

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

Trade Mark No. T1215563G  
3 August 2017

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

CHUN-HUA LO

**AND**

**OPPOSITION THERETO BY**

MONSTER ENERGY COMPANY

Hearing Officer: Ms Sandy Widjaja  
Principal Assistant Registrar of Trade Marks

Ms Lim Siau Wen (Drew & Napier LLC) for the Opponents

Mr Melvin Pang and Mr Marcus Liu (Amica Law LLC) for the Applicant

**GROUND OF DECISION**

1 In *Monster Energy Company v Mixi, Inc.*, [2017] SGIPOS 12 (“*Mixi*”), Monster Energy Company (“the Opponents”), tried to oppose the mark “MONSTER STRIKE” then sought to be registered for goods in Classes 9 and 41.

2 At the commencement of *Mixi*, the learned Assistant Registrar commented:

[2]...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.

And so the Opponents’ quest continues.

3 In the current dispute, Chun-Hua Lo (“the Applicant”) sought to register the trade mark, T1215563G (“Application Mark”):



for the following goods in Classes 30 and 43 respectively:

Class 30

Ice, natural or artificial; fruit flavoured water ices in the form of lollipops; cream (ice); fruit ices; ice lollies containing milk; ice lollies being milk flavoured; ice for refreshment; sherbets [ices]; frozen yogurt [confectionery ices]; edible ices; ice confections; ice cubes; flavored ices

Class 43

Bar services; cafés; cafeterias; restaurants; self-service restaurants; snack-bars.

4 The Application Mark was accepted and published on 27 December 2013 for opposition purposes. The Opponents filed their Notice of Opposition to oppose the registration of the Application Mark on 7 February 2014. The Applicant filed his Counter-Statement on 14 May 2014. The Opponents filed their evidence on 19 March 2015. The Applicant filed evidence in support of the application on 19 November 2015. The Opponents filed their evidence in reply on 17 February 2016.

5 On 14 March 2016, at the Pre-Hearing Review, the Applicant requested to file further evidence in response to the evidence in reply filed by the Opponents. The Opponents consented, on the basis of having the right to reply. Consequently, the Applicant filed his further evidence on 13 April 2016 and the Opponents filed their reply to the same on 3 June 2016. The hearing was set for 8 August 2016.

6 On 7 July 2016, just one day before the due date to file written submissions and bundle of authorities, the Opponents requested to amend their pleadings to add a ground of opposition based on Section 8(4) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“Act”) as well as to file further evidence. The Applicant objected, arguing that it will cause undue delay. An interlocutory hearing ensued and a decision was issued (*Chun Hua-Lo v Monster Energy Company* [2017] SGIPOS 1 (“*Interlocutory Decision*”)) where only the request to file further evidence was allowed, subject to the Applicant having a right of reply. Following this, the Opponents filed their further evidence on 6 February 2017 and the Applicant filed his response on 30 March 2017. The case was finally heard on 3 August 2017.

### **Grounds of Opposition**

7 The Opponents rely on Sections 8(2)(b) and 8(7)(a) of the Act in this opposition.

### **Opponents’ Evidence**

8 The Opponents’ evidence comprises the following:

- a) Statutory Declaration of Rodney Cyril Sacks, Chairman and Chief Executive Officer of Monster Beverage Corporation and their subsidiaries, including the Opponents, dated 22 January 2015 (“Opponents’ 1<sup>st</sup> SD”);
- b) Statutory Declaration of Rodney Cyril Sacks dated 1 February 2016 (“Opponents’ 2<sup>nd</sup> SD”);
- c) Statutory Declaration of Rodney Cyril Sacks dated 24 May 2016 (“Opponents’ 3<sup>rd</sup> SD”); and
- d) Statutory Declaration of Rodney Cyril Sacks dated 27 January 2017 (“Opponents’ 4<sup>th</sup> SD”)<sup>1</sup>.

### **Applicant’s Evidence**

9 The Applicant’s evidence comprises the following:

- a) Statutory Declaration of the Applicant, Chun Hua Lo, the founder of the ICE MONSTER business, dated 19 November 2015 (“the Applicant’s 1<sup>st</sup> SD”);
- b) Statutory Declaration of Chun Hua Lo dated 11 April 2016 (“the Applicant’s 2<sup>nd</sup> SD”); and
- c) Statutory Declaration of Chun Hua Lo dated 24 March 2017 (“the Applicant’s 3<sup>rd</sup> SD”)<sup>2</sup>.

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<sup>1</sup> This was following the *Interlocutory Decision* (above).

<sup>2</sup> Following the *Interlocutory Decision* (above).

## Applicable Law and Burden of Proof

10 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.


## Background


11 The Opponents deposed at [3] of Opponents' 1<sup>st</sup> SD that they are in the business of designing, creating, developing, producing, marketing and selling non-alcoholic beverages, including carbonated drinks, natural sodas, fruit juices, energy drinks and energy sports drinks, amongst others. The Opponents also deposed that they have been acknowledged as a leader in the beverage industry, receiving recognition and awards ([4] of Opponents' 1<sup>st</sup> SD). The Opponents' MONSTER marks have also been filed / registered worldwide in more than 100 countries ([7] of the Opponents' 1<sup>st</sup> SD). By both unit volume and dollar value, MONSTER energy drinks are the best-selling energy drinks in the United States of America (USA) and the second best-selling worldwide by unit volume ([8] of Opponents' 1<sup>st</sup> SD).

12 In Singapore, MONSTER energy drinks are distributed by Pacific Beverages Pte Ltd and are sold via retail stores, gas stations as well as drug stores ([15] of Opponents' 1<sup>st</sup> SD).

13 The Opponents rely on the following earlier marks (collectively, *Opponents' Earlier Marks*):

S/N	<i>Opponents' Earlier Marks</i>	Class
<b><i>Opponents' Earlier Monster Marks</i></b>		
1	MONSTER T0605638Z	<u>Class 5</u> Nutritional supplements; vitamin drinks; drinks containing vitamins and minerals.
2	MONSTER T0605639H	<u>Class 32</u> Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.
3	MONSTER T1111969F	<u>Class 5</u> Nutritional supplements in liquid form in Class 5.
		<u>Class 32</u> Non-alcoholic beverages in Class 32.
<b><i>Opponents' Earlier Monster Prefix Marks</i></b>		
4	MONSTER REHABITUATE	<u>Class 5</u> Nutritional supplements in liquid form.

	<i>T1210719E</i>	<p><u>Class 30</u> Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; all included in Class 30.</p> <p><u>Class 32</u> Non-alcoholic beverages, namely energy drinks, energy drinks flavored with tea, energy drinks flavored with juice, sports drinks, and fruit juice drinks; all of the foregoing enhanced with vitamins, minerals, nutrients, amino acids and/or herbs; all included in Class 32.</p>
5	<p>MONSTER REHAB <i>T1107597D</i></p>	<p><u>Class 5</u> Nutritional supplements in liquid form; vitamin drinks; beverages containing added vitamins and minerals (for medical purposes); all included in Class 5.</p> <p><u>Class 30</u> Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; all included in Class 30.</p> <p><u>Class 32</u> Non-alcoholic beverages, namely energy drinks, energy drinks flavored with tea, energy drinks flavored with juice, sports drinks, and fruit juice drinks; all of the foregoing enhanced with vitamins, minerals, nutrients amino acids and/or herbs; all included in Class 32.</p>
6	<p>MONSTER DETOX <i>T1206503D</i></p>	<p><u>Class 5</u> Nutritional supplements in liquid form in Class 5.</p> <p><u>Class 30</u> Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages; all included in Class 30.</p> <p><u>Class 32</u> Non-alcoholic beverages, including energy drinks, energy drinks flavored with tea, energy drinks flavored with juice, sports drinks, and fruit flavoured non-alcoholic drinks; all of the foregoing enhanced with vitamins, minerals, nutrients, amino acids and/or herbs (other than for medicinal use); all included in Class 32.</p>
<b><i>Opponents' Earlier Monster and Claw Device Marks</i></b>		
7		<p><u>Class 32</u> Beverages; preparations for making beverages.</p>

	<i>T0609605E</i>	
8	 <i>T0813672J</i>	<u>Class 9</u> Protective clothing; protective footwear; protective headwear; protective eyewear; all included in Class 9.
		<u>Class 16</u> Printed matter and publications; posters; stickers; transfers; cards; stationary; signboards; all included in Class 16.
		<u>Class 18</u> 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.
		<u>Class 25</u> Clothing; footwear and headgear; all included in Class 25.
<b><i>Opponents' Earlier Monster Energy Marks</i></b>		
9	MONSTER ENERGY  <i>T0603081Z</i>	<u>Class 32</u> Mineral and aerated waters and other non-alcoholic drinks; energy drinks; isotonic beverages (non-medicated); fruit drinks; fruit juices and syrups for preparing beverages.
10	MONSTER ENERGY  <i>T0813668B</i>	<u>Class 9</u> Protective clothing; protective footwear; protective headwear; protective eyewear; all included in Class 9.
		<u>Class 16</u> Printed matter and publications; posters; stickers; transfers; cards; stationary; signboards; all included in Class 16.
		<u>Class 18</u> 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.
		<u>Class 25</u> Clothing; footwear and headgear; all included in Class 25.
<b><i>Opponents' Earlier Monster Suffix Marks</i></b>		
11	JAVA MONSTER  <i>T0611182H</i>	<u>Class 32</u> Beverages, namely, soft drinks; carbonated soft drinks; carbonated and non-carbonated energy drinks; carbonated and non-carbonated sports drinks; carbonated and non-carbonated fruit juice drinks; soft drinks, carbonated soft drinks, carbonated and non-carbonated energy drinks, carbonated and non-carbonated sports drinks and carbonated and non-carbonated fruit juice drinks, all enhanced with vitamins, minerals, nutrients, amino acids, and/or herbs; flavored waters, fruit juices; concentrates, syrups or

		powders used in the preparation of soft drinks or energy drinks.
12	X-PRESSO MONSTER	<u>Class 5</u> Nutritional supplements in Class 5.
	<i>T1009880F</i>	<u>Class 32</u> Non-alcoholic beverages being energy drinks in Class 32 flavoured with coffee.

14 The Applicant deposed ([3] of the Applicant’s 1<sup>st</sup> SD) that the first ICE MONSTER shop was established in 1997 in Taipei. The Applicant also expanded into Singapore, Malaysia and Japan. However, in 2010, the Applicant had to close the shops due to certain personal and business considerations ([4] of the Applicant’s 1<sup>st</sup> SD).

15 Subsequently in May 2012, the Applicant re-opened in Taipei using the Application Mark ([4] of the Applicant’s 1<sup>st</sup> SD). Thereafter, the Applicant continued expansion into China and Japan respectively in 2015 ([5] and [6] of the Applicant’s 1<sup>st</sup> SD). The Applicant deposed that in addition to the above, he has expanded into Malaysia. He also has plans for further expansion in Japan as well as possibly USA and Dubai ([7] of the Applicant’s 1<sup>st</sup> SD).

## MAIN DECISION

### Ground of Opposition under Section 8(2)(b)

16 Section 8(2)(b) provides as follows:

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

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

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

### *Decision on Section 8(2)(b)*

#### *Step-by-step approach*

17 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under Section 8(2)(b) (see [15] and [55]):

- a) The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are assessed individually before the final element which is assessed in the round.

- b) Once the two threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

### *Similarity of Marks*

18 In relation to this issue, the following points are to be noted (*Staywell* at [15] to [30]):

- a) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.
- b) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court's inquiry. Trade-offs can occur among the three aspects of similarity.
- c) A productive and appropriate application of the step-by-step approach necessitates that the court reach a meaningful conclusion at each stage of the inquiry.
- d) The assessment of marks similarity is mark-for-mark without consideration of any external matter.
- e) Technical distinctiveness is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.
- f) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.
- g) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.



19 Further, the Court of Appeal provided in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40(c)] and [40(d)] ("*Hai Tong*"):

- a) The relevant 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.



- b) It is assumed that the average consumer has “imperfect recollection” such that the two contesting marks are not to be compared or assessed side by side (and examined in detail). Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.

20 Purely for ease of comparison, the marks are as follows:

<i>Application Mark</i>	<i>Opponents’ Earlier Marks</i>
	MONSTER
	MONSTER REHABILITATE
	MONSTER REHAB
	MONSTER DETOX
	
	MONSTER ENERGY
	JAVA MONSTER
X-PRESSO MONSTER	

21 As a preliminary point, the Applicant submitted at the oral hearing that out of all the *Opponents’ Earlier Marks*, it is the *Opponents’ Earlier Monster Marks* which are closest to the Application Mark. This means that if the conclusion is that the *Opponents’ Earlier Monster Marks* are not similar to the Application Mark, the same will hold true for the rest of the *Opponents’ Earlier Marks*. Thus, the focus of the analysis below will be on the *Opponents’ Earlier Monster Marks*.

*Distinctiveness*

22 I am mindful of the Court of Appeal’s guidance in *Staywell* (above) that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar; it is not a separate step within the marks-similarity inquiry. However, for ease of analysis, I will summarise my findings first, before applying them within the context of the mark-similarity analysis. In this regard, *Hai Tong* at [26] provided as follows:

[26] Distinctiveness is considered within the assessment of similarity, as noted by this court in *Sarika*. However, for the purpose of *elucidating* the analytical process, we have highlighted it here as a *separate step*...

[Emphasis in *italics* mine]

23 Before I delve further, a point arises as to whether acquired distinctiveness can be taken into account for this purpose at the mark similarity stage. As alluded to above, the

assessment of marks similarity is mark-for-mark without consideration of any external matter. The question then is whether the actual use of the mark (via sales and promotion of products bearing the mark) is considered external matter and as such excluded from the analysis at this stage.

24 It would appear that this issue has not been examined in detail thus far. Nevertheless, it is not necessary to resolve the query in this instance, for while the Opponents had sought to rely on *de facto* distinctiveness, as can be seen below and as argued by the Applicant ([20] of the Applicant's Written Submissions ("AWS1")), the Opponents' evidence of use cannot be taken into consideration on the facts of the current case.

### ***Opponents' Earlier Monster Marks***

25 The Opponents argued strenuously that the dominant and distinctive feature in the ***Opponents' Earlier Marks*** is the word "MONSTER" ([14] of the Opponents' Written Submissions ("OWS1")).

26 The Opponents submitted that "monster" has been defined as follows from the online Oxford Dictionary ([15] of OWS1):

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

[Emphasis in *italics* mine]

27 Given the above meaning, the Opponents submitted ([16] of OWS1):

[16]...the mark 'MONSTER' by itself, "say nothing about" the goods for which it is registered...Although the mark 'MONSTER' consists of an English dictionary word, it has absolutely no reference to the Opponent's goods. In short, the 'MONSTER' mark is unusual, novel and highly distinctive of the Opponent's goods.

28 Further the Opponents submitted that the ***Opponents' Earlier Marks*** have "come to acquire the capacity to act as a badge of origin through long-standing or widespread use" ([17] of OWS1). In this regard, the Opponents' evidence is as follows:

- a) Various awards which the Opponents had won ([4] of the Opponents' 1<sup>st</sup> SD);
- b) Registered and pending MONSTER marks worldwide ([6] of the Opponents' 1<sup>st</sup> SD): the Opponents deposed that MONSTER marks have been filed and registered in over 100 countries / territories ([7] of the Opponents' 1<sup>st</sup> SD);
- c) Sales of MONSTER energy drinks around the world (approximately 115 nations / territories) ([10] of the Opponents' 1<sup>st</sup> SD);
- d) Range of beverage products ([11] of the Opponents' 1<sup>st</sup> SD);

- e) Sales of MONSTER energy drinks in Singapore ([12] – [15] of the Opponents’ 1<sup>st</sup> SD);
- f) Promotional activities in Singapore ([25] of the Opponents’ 1<sup>st</sup> SD);
- g) Revenue and market share of MONSTER energy drinks ([16] – [17] of the Opponents’ 1<sup>st</sup> SD);
- h) Marketing strategy ([18] – [28] of the Opponents’ 1<sup>st</sup> SD), in particular:
  - (a) Sponsorship of athletes, teams and events
    - (i) International Sports Sponsorship ([34] – [85] and [107] – [110] of the Opponents’ 1<sup>st</sup> SD);
    - (ii) International Athletes ([86] – [106] of the Opponents’ 1<sup>st</sup> SD);
    - (iii) Monster Army ([111] – [114] of the Opponents’ 1<sup>st</sup> SD);
    - (iv) Music Festivals and Musicians ([115] of the Opponents’ 1<sup>st</sup> SD);
    - (v) Website and Social Media ([116] – [125] of the Opponents’ 1<sup>st</sup> SD);
    - (vi) Magazine / trade publications ([126] – [129] of the Opponents’ 1<sup>st</sup> SD);
    - (vii) The Monster train ([130] – [132] of the Opponents’ 1<sup>st</sup> SD);
    - (viii) Point of Sale Items ([133] of the Opponents’ 1<sup>st</sup> SD).

29 However, the above evidence is fraught with issues:

(i) It is to be noted that the relevant date in this case is *18 October 2012*, which is the date of the application of the Application Mark. Thus any evidence relating to events after this date is to be disregarded.

(ii) The majority of the evidence tendered relates to the Opponents’ overseas’ activities. In this regard, the Opponents sought to connect such evidence to the local context by arguing that the athletes and sports events, “dressed” in the manifold gear / items reflecting the Opponents’ marks<sup>3</sup>, are broadcasted extensively via the web / social media as well as television. These media platforms will in turn be seen by Singapore consumers. Clearly, such a claim must be substantiated by evidence and a bare statement is insufficient.

(iii) Critically, most of the evidence tendered do *not* reflect the ***Opponents’ Earlier Monster Marks***, which consists of the word “Monster” *simpliciter*<sup>4</sup>.

The above issues will be discussed in detail below.

30 Before I proceed further, it is useful to define the different types of marks reflected, in particular, in the Opponents’ 1<sup>st</sup> SD<sup>5</sup>:

<sup>3</sup> The Opponents’ main avenue of marketing their products is via sponsorships of such sportsmen and competitions – see below.

<sup>4</sup> See [18] AWS1 referring to *Société des Produits Nestlé SA and another v Petra Foods Ltd and another* [2017] 1 SLR 35 at [68] and [69].

<sup>5</sup> For clarity, references to the ***Opponents’ Earlier Marks*** (above) will not be used; the ***Opponents’ Earlier Marks*** pertain to specific applications made at IPOS.

S/N	Opponents' Marks	Depiction
1	Monster Energy Composite Mark <sup>6</sup>	
2	Claw Device Mark	
3	Monster Energy Stylised Mark	
4	Monster Composite Mark	
5	Monster Energy Composite Mark 2	
6	Monster Stylised Mark	

31 As a preliminary note, the evidence tendered by the Opponents in *Mixi* is highly similar (subject to the specifics of that case; for example, in *Mixi*, the Opponents' earlier "MONSTER ENERGY" marks are registered in Classes 9, 16, 18 and 25 and the relevant date in *Mixi* is 23 June 2014). Thus, wherever appropriate, I will be referring to the learned Assistant Registrar's analysis in relation to the evidence filed in that case.

#### *Awards*

32 The Opponents provided a whole list of awards which they had received to demonstrate that they were acknowledged as a leader in the beverage industry ([4] of the Opponents' 1<sup>st</sup> SD). Some more recent examples include:

- (i) *One of the most innovative companies* by Forbes in 2014;
- (ii) *Liquid refreshment company of the year* by Beverage World in 2012;
- (iii) *100 fastest growing companies* by Fortune Magazine in 2008.

However, there is no evidence as to whether the awards were applicable to the local market. Thus they do not assist the Opponents here.

#### *Worldwide Registrations and Applications*

33 In relation to the Opponents' registered and pending MONSTER marks worldwide, even if some may relate to the plain MONSTER mark, as the learned Assistant Registrar

<sup>6</sup> As above. Thus, while this mark is identical to the *Opponents' Earlier Monster and Claw Device Marks*, the reference used for the purposes of identifying it in the Opponents' 1<sup>st</sup> SD will be the Monster Energy Composite Mark.

provided at [161] of *Mixi* “trade mark registrations do not automatically equate to trade mark use”.

### *Range of Products*

34 The Opponents have an extensive range of, in particular, energy drinks ([11] of the Opponents’ 1<sup>st</sup> SD). However, clearly, only those which have been made available in Singapore will be relevant. This will be dealt with below.

### *Sales in Singapore*

35 In relation to sales in Singapore, the Opponents deposed ([13] of the Opponents’ 1<sup>st</sup> SD):

[13] My Company launched sales of its MONSTER energy drinks in Singapore in October 2012. Monster currently sells MONSTER ENERGY, MONSTER ENERGY ABSOLUTE ZERO, and MONSTER KHAOS in Singapore. *Since the launch in Singapore in October 2012 through 31 December 2014, my company has sold more than 2.2 million cans of MONSTER energy drinks bearing one or more of the MONSTER marks in Singapore, amounting to sales of approximately US\$2.1 million.*

[Emphasis in *italics* mine]

In light of the above, in relation to the Singapore market, the Opponents were only “ahead” of the Applicant by about 18 days. Thus, only figures which pertain to the period 1 October – 18 October 2012 can be taken into account<sup>7</sup>.

36 I refer to the Opponents’ 1<sup>st</sup> SD at Exhibit RCS-2, which is an excerpt of the Opponents’ website showing a picture of the MONSTER drinks that were distributed in Singapore ([13] of the Opponents’ 1<sup>st</sup> SD). Firstly, it is noted that the document is dated 13 January 2015. Thus it cannot be taken into account since it is after the relevant date of 18 October 2012. In any event, it is apparent that the can of energy drink on the website reflects the Monster Energy Composite Mark while the website itself reflects the Monster Energy Stylised Mark. In short, the *Opponents’ Earlier Monster Marks* is nowhere to be seen.

37 The Opponents also deposed, at [15] of the Opponents’ 1<sup>st</sup> SD:

[15] In Singapore, my Company’s MONSTER energy drinks are distributed by Pacific Beverages Pte Ltd, and are sold in the channels of retail stores, gas stations and other outlets such as drug stores and on premise. Attached hereto...are copies of invoices to Pacific Beverages Pte Ltd and shipping documentation to Pacific Beverages Pte Ltd.

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<sup>7</sup> In this regard, the Opponents’ evidence at [15] of the Opponents’ 2<sup>nd</sup> SD and [9] of the Opponents’ 3<sup>rd</sup> SD are to be disregarded.

38 The Opponents tendered copies of invoices and shipping documents to their local distributor Pacific Beverages Pte Ltd (Exhibit RCS-3 of the Opponents' 1<sup>st</sup> SD). I refer to page 54 of Exhibit RCS-3 of the Opponents' 1<sup>st</sup> SD - the tax invoice issued by Monster Energy Singapore was dated "10/04/2012". Whether it is read as "4 October 2012" or "10 April 2012" it will still be before the relevant date of 18 October 2012 and thus can be taken into account. The mark reflected on the top left hand of the invoice is the Monster Energy Composite Mark 2. On the other hand, under "Description", the product is simply described as "Monster Energy".

39 On page 70 of Exhibit RCS-3 of the Opponents' 1<sup>st</sup> SD is a copy of a commercial invoice dated 28 August 2012. The shipper is "Monster Energy Company" in the USA and the consignee is "Monster Energy Singapore Pte Ltd" in Singapore. However, there is no depiction of the mark. Under "Description of Merchandise" the products were simply described as "energy drink". Some documents were dated after the relevant date and will be disregarded (see for example, the invoice at page 67 of Exhibit RCS-3 of the Opponents' 1<sup>st</sup> SD which is dated 24 November 2014).

40 As the learned Assistant Registrar observed at [129] of *Mixi*:

[129] It is one thing to describe the goods...but *how they are actually marketed and sold is another matter*. And from the evidence, although there are minor variations for each product range, each drink can invariably bears [the Claw Device]...and the words "MONSTER ENERGY" always appear as [Monster Energy Stylised Mark].

[Emphasis in *italics* mine]

41 It is to be recalled that the relevant marks relied on by the Opponents here are the *Opponents' Earlier Monster Marks*, which merely comprise the plain word "MONSTER". Thus, even if the website above can be taken into account to reflect how the Opponents' marks were actually portrayed on the cans, the evidence clearly cannot be taken into account for the issue of acquired distinctiveness since the cans reflect essentially the Monster Energy Composite Mark.

#### *Promotional Expenditure in Singapore*

42 Similarly, the Opponents deposed as follows in relation to local promotional expenditure ([25] of the Opponents' 1<sup>st</sup> SD):

[25]...Monster have undertaken extensive advertising, marketing and promotional activities in Singapore. *Since April 2012 through to September 2014*, my Company has spent more than US\$948,000 in marketing and promotional activities in Singapore to promote MONSTER energy drinks.

[Emphasis in *italics* mine]

Again, promotional expenditure after 18 October 2012 is to be disregarded. In addition, having regard to the actual mark that has been marketed (see below), the evidence does not assist the Opponents.

*Worldwide Sales / Revenue and market share of MONSTER energy drinks*

43 Sales of MONSTER energy drinks around the world ([10] of the Opponents' 1<sup>st</sup> SD) clearly do not assist as there is a need to show sales in Singapore. This is so despite the extensive revenue from gross sales worldwide<sup>8</sup> ([16] of the Opponents' 1<sup>st</sup> SD<sup>9</sup>):

- (i) US\$2.37 billion in 2012;
- (ii) US\$1.95 billion in 2011; and
- (iii) US\$1.489 billion in 2010.

*Marketing Strategy*

44 With regard to marketing strategy, the Opponents deposed (at [19] of the Opponents' 1<sup>st</sup> SD):

[19] Monster's marketing strategy is not conventional in that MONSTER does not use direct television or radio advertising to promote the MONSTER Marks and drinks...

*Sponsorship of athletes, teams and events*

45 Specifically, the Opponents' deposed ([20]):

[20] In Singapore and elsewhere outside of United States, Monster allocates majority of its marketing, advertising and promotional budget on *athlete endorsements and sponsoring athletic competitions* and other events. In particular, Monster's marketing focus includes international events, including but not limited to events which are *webcast over the internet to reach our primary target of young adults aged 18 to 34 years old, primarily males...* In addition to the actual contractual amounts paid to sponsor athletes and racing teams, Monster expends substantial amounts in supporting the sponsored athletes, teams and sports through *point of sale materials...wrapping / branding the athletes' vehicles*, paying for the athletes' travel expenses and by providing them with *Monster branded apparel...and action sports gear bearing the MONSTER marks...* Further, Monster hire employees and outside companies to attend events...*to provide...sampling of products to consumers...*

...

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<sup>8</sup> The Opponents deposed that MONSTER energy drinks have represented 92.3% and 91.2% of the Opponents' total net sales for the years ended December 31, 2012 and 2011, respectively ([16] of the Opponents' 1<sup>st</sup> SD).

<sup>9</sup> Again, any figures after the relevant date of 18 October 2012 is to be disregarded.

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

...

[27] My Company's sponsorship of sporting events involves MONSTER Marks being *prominently displayed at events on banners, posters, signs and on clothing and accessories sold at events*, on transport, support and hospitality tractors, on motor homes and promotional vehicles that tour the circuit for various sports.

[28] By sponsoring athletes and events, *widespread and global exposure is created, including in Singapore*. The Monster sponsored athletes' exploits are *followed avidly by those attending the events, and by many more viewers that watch the television and webcasts of these events* and follow the sports. The sponsored athletes, teams and musicians create enormous public exposure and awareness of MONSTER marks.

[Emphasis in *italics* mine]

As a preliminary note, many of the excerpts in the Opponents' 1<sup>st</sup> SD relating to the Opponents' promotional activities via sponsorships were undated / dated after 18 October 2012 such that they cannot be taken into account.

46 Examples of sponsored items during events and gear, accessories and equipment worn and utilised by athletes include:

- (i) Backdrop (page 164 of the Opponents' 1<sup>st</sup> SD at RCS-15 – showing the Claw Device and the Monster Energy Stylised Mark);
- (ii) Banners (page 170 of the Opponents' 1<sup>st</sup> SD at RCS-15 – showing the Claw Device and the Monster Energy Stylised Mark);
- (iii) Backdrop of podium (page 172 of the Opponents' 1<sup>st</sup> SD at RCS-15 – showing the Monster Energy Stylised Mark);
- (iv) Suit (page 124 of the Opponents' 1<sup>st</sup> SD at RCS-9 – showing the Claw Device and the Monster Energy Stylised Mark);
- (v) Helmet (page 108 of the Opponents' 1<sup>st</sup> SD at RCS-7- showing the Claw Device);
- (vi) T-shirt (page 125 of the Opponents' 1<sup>st</sup> SD at RCS-9 – showing the Monster Energy Composite Mark); and
- (vii) Car (page 215 of the Opponents' 1<sup>st</sup> SD at RCS-21 – showing Claw Device and the Monster Energy Stylised Mark).



47 Last but not least, samples of energy drinks bearing the Opponents' marks were given out during such events. Between the period 2012 to 2014<sup>10</sup>, over 159,000 sample cans of the Opponents' energy drinks were distributed to consumers in Singapore at such sporting events ([32] of the Opponents' 1<sup>st</sup> SD).

48 Sports events sponsored by the Opponents (in general see [34] – [85] and [107] – [110] of the Opponents' 1<sup>st</sup> SD) include:

- (i) F1 Racing since March 2010 ([34] of the Opponents' 1<sup>st</sup> SD);
- (ii) MotoGP since 2007 ([43] of the Opponents' 1<sup>st</sup> SD); and
- (iii) Asian X Games from 2005 to 2014 ([55] of the Opponents' 1<sup>st</sup> SD).

49 On the other hand, athletes sponsored by the Opponents (in general see ([86] – [106] of the Opponents' 1<sup>st</sup> SD) include:

- (i) Michael Schumacher for the period March 2010 – 2012 ([86(b)] of the Opponents' 1<sup>st</sup> SD);
- (ii) Ricky Carmichael since January 2006 ([89] of the Opponents' 1<sup>st</sup> SD); and
- (iii) Jeremy McGrath since 2007 ([103] of the Opponents' 1<sup>st</sup> SD)

Again, the relevant date of 18 October 2012 has to be taken into account such that sponsorships which took place after the relevant date are to be disregarded.

50 Despite the extent of sponsorship, critically, the ***Opponents' Earlier Monster Marks*** cannot be found in most of the evidence pertaining to the promotion of the Opponents' marks. Rather, the marks which appeared on a large majority of these promotional items were:

- (i) Monster Energy Composite Mark;
- (ii) Claw Device; and
- (iii) Monster Energy Stylised Mark.

51 Last but not least, most of the evidence tendered in relation to the Opponents' marketing, advertising and promotional efforts took place *outside* of Singapore, and the connection with the local scene is nebulous. In effect, the Opponents deposed that such international events would be broadcast in Singapore (for example, [48(b) and (c)] of the Opponents' 1<sup>st</sup> SD). However there is no need to deal with this issue as ultimately what was marketed and exposed was not the ***Opponents' Earlier Monster Marks***<sup>11</sup>.

### *Monster Army*

52 With regard to Monster Army, the Opponents deposed at [111] of the Opponents' 1<sup>st</sup> SD:

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<sup>10</sup> Again any occurrences after the relevant date of 18 October 2012 are to be disregarded.

<sup>11</sup> Thus, even if the event which was sponsored was F1 conducted in Singapore ([37] of the Opponents' 1<sup>st</sup> SD), the evidence cannot be taken into account.

[111] In addition to sponsoring professional athletes and teams, Monster maintains an amateur sponsorship and athlete development program called *The Monster Army*. More than 360,000 amateur athletes from throughout the world in various extreme sports have applied to be accepted as part of the Monster Army...including 168 people from Singapore prior to 1 October 2012. To date, 214 people from Singapore have applied to be accepted as part of the Monster Army...

[112] Monster supports members of the Monster Army in many different ways, but often includes assistance with gear, training and travel. Members of the Monster Army also typically wear Monster branded gear...Monster's Monster Army website also features an online store that sells clothing and other merchandise bearing the MONSTER marks...

[113] Monster does not have continuous analytical records of the Monster Army website but Google Analytics...shows that...for the period of 1 October 2008 to 1 October 2012, the Monster Army website received more than 1.8 million unique visitors and 1,947 of these unique visitors were residents from Singapore.

53 In relation to the above, the same issues scourge the Opponents. As can be clearly seen from page 245 of Exhibit RCS-28 of the Opponents' 1<sup>st</sup> SD, which shows an excerpt of the Monster Army website, the marks reflected were (i) the Claw Device; and (ii) the Monster Energy Composite Mark. Thus, the above cannot be relied on to support the Opponents' contention of acquired distinctiveness in relation to the ***Opponents' Earlier Monster Marks***<sup>12</sup>.

#### *Music Festivals*

54 The Opponents deposed that the MONSTER Marks also received tremendous exposure internationally via sponsorship of musicians and music festivals which were attended by "thousands" of fans and received further exposure via the internet etc ([115] of the Opponents' 1<sup>st</sup> SD). The Opponents also deposed that their energy drinks were given out during such events ([32] of the Opponents' 1<sup>st</sup> SD). However, without evidence as to the actual MONSTER marks promoted at such events, this does not assist the Opponents.

#### *Website and Social Media*

55 In relation to the Opponents' website and social media strategy, there are four main platforms:

- (i) Website ([117] – [119] of the Opponents' 1<sup>st</sup> SD);
- (ii) Facebook ([120] – [123] of the Opponents' 1<sup>st</sup> SD);
- (iii) You-tube ([124] – [125] of the Opponents' 1<sup>st</sup> SD); and

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<sup>12</sup> It is noted though, that there is a reference to "Monster Energy" in plain at page 245 of Exhibit RCS-28 of the Opponents' 1<sup>st</sup> SD.

(iv) Twitter ([120(i)] of the Opponents' 1<sup>st</sup> SD.

56 Exhibit RCS-29 of the Opponents' 1<sup>st</sup> SD reflects the Opponents' website. Reference is made to page 250 of Exhibit RCS-29 of the Opponents' 1<sup>st</sup> SD, where the Monster Composite Mark is reflected at the bottom left hand side of the page. Other examples include pages 252 and 258 respectively of Exhibit RCS-29 of the Opponents' 1<sup>st</sup> SD, which also reflect the Monster Composite Mark.

57 Exhibit RCS-32 of the Opponents' 1<sup>st</sup> SD reflects the Opponents' Facebook page (page 270 of Exhibit RCS-32 of the Opponents' 1<sup>st</sup> SD), YouTube page (page 273 of Exhibit RCS-32 of the Opponents' 1<sup>st</sup> SD<sup>13</sup>) and Twitter page (page 274 of Exhibit RCS-32 of the Opponents' 1<sup>st</sup> SD).

58 The excerpts in Exhibits RCS-32 and 33 reflect mainly the Monster Energy Composite Mark although I note that there is some reference to variants of "MONSTER" *simpliciter* (for example at page 273 of Exhibit RCS-32 of the Opponents' 1<sup>st</sup> SD - "MONSTER ENERGY" and at page 283 of Exhibit RCS-33 of the Opponents' 1<sup>st</sup> SD - "MONSTER ARMY").

59 It is noted that the printouts in Exhibit RCS-32 were dated 18 December 2014, except for the YouTube pages, which were undated. On the other hand, some of the YouTube excerpts, for example, page 281 of the Opponents' 1<sup>st</sup> SD at Exhibit 33, was dated 7 March 2013.<sup>14</sup>

60 Regardless of the dates of the excerpts, critically, they do not assist the Opponents for the reason that, in the main, the marks portrayed were (i) the Claw Device; and (ii) the Monster Energy Composite Mark.

61 Further, as pointed out by the learned Assistant Registrar in *Mixi* ([152]:

[152]...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 ...

[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

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<sup>13</sup> See also for example, page 281 of Exhibit RCS-33 of the Opponents' 1<sup>st</sup> SD.

<sup>14</sup> Or 3 July 2013; in either case, it is after the relevant date of 18 October 2012.

*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.*

[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.

[Emphasis in *italics* in the original]

62 I agree. Thus page 260 of Exhibit 30 of the Opponents’ 1<sup>st</sup> SD which pertains to a CNBC report entitled *The World’s Most Liked Brands* referring to the top 10 most “liked” brands on Facebook ([121] of the Opponents’ 1<sup>st</sup> SD - the report was dated 17 May 2012 (see page 262) even though the printout was dated 24 June 2013) does not assist the Opponents as well.

*Magazine / Trade Publications*

63 With regard to exposure of the Opponents in magazine and trade publications, the Opponents deposed ([126] of the Opponents’ 1<sup>st</sup> SD):

[126] In addition, a number of...articles have been published in internationally circulated magazines describing and referring to the *MONSTER energy drinks* and to the success of the Monster and the MONSTER ENERGY products, all of which have featured the *MONSTER marks and [the Claw Device]*...

...

[129]...Much of the content is available online on beverage.com. Monster has advertised the *MONSTER energy drinks* in these magazines since the launch in April 2002...

[Emphasis in *italics* mine]

64 The Opponents proceeded to list a number of publications (one of which was dated after the relevant date of 18 October 2012 – see [126(j)]), which were included in Exhibit RCS-34 of the Opponents’ 1<sup>st</sup> SD. I have scrutinised Exhibit RCS-34 of the Opponents’ 1<sup>st</sup> SD. Once again, it is clear that the main mark that was portrayed is the Monster Energy Composite Mark:

- (i) Page 288 of Exhibit RCS-34 of the Opponents’ 1<sup>st</sup> SD is an excerpt of *The Wall Street Journal* dated 3 June 2003. The article is entitled “A Real Advertising Vehicle” and referred to the monorail. The monorail reflects a combination of the Monster Energy Composite Mark as well as Monster Energy Stylised Mark. The *Opponents’ Monster Energy Marks* were nowhere in sight.

- (ii) Page 293 of Exhibit RCS-34 of the Opponents' 1<sup>st</sup> SD is an excerpt of *Beverage World* dated June 2004. The article reflects the Opponents' energy drink, and the Monster Energy Composite Mark on the cans<sup>15</sup>.
- (iii) Page 295 of Exhibit RCS-34 of the Opponents' 1<sup>st</sup> SD is an excerpt of *Business Week* dated 6 June 2005. It reflects two individuals holding the Opponents' energy drinks. The cans reflect the Monster Energy Composite Marks<sup>16</sup>. The individuals were both wearing shirts with the Claw Device.

The point is, the *Opponents' Earlier Monster Marks* were not reflected in these publications. This is quite different from referring to the Opponents as "Monster" as can be seen in the title of *Business Week Online* dated 4 January 2006 (page 302 of Exhibit RCS-34 of the Opponents' 1<sup>st</sup> SD).

### *Monster Train*

65 The Opponents deposed that in 2003, the Opponents signed a \$10 million deal to sponsor the MONSTER train, the first multi-car train on the Las Vegas monorail ([130] – [132] of the Opponents' 1<sup>st</sup> SD):

[130]...The train was named after [MONSTER energy drink] and prominently featured the [*Claw Device*] and the *MONSTER Marks*...

[Emphasis in *italics* mine]

66 I refer to Exhibit RCS-35 of the Opponents' 1<sup>st</sup> SD at pages 309 and 310 which depicted the body of the train. It is clear that the marks which were reflected were the Monster Energy Composite Mark as well as the Monster Energy Stylised Mark.

67 With regard to the promotional materials / advertising analysis:

- (i) Brochure relating to the train (page 321 of Exhibit RCS-36 of the Opponents' 1<sup>st</sup> SD);
- (ii) News excerpt relating to the train (page 323 of Exhibit RCS-37 of the Opponents' 1<sup>st</sup> SD);
- (iii) List of articles published on the internet which featured the train (page 329 of Exhibit RCS-38 of the Opponents' 1<sup>st</sup> SD);
- (iv) Fact sheet from the webpage [www.ivmonorail.com](http://www.ivmonorail.com) which featured the train ride (page 341 of Exhibit RCS-39 of the Opponents' 1<sup>st</sup> SD); and
- (v) A copy of Las Vegas Monorail Train Advertising Value Analysis (page 347 of Exhibit RCS-41 of the Opponents' 1<sup>st</sup> SD).

Item (i) reflected Monster Energy Composite Mark 2 while item (ii) featured the train and thus the comments with regard to the marks as applied onto the train (above) apply. Item

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<sup>15</sup> Although for one of the cans, there is the word "LO.CARB" after the Claw Device.

<sup>16</sup> Again, for one of the cans, there is the word "LO.CARB" after the Claw Device.

(iii) made reference to “Monster Energy”. Items (iv) and (v) merely referred to “Las Vegas Monorail”. Clearly all the items above do not assist.

68 The Opponents also attempted to connect the train to Singapore by tendering a fact sheet based on data from various entities, including the *US Department of Commerce*, the *Office of Travel & Tourism Industries*, the *In-Flight Survey of International Travellers to the US*, and the *Las Vegas Convention and Visitors Authority* seeking to show the extent of foreign visitors who travelled to Las Vegas (page 345 of Exhibit RCS-40 of the Opponents’ 1<sup>st</sup> SD)<sup>17</sup>. It is observed that there was no specific mention of Singapore in the list of countries from which the visitors originated. Clearly, there is insufficient evidence to connect the “MONSTER train” back to Singapore.

#### *Point of Sale Items*

69 The Opponents also sought to tender evidence of the various point of sale items (page 349 of Exhibit RCS-42 of the Opponents’ 1<sup>st</sup> SD which is a copy of the 2012 Point of Sale catalogue). Examples include:

- (i) Hoodie and T-shirt (page 353 of Exhibit RCS-42 of the Opponents’ 1<sup>st</sup> SD) which showed the Monster Energy Composite Mark; and
- (ii) Bottle cap opener (page 381 of Exhibit RCS-42 of the Opponents’ 1<sup>st</sup> SD) which reflected the Claw Device.

The same comment applies, that is, the *Opponents’ Earlier Monster Marks* were missing from these items.

70 In light of *all* of the above, the analysis below proceeds on the basis of inherent distinctiveness *only*.

71 The Opponents relied on the High Court decision of *Han’s (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 ([13] OWS1), where Judicial Commissioner Wei (as he then was) gave examples to illustrate the varying distinctiveness of a trade mark:

[61] Returning to the meaning of distinctiveness, the trade mark must necessarily, either inherently or as a result of use, perform the most basic function of distinguishing the goods of the trader from those of his competitors in the marketplace. Some trade marks carry a high level of “inherent distinctiveness” in the sense that these marks will be understood by the public as bearing a trade mark meaning, even if they have not yet been used or promoted to the public. *Invented words are classic examples of such trade marks*. Take, for example, a manufacturer of sailing boats who decides to market the boats under a new trade mark which he has invented. The mark is “ADOGSTY”. It has no meaning at all. Such an invented word mark has a high level of inherent distinctiveness and ability to serve as a trade mark. After all, what else could the word “ADOGSTY” mean when used in relation to the sailing boats?

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<sup>17</sup> Only the data for 2005 is potentially relevant. The figures for 2013 cannot be taken into account.

[62] Another example is a manufacturer who decides to use the mark “*Slow Coach*” for a range of running shoes that he is about to launch. Even though the words and phrase are not newly coined, the meaning has little bearing on the product to which it is to be applied...

[63] Other marks, on the other hand, while possessing the capability to distinguish goods or services in the course of trade, may have low levels of inherent distinctiveness. Often this will be because the mark includes a word or symbol or device that is at least partially descriptive of the goods or service. Alternatively, it may be that the word chosen has a laudatory meaning or some meaning that captures a mood or image of some relevance to the product or service in question. The phrase “*Twinkling Star*”, for example, when used as a trade mark for diamond wedding rings, arguably possesses a low level of inherent distinctiveness, since it captures the idea of the sparkle of the gemstone...

[Emphasis in *italics* mine]


72 Following the above, marks which consist of common English words, which have no relation to the goods of concern, are of *some* level of distinctiveness. But this pales in comparison to marks which consist solely of invented words.

73 Thus, I am of the view that while the *Opponents’ Earlier Monster Marks* are of some level of technical distinctiveness, it is not of such a high level that they “[enjoy] a high threshold before a competing sign will be considered dissimilar to [them]” ([18] of OWS1).

*Visual Similarity*

***Opponents’ Earlier Monster Mark***

74 For ease of reference only, the marks are as follows:

<i>Application Mark</i>	<i>Opponents’ Earlier Monster Mark</i>
	<p>MONSTER</p>

As a preliminary point, the *Opponents’ Earlier Monster Marks* consist simply of a single word while the Application Mark is a composite mark, comprising of both words and a device.

75 To begin with, "...it is important to look at the *differences between the marks* in order to decide whether the challenged mark is able to distinguish itself sufficiently and substantially", *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816 at [26] ([29] of AWS1).

76 The Opponents referred to the principles in relation to the visual similarity of composite marks set out by the Court of Appeal at [62] of *Hai Tong* ([22] OWS1):

[62(c)] The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.

(d) The textual component of a composite mark or sign *could* (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

(i) The two marks or signs in question each contain a similar device. The overall resemblance between them may then be diminished if they bear words which are entirely different from each other.

(ii) The textual component is large, and is in a prominent location in relation to the other components or stands out from the background of the mark or sign.

(iii) The textual component is *in itself* already widely known.

(iv) The composite mark or sign is applied to goods or services marketed or sold primarily through *online* trade channels.

(e) The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:

(i) the device is significant and large;

(ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component; or

(iii) the device component is of a complicated nature.

(f) But usually not where:

(i) the device is simple and will not evoke any particular concept for the average consumer;

(ii) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods; or

(iii) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin.



77 The Opponents argued ([25] of OWS1):

[25]...the Application Mark contains the Opponent’s ‘MONSTER’ mark in its entirety. Although the Application Mark also contains additional features, namely, the word “ICE” and the device component of a “cube-man”, both these features do not serve to adequately distinguish the Application Mark from the Opponent’s ‘MONSTER’ mark for the following reasons:

(i) The dominant and distinctive feature of the Application Mark is the word ‘MONSTER’. The word ‘MONSTER’ does not convey any descriptive meaning and has no allusive quality insofar as the Applicant’s goods and services are concerned.

(ii) The device component of the “cube-man” only serves to reinforce the word component of ‘MONSTER’...The device in the Application Mark is therefore not one that will take away the attention of the average consumer from the words in the Application Mark.

(iii) The textual component in the Application Mark is prominently displayed in comparison to the device component. Emphasis is even given to the word ‘MONSTER’ as it is featured in a completely different font and stylisation in contrast with the other word ‘ICE’.

(iv) That the textual component in the Application Mark is featured in a stylised manner is also irrelevant. As stated in [58] of *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 (“*Sarika (HC)*”), trade mark protection may not be circumscribed simply by tweaking the font or style of the lettering of the word mark, particularly where one had deliberately registered the word mark to represent that the distinctiveness of the mark lies in the word itself.

(v) The word “ICE” in the Application Mark is plainly descriptive and generic of the Applicant’s and hence lacks distinctiveness.

78 On the other hand, the Applicant argued ([25], [34] and [35] of AWS1):

[25] In the present case, the dominant and distinctive element is the “Cube Man” device (the “**Cube Man Device**”). The Cube Man Device is highly distinctive both in the technical and non-technical sense as it is a *unique* and complicated device which is a prominent and eye catching component of the Application Mark. The distinctiveness of *the cube-man device is further emphasized and reinforced by the word “ICE” framed by the square/cube device*, which is a reference to the “ice cube” shape of the Cube Man Device.

...

[34] The Cube Man Device...is complicated and evokes a very specific concept for the average consumer (that is, of an ICE CUBE mascot), and is not a device which

is commonly used in relation to the goods and services in question. Furthermore, *the Cube Man Device will easily be perceived as a mascot of the Applicant and will not be perceived as merely a decorative element.*

[35] *Taken as a whole, the marks are further clearly different in terms of length, structure, and letters.* The Application mark consists of 2 words, 10 letters and the distinctive Cube Man Device. In contrast, the Opponent's MONSTER Marks only consists of 7 letters and one word. *The Application mark is clearly much longer, and completely different structurally as a composite mark.*

[Emphasis in *italics* mine]


79 I am of the view that the marks are not visually similar. As discussed above, the word "monster" is of normal level of distinctiveness. In addition, I agree with the Applicant at [31] of AWS1 that:


[31] ...the additional components of the Application Mark, namely, the inclusion of the word "ICE" backed by a black square/cube device, as well as the distinctive Cube Man Device, are *not insignificant, negligible, or small add-ons* to the Application Mark.

[Emphasis in *italics* mine]

80 These differing elements are effective "to obscure the similarity between [the marks]" ([36] of AWS1) when the Application Mark is viewed as a whole. In this regard, the fact that the word "monster" is present in the Application Mark in its entirety is only one factor to be taken into account and clearly cannot be conclusive ([25] of OWS1).

81 I am of the opinion that the Cube Man Device is unique and stands out even though it is placed at the right hand side of the Application Mark. *Hai Tong* ([25(ii) OWS1) can

be distinguished on the basis that the device in that case (that is, , which is the rose

device in the mark ) is common to the trade, which resulted in the Court of Appeal concluding that the device of the rose in the plaintiff's mark "if anything, underscored the textual component by emphasising the "Rose" portion of "Lady Rose" ([65] – [67] of *Hai Tong*).

82 In the current case, the Cube-Man device is an *invented* device. I agree with the Applicant ([17.3] of Applicant's reply submissions ("AWS2")):

[17.3] As the Cube Man Device is clearly the depiction of a *fictional character*, the device will not be perceived as decorative, and will instead very likely be perceived as a *mascot*.

[Emphasis in *italics* mine]

Thus, I disagree with the Opponents that the Cube Man Device only serves to reinforce the word component of ‘MONSTER’ ([25(ii)] OWS1).

83 Rather, I am of the view that having regard to the *imaginary* nature of the Cube Man Device, the device component is more likely to be perceived as an element indicating commercial origin (*Hai Tong* ([62(f)(iii)] above). The words “ice monster” together with the particular design of the word “ICE” (framed by a black square/cube device which highlights the word “ICE” in white font), further *bolster* the Cube Man Device.

84 With regard to the Opponents’ reliance on *Sarika (HC)*, I stress that it is the design of the word “ice” as a whole and not simply its font *per se* that confers it with some significance.

85 Similarly, in answer to the Opponents’ reliance on *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] SLR 1129 (“*Caesarstone HC*”) that, the principle:

the first part of the mark tends to have a greater visual impact than the final part

is not absolute ([5] of the Opponents’ reply submissions (“OWS2”)), I am of the view that “ice” is of some significance due to its design *as a whole*, that is, the word being framed by a black cube device, thus highlighting the word “ICE” in white font. My conclusion (that ‘ice’ is of some significance) is not made simply due to the fact that it is at the beginning of the Application Mark.

86 In the same vein, in response to the Opponents’ dependence on *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (Court of Appeal) that “ice” being descriptive does not displace any similarity, as mentioned above, the word “ice” must be viewed in totality, together with its design.

### *Conclusion*

87 In conclusion, I agree with the Applicant that taken as a whole, the marks are clearly different in terms of structure, length and letters such that the *Opponents’ Earlier Monster Marks* are visually more dissimilar than similar in comparison to the Application Mark.

### *Aural Similarity*

88 With regard to aural similarity, the Court of Appeal in *Staywell* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component of the mark (“Dominant Component Approach”) and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not (“Quantitative Assessment Approach”).

89 Based on my conclusion with regard to the visual aspect of the marks, I am of the view that the Dominant Component Approach is more appropriate in this case. Nonetheless, it will become apparent that the same result is reached regardless of the approach utilised.

90 In assessing aural similarity, the device in the Application Mark is to be disregarded. Applying the Dominant Component Approach, the distinctive component for the Application Mark (relative to the word “ice”) is “monster” (and I come to this conclusion having regard to the fact that the word “monster” is the second word in the Application Mark). Thus, applying this approach, there is some aural similarity between the marks.

91 Applying the Quantitative Assessment Approach, the marks have more syllables in common than not. The Application Mark consists of 3 syllables “ice-mon-ster” of which two are identical to the ***Opponents’ Earlier Monster Marks***.

#### *Conclusion*

92 In light of the above, regardless of the approach being applied, the ***Opponents’ Earlier Monster Marks*** are aurally more similar than dissimilar in comparison to the Application Mark.

#### *Conceptual Similarity*

93 The Court of Appeal in *Staywell* expounded at [35] as follows:

[35] ...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole...*Greater care is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts...*

[Emphasis in *italics* mine]

94 The Opponents argued ([30] OWS1):

- (i) Given the meaning of the English word ‘monster’, the ***Opponents’ Earlier Monster Marks*** evoke the image of a creature having a strange or frightening appearance and the Application Mark conjures up the very same image.
- (ii) This image is reinforced by the Cube Man Device in the Application Mark. Together with the words ‘ICE MONSTER’, the Cube Man Device will in all likelihood be viewed by the average consumer as an ice version of a monster, or a strange creature in the shape of a cube.
- (iii) The inclusion of the word ‘ice’ or the Cube Man Device in the Application Mark does not alter the fundamental impression being evoked i.e. that of a monster and will only be seen as a variation of the Opponent’s ‘MONSTER’

mark.

95 The Applicant countered ([47] – [51] of AWS1):

[47]...the dominant conceptual identity of the Application Mark is that of the Cube Man Device...The clear and prominent depiction of the Cube Man Device that cannot help but catch the eye, combined with the word “ICE” in the application mark would leave *a clear overall conceptual impression of the Application Mark as that of ice and cold temperatures.*

[48] Furthermore, *the font, stylization and friendly, cartoonish, depiction of the [Cube-Man Device] and the overall style of the Application Mark...all lend towards the idea of friendliness and approachability.*

[49] In contrast, the conceptual identity of the Opponent’s MONSTER Mark is that of a large, frightening creature. The ordinary meaning of the word “MONSTER” is “a large, ugly, and frightening imaginary creature”.

[50] *The concept of ice or cold temperatures, and ideas of friendliness and approachability is entirely missing from the Opponent’s MONSTER Mark.* It is submitted that the figurative and dominant component of the Application Mark, namely, the Cube Man Device, constitutes *a clear distinguishing feature* in relation to the idea of a “large, ugly, frightening imaginary creature”.

[51] In view of the above, it is manifest that the concept of the Application Mark is clearly *different* from the “MONSTER” concept underlying the Opponent’s MONSTER Mark. When considered as a whole, the addition of the dominant and distinctive Cube Man Device serves to clearly and sufficiently distinguish the conceptual identity of the Application Mark.

[Emphasis in *italics* mine]

96 In support, the Applicant referred to the case of *Vedial SA v OHIM — France Distribution (HUBERT)*, Case T-110/01 [2002] ECR II-5275 (“**Hubert**”) (see [32] – [33] of AWS2)<sup>18</sup>:

[59] Accordingly, since the dominant component of the earlier mark, SAINT-HUBERT, and the Christian name 'HUBERT' in the mark claimed have distinct semantic meanings and since, moreover, *the figurative component of the mark claimed, namely the representation of a chef, constitutes a distinguishing feature in relation to the idea of a saint or the name of a place*, it must be held that there is no conceptual similarity between the conflicting marks.

[Emphasis in *italics* mine]

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<sup>18</sup> While this is not a local case, it was referred to by the Court of Appeal in *Staywell*. This is in contrast to the cases sought to be relied on by the parties (see [124] below).

97 At the hearing, the Opponents argued that *Hubert* can be distinguished on the basis that the chef device in that case is more distinctive than the Cube Man Device. Further, the Opponents argued that in *Hubert*, there was the additional word “Saint” while in the current case, the *Opponents’ Earlier Monster Marks* have been totally incorporated into the Application Mark.



98 With regard to *Hubert*, I would say that the chef device in the mark and the Cube Man Device are on par<sup>19</sup>. Marks have to be assessed as a whole and the positioning of the respective devices can only be one of the factors to be taken into account. The same holds true in relation to the additional word “Saint” in *Hubert*. At the end of the day, the relevant marks must be considered as wholes in the comparison exercise<sup>20</sup>.

99 Having regard to the Court of Appeal’s reminder in *Staywell* that *greater care* is needed to uncover the ideas that lie behind and inform the understanding of the mark as a *whole*, I am inclined to agree with the Applicant that:

- (i) The addition of the word “ice” (including the particular architecture of the “ice”) and the Cube Man Device notably altered the impression that may be derived from the Application Mark such that the overall conceptual impression of the Application Mark is dissimilar to that of the *Opponents’ Earlier Monster Marks*.
  - (a) The above elements introduce the concepts of cold and ice cubes, which are absent from the *Opponents’ Earlier Monster Marks*.
  - (b) Importantly, the Cube Man Device (as well as the general stylisation of the words “ice monster”), introduce the concept of friendliness and approachability, which is contrasted with the frightening, scary concept associated with monsters in general and thus the *Opponents’ Earlier Monster Marks*.

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<sup>19</sup> This is in comparison to *Quelle AG v Office for Harmonisation in the Internal Market (Trade Marks and*



*Designs*) (Case T-88/05) [2007] ETMR 62 ([23] AWS2) where the mark (and device) was **MARS** and *Crazy Ron’s Communications Pty Limited v Mobileworld Communications Pty Limited* [2004] FCAFC 196




[26] AWS2) where the mark (and device) was . In these two cases, the size and prominence of the devices relative to the words in the marks are such that they are not comparable to the current case

<sup>20</sup> The Opponents also sought to rely on *Staywell* with regard to the issue of a common element in the marks. However, it does not assist as “Regis” is clearly not a common English word. Importantly, the Court of Appeal was of the view that “Regis” is distinctive in the hotel industry ([31] of *Staywell*).

100 At the oral hearing, the Opponents sought to argue that the Cube Man Device is still a “monster” even if it is a cute one at that. The definition of a monster (above) includes that of a “*mutant*” creature and on that basis the Cube Man Device can perhaps be seen as a “monster”. But it does not detract from the fact that the idea conveyed by the Cube Man Device is still that of a “cute” (even if malformed) creature which clearly deviates from the perception of the **Opponents’ Earlier Monster Marks**, which is that of a creature having a *frightening* appearance as submitted by the Opponents themselves ([30] OWS1 above)<sup>21</sup>.

101 Before I leave this element, the Opponents relied on **Doctor’s Associates Inc v Lim Eng Wah (trading as Subway Niche)** [2012] SGHC 84 (“*Subway*”) (at [31] OWS1), where the High Court held that the defendant’s “SUBWAY NICHE” marks (“



” and “”) were conceptually similar to the plaintiff’s SUBWAY mark, for the purposes of Section 27(2)(b) of the Act ([41] of *Subway*). The Court held that the addition of “NICHE” did not significantly alter the texture of or impression evoked by the subway/train/rail concept ([40] of *Subway*).

102 However, I agree with the Applicant at [36] of AWS2:

[36]...In the case of SUBWAY NICHE...the addition of the “tunnel device”...and the addition of the word NICHE did not significantly alter the...impression evoked by the subway / train / rail concept...

103 Taking all of the above into consideration, I am of the view that the marks are conceptually more dissimilar than similar.

*Conclusion on the similarity of marks*

104 It is to be recalled following **Staywell** at [17] and [18] that:

[17] ... The court must ultimately *conclude* whether the marks, when observed in their totality, are similar rather than dissimilar...

[18] ... *Trade-offs* can occur between the three aspects of similarity in the marks-similarity inquiry...

[Emphasis in *italics* mine]

105 Further, the average consumer has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the essential or dominant features of the marks. However, it is also important to remember that the average consumer is one

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<sup>21</sup> In any event, the **Opponents’ Earlier Monster Marks** being a plain word “Monster” in all likelihood will be understood to allude to the general meaning of a “monster”. In this regard, it is observed that the first entry in the online Oxford Dictionary (above) is “[a] large, ugly, and *frightening* imaginary creature”.

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.

***Opponents’ Earlier Monster Marks***

106 I am of the view that the ***Opponents’ Earlier Monster Marks*** in comparison to the Application Mark is visually and conceptually more dissimilar than similar while there is some aural similarity such that overall, the marks are more dissimilar than similar.

107 Having regard to the 3-step test, my conclusion above ends the inquiry with regard the objection under Section 8(2)(b). However, in light of the extensive arguments and evidence<sup>22</sup> filed in relation to the issue of goods / services similarity, my views are as follows.

*My Opinion (Similarity of Goods / Services)*

108 In relation to this limb, the Court of Appeal in ***Staywell*** at [43] referred to ***British Sugar Plc v James Robertson & Sons Ltd*** [1996] RPC 281 (“***British Sugar***”), and emphasized that the question is how the goods or services are regarded, as a practical matter, for the purposes of trade.

109 For ease of reference, the relevant goods and services are as follows:

S/N	<b><i>Opponents’ Earlier Monster Marks</i></b> <sup>23</sup>		<b><i>Application Mark</i></b>
1	T0605638Z	<u>Class 5</u> Nutritional supplements; vitamin drinks; drinks containing vitamins and minerals.	<u>Class 30</u> Ice, natural or artificial; fruit flavoured water ices in the form of lollipops; cream (ice); fruit ices; ice lollies containing milk; ice lollies being milk flavoured; ice for refreshment; sherbets [ices]; frozen yogurt [confectionery ices]; edible ices; ice confections; ice cubes; flavored ices.
2	T0605639H	<u>Class 32</u> Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.	
3	T1111969F	<u>Class 5</u> Nutritional supplements in liquid form in Class 5.	

<sup>22</sup> This includes the ***Interlocutory Decision*** which allowed for the Opponents’ 4<sup>th</sup> SD as well as the Applicants’ 3<sup>rd</sup> SD to be filed.

<sup>23</sup> As discussed above, only the ***Opponents’ Earlier Monster Marks*** (and thus the goods / services for which they are registered for) will be analysed.



		<u>Class 32</u> Non-alcoholic beverages in Class 32.	<u>Class 43</u> Bar services; cafés; cafeterias; restaurants; self-service restaurants; snack-bars.
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As a preliminary point, I will deal with Class 30 and 43 separately as parties have tendered substantial arguments with regard to Class 43.

110 The Opponents argued that the fact that the goods / services are in different classes does not prevent them from being similar. The Opponents referred to *Redsun Singapore Pte. Ltd v Tsung-Tse Hsieh* [2015] SGIPOS 1 at [52], which cited *Genzyme Corporation v Novozymes Switzerland AG* [2010] SGIPOS 11 at [42] – see [46] of OWS1):

[52]...*the Nice Classification is only a starting point and does not purport to be authoritative in determining whether goods are similar.* The fact that goods are categorised in the same class may indicate that they are similar in nature, *but the actual inquiry has to deal with the specific goods at hand and look beyond the class number.* Likewise, the fact that goods are not in the same class does not necessarily mean that they are not similar goods. That is also the point of cross-searching other potentially related classes in examination practice.

[Emphasis in *italics* mine]

111 I note that in *Caesarstone HC* at [126] to [128], Wei J provided:

[126] Curiously, in the present proceedings, the opponent has chosen not to oppose the CAESARSTONE Mark in the following classes that were specified in the application for registration:

**Class 20...**  
**Class 35...**  
**Class 37...**

[127] No submissions were made as to the relationship between these unopposed classes of goods and services and Class 19 (which attracted opposition), and this issue was not directly before me... The question that may need to be addressed head-on (in an appropriate case) is *whether goods and services could ever be considered as being “similar” under the TMA as presently formulated.* As will be seen, in some jurisdictions such as Australia, the equivalent statutory provisions refer to the concept of “closely-related” goods or services<sup>24</sup>.

<sup>24</sup> Section 44(1) of the Australian **Trade Marks Act 1995**.

[128] Given the *close relationship between the goods and services* in Classes 19, 20, 35 and 37, it is perhaps a little surprising that opposition proceedings were not brought in respect of the registration for Classes 20, 35 and 37<sup>25</sup>...

[Emphasis in *italics* mine]

112 Following from the above, an interesting threshold issue arises as to whether goods / services can ever be considered to be similar, having regard to Section 8 of the Act, in comparison to the corresponding (but differently worded) provision in Australia.

113 Parties did not make any specific submissions in relation to the above point. However, the Opponents sought to rely on the *Guidelines for Examination of European Union Trade Marks, EUIPO* (“*EUIPO Guidelines*”)<sup>26</sup>, which provides for instances where goods and services can be regarded as similar<sup>27</sup>.

114 The relevant provision in the European Union is *Article 8(1) of the Regulation on the European Union Trade mark*, (which is in *pari materia* to Section 8 of the Act)<sup>28</sup>. Having regard to the above, by seeking to apply these *EUIPO Guidelines*, the Opponents seem to *suggest* that there is no threshold issue in this instance<sup>29</sup>. As parties did not make any other submissions on this specific issue, I will proceed on the basis that there is no such threshold issue,<sup>30</sup> and leave it for another occasion for the matter to be ironed out.

115 The relevant test for similarity of goods / services is that laid down in *British Sugar* as endorsed by the Court of Appeal in *Staywell* and the following factors are to be taken into account:

- (i) The respective uses of the goods / services;

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<sup>25</sup> The Opponents sought to rely on this part of the judgment (see [56] of OWS1).

<sup>26</sup> See [52] of OWS1 (below). The *EUIPO Guidelines* was one of the basis on which they sought to adduce the Opponents’ 4<sup>th</sup> SD (see [78] of *Interlocutory Decision*).

<sup>27</sup> The Applicant sought to refute the applicability of the same, specifically, that, the *EUIPO Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services*, Annex II, [5.5], at the 3<sup>rd</sup> paragraph, does *not* apply as the services in Class 43 sought to be registered under the Application Mark are *not integral* to the goods in Class 32 registered under the *Opponents’ Earlier Monster Marks* (see [71] and [72] of the AWS1).

<sup>28</sup> **Relative grounds for refusal:**

**1.** Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

- (a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
- (b) if, because of its identity with, or similarity to, the earlier trade mark and *the identity or similarity of the goods or services* covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

[Emphasis in *italics* mine]

<sup>29</sup> The Applicant only sought to refute the applicability of a particular instance (above). This does not foreclose the possibility of goods / services being found similar in other situations.

<sup>30</sup> In any event, for the purposes of this case, it is to be recalled that I have already concluded above that the objection under Section 8 fails as there is no marks similarity.

- (ii) The respective users of the goods / services;
- (iii) The respective trade channels through which the goods / services reach the market;
- (iv) 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 likely to be found on the same or different shelves;
- (v) How those in trade classify goods, for instance whether market research companies put the goods / services in the same or different sectors.

*Class 32 and Class 5 v Class 30*

116 The Opponents argued ([51] OWS1):

[51] The rest of the Opponent's goods in Classes 5 and 32, in general, fall into the category of beverages and include vitamin drinks, energy drinks, isotonic drinks, fruit juices and soda water. Having regard to the guiding principles above, it matters not that these goods are classified in a different Class from Class 30. *For the same reasons in the preceding paragraph, it is submitted that the Applicant's Class 30 goods are similar to the Opponent's goods in Classes 5 and 32. The uses and likely users are the same / similar. Both sets of goods are again complementary.*

[Emphasis in *italics* mine]

117 In [50] of OWS1, the Opponents had submitted that the goods in Class 30 for both the Application Mark as well as the **Opponents' Earlier Marks**<sup>31</sup>:

- (i) Serve the common purpose of quenching thirst;
- (ii) Reach consumers and are available through two similar trade channels:
  - (a) via food and beverage establishments such as restaurants etc. and are commonly displayed in the same menu;
  - (b) in a packaged form, both are mass market self-serve consumer products readily available at supermarkets etc.
- (iii) Are complementary for eg. ice is frequently added to tea to make ice tea etc.

118 On the other hand, the Applicant submitted ([68] of AWS1):

[68] With regard to the remaining goods under Class 5...and 32 of the Opponent's Marks as compared against the Applicant's Class 30 goods, it is submitted that these goods in general relate to *beverages*, and are in no way similar to the goods protected under Class 30, which are *ices*. To support the dissimilarity, we would apply the **British Sugar** factors as follows:

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<sup>31</sup> The Opponents' marks which are registered for Class 30 are the **Opponents' Earlier Monster Prefix Marks** which are not taken into account (above).

<b>British Sugar Factors</b>	<b>Opponent's Goods<sup>32</sup></b>		<b>Applicant's Goods</b>
	<b>Class 5</b>	<b>Class 32</b>	<b>Class 30</b>
<b>Uses</b>	Medicinal and/or nutritional	<i>Drinks including Energy Drink</i>	As a dessert
<b>Users</b>	Health conscious consumers	Consumers requiring replenishment <i>including that of energy or nutrients</i>	Consumers craving desserts
<b>Physical nature</b>	Liquid form or pill form	Liquid form	Solid or semi-solid form
<b>Trade channels</b>	Health food stores Convenience stores supermarkets	Convenience stores Supermarkets <i>as well as cafés and restaurants etc</i>	<i>In the main Exclusively Cafés and restaurants but also including Convenience stores Supermarkets</i>
<b>Nature of goods as Consumer items?</b>	Health supplement	<i>Drinks including Energy Drink</i>	Dessert
<b>Substitutability?</b>	Not substitutes	Not substitutes	Not substitutes

119 I am of the view that the Opponents' argument above that the goods in Classes 5, 30 and 32 all "serve the common purpose of quenching thirst" is too broad a categorisation. If this characterisation is used, it would catch too many items across the Nice Classification<sup>33</sup>. I am more inclined to accept the Applicant's application of the principles in **British Sugar**, subject to the modifications as indicated in *italics* and as *tracked* above.

120 Having regard to the different uses, users, physical nature and the different shelves / sections (the products will be placed) in supermarkets and the different parts of the menus (the products will be listed) in cafés etc even if they are both sold via convenience stores / cafés, the goods are more dissimilar than similar (especially for Class 5<sup>34</sup>).

121 Last but not least, with regard the Opponents' argument that the goods are complementary, I do not think it necessarily mean that they are similar. Taking the factors in **British Sugar**, ice cubes and, for example, fruit juices: (i) the uses are different - the

<sup>32</sup> As indicated above, only those goods registered under **Opponents' Earlier Monster Marks** will be analysed.

<sup>33</sup> For example, (i) milk products in Class 29; and (ii) coffee / tea in Class 30.

<sup>34</sup> The uses, users as well as the shelves on which they are placed in the convenience stores are different, amongst others.

beverage is to quench thirst while the ice cubes are to chill the drink; (ii) the trade channels are different; and (iii) they are found on different shelves in the supermarket.

*Class 32<sup>35</sup> v Class 43*

122 In relation to this issue, the Opponents argued ([52] of OWS1):

[52] As for the Applicant’s Class 43 services, it is submitted that they are similar to the Opponent’s goods in all the classes which, in general, fall into the category of beverages. First of all, the very definition of a ‘café’ and ‘restaurant’ according to the online Merriam-Webster dictionary...is ‘*a small restaurant where you can get simple meals and drinks (such as coffee)*’ and ‘*a business establishment where meals or refreshments may be purchased*’ respectively. Therefore, food and beverages are **integral** to the provision of restaurant, café, cafeteria and bar services<sup>36</sup>. Such services cannot exist without food and beverages.

...

[57] The close relationship between food and beverages and Class 43 services is also apparent in the market as evidenced by the Internet printouts annexed to [the Opponents’ 4<sup>th</sup> SD]. ***The Internet printouts demonstrate that it is common practice for food and beverage establishments to also provide food and beverages using the same trade mark.***

[Emphasis in *italics* and **bold** mine]

123 I am inclined to agree with the Opponents that there is some similarity between the goods in Class 32 and the services in Class 43. In particular, I am of the view that there is similarity between the specific items *italicised* below:

S/N	<i>Opponents’ Earlier Monster Marks<sup>37</sup></i>		<i>Application Mark</i>
1	T0605638Z	<u>Class 5</u> Nutritional supplements; vitamin drinks; drinks containing vitamins and minerals.	<u>Class 43</u> <i>Bar services; cafés; cafeterias; restaurants; self-service restaurants; snack-bars.</i>
2	T0605639H	<u>Class 32</u> <i>Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.</i>	

<sup>35</sup> It is clear that Class 5 is not similar to Class 43 and thus will not be dealt with here.

<sup>36</sup> Applying the *EUIPO Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services*, Annex II, [5.5], at the 3<sup>rd</sup> paragraph.

<sup>37</sup> As discussed above, only ***Opponents’ Earlier Monster Marks*** (and thus the goods / services for which they are registered for) will be analysed.

3	T1111969F	<u>Class 5</u> Nutritional supplements in liquid form in Class 5.	
		<u>Class 32</u> <i>Non-alcoholic beverages in Class 32.</i>	

124 However, the Applicant argued at [70] – [75] of AWS1 that:

- (i) the Opponents’ 4<sup>th</sup> SD does not assist the Opponents’ cause as the ***Opponents’ Earlier Marks***<sup>38</sup> do not include any Class 43 services;
- (ii) the Applicants’ 3<sup>rd</sup> SD:
  - (a) show that the goods of a beverage manufacturer are, instead, often distributed by third parties.
  - (b) the Opponents do not intend, and in fact had never intended, for the beverages which they protect under Class 32 to be sold through restaurants, bars and/or cafés.
- (iii) the Opponents have provided no evidence of any restaurant or bar business, and have not obtained any trademark protection for the same. The Opponents have further provided no evidence that they will enter into a café or restaurant business.

125 I agree that the ***Opponents’ Earlier Monster Marks*** do not include any Class 43 services. But in my view, that does not prevent the applicability of the Opponents’ 4<sup>th</sup> SD. From a literal reading, the evidence is “neutral” in relation to the current issue; it merely provides information as to the different locations of the cafés, products as well as promotions. It does not indicate whether the owners had decided to open a café first, before developing the products or vice versa, with one exception – see Boost at page 87 of Exhibit RCS-1 of the Opponents’ 4<sup>th</sup> SD):

### **A History**

*Boost Juice Bars™ was born in 2000 in sunny Australia, when Janine Allis (mum of three) decided there was a lack of healthy options out there for her and her kids...following a trip to the U.S. she noticed that Juice Bars were popping up everywhere. So upon returning to Australia she developed a business plan and raised \$250,000 through friends investing in the concept to get the plan underway. The first store opened in Adelaide in 2000...*

[Emphasis in *italics* mine].

126 My reading of the excerpt above is that the original intent and purpose was to provide the specific beverage, before a bar / café was opened as an avenue to sell the drinks. Even

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<sup>38</sup> Which includes the ***Opponents’ Earlier Monster Marks***.

if I am wrong, and the above example is to be disregarded, as mentioned above, the Opponents' 4<sup>th</sup> SD would at most be considered as "neutral".

127 It is to be remembered that in opposition matters, there is a need to take into account the *whole notional specification* registered under the **Opponents' Earlier Monster Marks**. Thus, while the Opponents have thus far mainly dealt with, in particular, energy drinks<sup>39</sup>, it does not prevent them from expanding into other types of *beverages*, a plain reading of which would include both ready-to-drink beverages<sup>40</sup> *as well as* beverages for immediate consumption.

128 It is to be recalled that the crux with regard the issue of goods / services similarity is how the trade views the same (*Staywell* at [43] above). In the marketplace, a manufacturer of beverages may logically open a café under the same trade mark as the beverages that he / she created. While the opening of such an outlet is integral for beverages for immediate consumption, it would not be far-fetched for ready-to-drink beverages to be sold via such an outlet as well. The manufacture of beverages and the provision of an outlet to sell and serve the same can be contemporaneous. Alternatively, for ready-to-drink beverages, the manufacturer may eventually do that once the beverages gained sufficient popularity.

129 Both parties sought to tender cases from other jurisdictions to support their stance. In addition, the Opponents sought to adduce cases where they successfully enforced their marks against other monster-variant marks. I do not think it is necessary to dwell into these cases as they are not binding on me<sup>41</sup>. These cases do show, however, that depending on the actual circumstances, an earlier mark relating to beverages can be considered to be similar to a *later* mark relating to the running of an outlet, for example, a café.

130 With regard to the Applicant's 3<sup>rd</sup> SD, in particular the Opponents' *Annual Report 2015* (page 242 – page 361 of Exhibit 12 of the Applicant's 3<sup>rd</sup> SD), the excerpt relied on by the Applicant only reflect the Opponents' *current status*<sup>42</sup>. Based on the excerpt alone, I do not agree that it shows that "the Opponent *does not intend*...for the beverages which it protects under Class...32 to be sold through...cafés". The Applicant referred to, for example, page 250 of Exhibit 12 of the Applicant's 3<sup>rd</sup> SD ([73] of AWS1):

## **PART I**

### **1. Business Reportable Segments**

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<sup>39</sup> See below.

<sup>40</sup> It would appear that while the Opponents' main product is energy drinks, they also deal with a minute quantity of ready-to-drink beverages such as tea / juices (see pages 250 and 254 of Exhibit 12 of the Applicants 3<sup>rd</sup> SD; although as the Annual Report is for 2015, it is only indicative of the situation as at 18 October 2012. See also [3] of the Opponents' 1<sup>st</sup> SD).

<sup>41</sup> With regard to the Opponents' success in other jurisdictions, as submitted by the Applicant, not only are the laws different from Singapore, in addition, in the current case the Opponents are not pursuing an opposition under Section 8(4) which is an objection based on the extent of the Opponents' fame. This may not be the case in the Opponents' other enforcement actions overseas ([40.4] AWS2).

<sup>42</sup> As at 2015, since the *Annual Report* is for the year 2015.

Our Finished Products segment generates net operating revenues by selling ready-to-drink packaged energy drinks to full service beverage distributors, retail grocery and specialty chains, wholesalers, club stores, drug chains, mass merchandisers, convenience chains, health food distributors, food service customers and the military.

131 There is nothing in the paragraph which describes any impending intention. The above (that the Opponents had, in the main, only dealt with energy drinks thus far) *may* explain why the Opponents currently do not have a Class 43 registration. Clearly, it is open for them to make such an application in the future<sup>43</sup>.

132 While this allows the Opponents to rely on specifications which have yet been used, ultimately, the onus is on the Opponents to ensure that the items are commercialised or they may be open to a revocation action based on non-use.

133 Applying *Staywell*, in relation to Class 43, I am of the view that there is similarity between the specified items in Class 32 and 43 as *italicised* below:

S/N	<i>Opponents' Earlier Monster Marks</i> <sup>44</sup>		<i>Application Mark</i>
2	T0605639H	<u>Class 32</u> <i>Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.</i>	<u>Class 43</u> <i>Bar services; cafés; cafeterias; restaurants; self-service restaurants; snack-bars.</i>
3	T1111969F	<u>Class 32</u> <i>Non-alcoholic beverages in Class 32.</i>	

### *Conclusion*

134 Thus with regard to this element, there is similarity of goods / services as highlighted above between the specific goods in Class 32 and services in Class 43.

### *Closing thoughts*

135 In any event, regardless of my conclusion above, the ground of opposition under Section 8(2)(b) *fails* as the first element (similarity of marks) has *not* been made out.

<sup>43</sup> The same response also applies to the argument that the status as at 2015 (via the Annual Report) shows that the Opponents had not ventured into Class 43 services thus far. It is open for them to do so until a revocation based on non-use action is launched against them (below).

<sup>44</sup> As discussed above, only *Opponents' Earlier Monster Marks* (and thus the goods / services for which they are registered for) will be analysed.



136 **Ground of Opposition under Section 8(7)(a)**

137 Section 8(7)(a) of the Act reads:

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

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

***Decision on Section 8(7)(a)***

138 In relation to this ground, there are three elements to be established:

- (i) Goodwill;
- (ii) Misrepresentation; and
- (iii) Damage.

139 A widely-quoted description of goodwill is as follows (see ***The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited*** [1901] AC 217, referred to in *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon (“***Law of Intellectual Property of Singapore***”) at [17.1.1]):

It is the benefit and advantage of the good name, reputation, and connection of a business. *It is the attractive force which brings in custom.* It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing *unless* it has a power of attraction sufficient to bring customers home to the source from which it emanates.

[Emphasis in *italics* mine]

140 It is important to focus on goodwill in Singapore as the Court of Appeal in ***Staywell*** at [136] has clarified that the Singapore approach, unlike other jurisdictions like Australia, is still the “hardline” approach, albeit such an approach having been softened by ***CDL Hotels International Ltd v Pontiac Marina Pte Ltd*** [1998] 1 SLR(R) 975 to include pre-trading activity.

141 It is important to note that the Opponents must establish that they have acquired goodwill as at the *relevant date* and this date is the date on which the defendant's conduct complained of started: ***Law of Intellectual Property of Singapore*** at [17.2.5]. Applying this principle to the current case, the relevant date in this instance is the date of application of the Application Mark which is 18 Oct 2012.

142 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) held:

(1) Goodwill, in the context of passing off, was concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue of *whether a mark or get-up was distinctive* of the plaintiff’s products or services was a question best dealt with in the context of the inquiry as to whether the defendant had made a misrepresentation.

[Emphasis in *italics* mine]

143 In relation to proving goodwill, the Court of Appeal provided in *Singsung* at [58]:

[58] *Evidence of sales* and income of the business are a “proxy for the attractive force of the business”...

[Emphasis in *italics* mine]

144 Further, it is clear that under the law the “get up” can include *various* aspects of the business, *including* a mark, (see *Law of Intellectual Property of Singapore* at [17.2.10] – [17.2.11]):

[17.2.10]: The action for passing off is no longer anchored...to the name or trade mark of a product or business...The real issue is not what type of indicia is employed by the plaintiffs to market his goods or services, but whether the relevant public associates the indicia exclusively with the plaintiff’s goods or services.

[17.2.11] The *different types of indicia* used by the traders to distinguish their products or services are sometimes known generically as “*get-up*”...

[Emphasis in *italics* mine]

Examples of such indicia include “a brand name or a trade description, or the individual features of labelling or packaging” see *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 at [499].

145 Last but not least, the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 (“*Rovio*”) at [164] clarified as follows:

[164] Having considered the statutory language of s 8(7)(a) of the TMA and the limited authorities on the matter, I am of the view that s 8(7)(a) of the TMA at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie case* on goodwill, misrepresentation, and damage...

[Emphasis in **bold** mine]

146 In relation to goodwill, I have already set out my views above on the Opponents’ sales and promotional figures in Singapore. Bearing in mind the Court’s guidance in *Rovio*, I am prepared to accept that the Opponents have the relevant goodwill in Singapore.

*Misrepresentation*





147 In relation to this element, the Court of Appeal in *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 held that:

(20) ...the findings for the misrepresentation requirement were in turn based on the finding of a likelihood of confusion under s 27(2)(b) TMA...

148 As alluded to above, in an action in passing off, it is permissible for the Opponents to rely on their *get-up* (which includes the **Opponents’ Earlier Monster Marks**). I have already commented on the Opponents’ evidence with regard to the issue of *de facto* distinctiveness above. In essence, the bulk of the evidence tendered by the Opponents (via the Opponents’ 1<sup>st</sup> SD) pertain to the following marks:

- (i) the Monster Energy Composite Mark;
- (ii) the Claw Device; and
- (iii) Monster Energy Stylised Mark.

149 For ease of reference, the marks are reproduced again as follows:

<i>Application Mark</i>	<i>Opponents’ Earlier Monster Mark</i>
	<b>MONSTER</b>
	<i>Monster Energy Composite Mark</i>
	
	<i>Claw Device</i>
	
	<i>Monster Energy Stylised Mark</i>
	

150 As deposed by the Opponents themselves at [20] of the Opponents’ 1<sup>st</sup> SD:

[20]...The “MONSTER image” needs to appeal to Monster’s target market of young adults aged 18 – 34 years old, primarily males. *The image of the MONSTER energy drinks is therefore “edgy and aggressive”...*

[Emphasis in *italics* mine]

The frightening and aggressive aspect of a monster is clearly encapsulated by the Claw Device and the Monster Energy Stylised Mark which makes up the Monster Energy Composite Mark.

151 The above can hardly be said to be similar, and indeed stands in stark contrast to the Application Mark. As alluded to above under the issue of conceptual similarity, with regard to the Application Mark:

- (i) The addition of the word “ice” and the Cube Man Device introduce the concept of cold and ice cubes; and
- (ii) The Cube Man Device (as well as the general stylisation of the words “ice monster”) also introduces the concept of friendliness and approachability.

These concepts are the antithesis of the frightening, aggressive notions portrayed by the Opponents’ three marks above.

152 In addition, the Opponents had mainly dabbled with, specifically, energy drinks in Singapore (above). The Opponents deposed ([12] of the Opponents’ 1<sup>st</sup> SD):

[13] *My Company launched sales of its MONSTER energy drinks in Singapore in October 2012...Since the launch in Singapore in October 2012<sup>45</sup> through 31 December 2014, my company has sold more than 2.2 million cans of MONSTER energy drinks bearing one or more of the MONSTER marks in Singapore, amounting to sales of approximately US\$2.1 million.*

[Emphasis in *italics* mine]

The above is corroborated by invoices and shipping documents (see Exhibit RCS-3 of the Opponents’ 1<sup>st</sup> SD, referred to at [38] and [39] above).

153 I have earlier opined that in relation to the issue of goods / services similarity, only the specific goods / services of the parties (indicated in *italics* below) are similar:

S/N	<i>Opponents’ Earlier Monster Marks</i> <sup>46</sup>	<i>Application Mark</i>
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<sup>45</sup> As mentioned, any sales after the relevant date of 18 October 2012 will be disregarded.

<sup>46</sup> Even though only the *Opponents’ Earlier Monster Marks* (and thus the goods / services for which they are registered) were analysed, it is inconsequential as it can be seen that energy drink as an item was not found to be similar to the specifications in Classes 32 and 43 sought to be registered for the Application Mark.

2	T0605639H	<u>Class 32</u> <i>Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.</i>	<u>Class 43</u> <i>Bar services; cafés; cafeterias; restaurants; self-service restaurants; snack-bars.</i>
3	T1111969F	<u>Class 32</u> <i>Non-alcoholic beverages in Class 32.</i>	

It is clear that energy drinks are *not* similar to both the Applicant's specifications in Classes 32 and 43.

154 Taking into account the extent of dissimilarity in the marks and the differences in the goods / services proffered by the parties, I am of the view that, on a balance of probabilities, there is no likelihood of misrepresentation that the Applicant and the Opponents are one and the same or that they are economically linked.

*Damage*

155 As I have found that the element of misrepresentation has not been made out, there is no need for me to look into the element of damage.

*Conclusion*

156 The ground of opposition under Section 8(7)(b) therefore fails.

**Conclusion**

157 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. Accordingly, the Application Mark shall proceed to registration. The Applicant are also entitled to costs to be taxed, if not agreed.

Date of Issue: 2 November 2017

[The appeal from this decision to the High Court was dismissed.]