) that distinctiveness in the context of passing off – and misrepresentation specifically – is inextricably tied to use. If a mark (or some other indicia) has never been used by a trader, it cannot be said to be distinctive of a trader. (Otherwise, any trader could simply claim any number of indicia as its own without having used them.) A trader may conduct business in Singapore and thus enjoy goodwill. But unless there is a link, or association, between that goodwill and the mark (or some other indicia) relied upon (which can only arise if the mark is distinctive of the trader's goods or services) there cannot be any misrepresentation to speak of.

185 The Opponent has relied on the plain word mark "MONSTER ENERGY" for the purposes of the passing off ground.⁷³ The question therefore is whether it has used that mark in Singapore in the course of trade such that the mark can be said to be distinctive of it.

Above, after analysing the Opponent's evidence in the context of Section 8(4) TMA, I arrived at the conclusion that "MONSTER ENERGY" could not be said to be well known to the relevant sector of the public (*i.e.* actual and potential consumers of energy drinks) in Singapore because, *inter alia*, that was not the trade mark by reference to which the Opponent's energy drinks were primarily marketed and sold. For substantially the same reasons, I hold that the plain "MONSTER ENERGY" mark was not distinctive of the Opponent's energy drinks in Singapore. I must stress that I am not suggesting that the Opponent did not use "MONSTER ENERGY" at all: there was certainly evidence that it did so online (see [130] and [150] – [152] above). But, by and large the evidence showed

TT

the use of "**MONSTER**," or alternatively the claw device "**M**" alone. It also bears repeating that the word "ENERGY" appears much smaller in size as compared to the stylised **MONSTER**; that "ENERGY" is descriptive of energy drinks; and the Opponent appears to have used "ENERGY" to designate a particular product line to distinguish it from its other product lines. (See [131] above.)

⁷² Opponent's Written Submissions at [164].

⁷³ Opponent's Written Submissions at [160].

187 I have found the respective marks "MONSTER ENERGY" and "MONSTER STRIKE" to be more dissimilar than similar. I have also found the goods and services in Classes 9 and 41 for which registration is sought under the Application Mark to be substantially dissimilar to the goods for which the Opponent's "MONSTER ENERGY" mark is registered. Even if I were to undertake the comparison by reference to the Opponent's energy drinks, the respective goods and services are also substantially dissimilar. In the premises, I cannot see how the relevant segment of the public would likely be deceived or confused as to trade source. Consequently the opposition under Section 8(7)(a) TMA fails.

188 Before I leave this part, I will briefly touch on the Opponent's submission that its goodwill exists in relation to computer programs, computer game programs and video games.⁷⁴ It made this submission under the heading "the type of business in respect of which goodwill exists". Obviously this submission was unsustainable, because on the evidence the Opponent clearly had no business in relation to computer programs, computer game programs and video games. Sponsoring e-sports teams, and featuring its trade marks in connection with games and gaming events is different from *engaging in* the trade of selling such programs and games.

Damage

189 The final element is damage, or the likelihood thereof.

190 I have dealt with this in the context of Section 8(4)(b)(i) TMA above, and my findings and conclusions there apply here equally. As such, even if I am wrong on misrepresentation, the opposition necessarily fails here as well.

Conclusion

191 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. The Applicant is entitled to costs to be taxed, if not agreed.

Date of issue: 12 September 2017

⁷⁴ Opponent's Written Submissions at [156].