

# Intellectual Property Office of Singapore Case Summary: Monster Energy Company v NBA Properties, Inc. [2018] SGIPOS 16

Source: <https://www.ipos.gov.sg/protect-ip/hearings-mediation/legal-decisions>

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Monster Energy Company (“the Opponent”) is the owner of various trade marks registered in Singapore, where it has sold energy drinks under the “MONSTER” and “MONSTER ENERGY” brands since 2012. Two of the Opponent’s Singapore trade marks include a Claw Device Mark and a Composite Mark, which have been registered in respect of a wide range of goods (including sunglasses, printed matter and clothing) in addition to beverages. The Opponent opposed the registration of a trade mark by NBA Properties Inc (“the Applicant”), the marketing and licensing arm of the National Basketball Association (NBA) which operates a North American men’s professional basketball league. The Applicant had sought to register a composite mark comprising a graphical device encircled with the words “TORONTO RAPTORS” (“the Application Mark”), the team name of one of the members of the NBA basketball league.

Applicant’s Application Mark	Opponent’s (Earlier) Claw Device Mark	Opponent’s (Earlier) Composite Mark
		

The Opponent objected to the registration of the Application Mark on a number of different statutory grounds: (1) Section 8(2)(b) – that the Application Mark was similar to the Opponent’s trade marks, in respect of similar or identical goods or services, the result of which was a likelihood of consumer confusion; (2) Sections 8(4)(b)(i) and 8(4)(b)(ii) – that the Application Mark was similar to the Opponent’s trade marks, which were allegedly “well known in Singapore” or “well known to the public at large in Singapore”, such as to either damage the interests of the Opponent by indicating a connection between the Applicant’s goods or services and the Opponent, dilute the distinctive character of the Opponent’s trade marks in an unfair manner or take unfair advantage of the distinctive character of the Opponent’s trade marks; and (3) Section 8(7)(a) – that the use of the Application Mark was liable to be prevented in Singapore by the tort of passing off. All of these grounds of opposition hinged on a finding of “similarity” between the Application Mark and the Opponent’s earlier trade marks.

The IP Adjudicator found that the Application Mark and the Opponent’s earlier trade marks were dissimilar, both visually and conceptually, such that none of these grounds of opposition could be sustained. The Opponent’s Claw Device Mark depicted a menacing three-pronged jagged scar produced by an unidentified feral creature, while the graphical device in the Application Mark depicted a three-pronged claw (presumably the claw of a velociraptor) clutching a basketball. In the IP Adjudicator’s view, a mere similarity in the subject matter of the competing marks (i.e. the three-pronged claw-shaped devices with jagged edges) was not sufficient to establish visual similarity for the purposes of opposing the registration of a trade mark. The IP Adjudicator also made general observations about how the knowledge of the average consumer and evidence of consumer awareness of the meaning of the words incorporated into a trade mark ought to be relevant to the mark-similarity analysis in trade mark opposition proceedings. Applying a contextual approach towards evaluating what the average consumer might see when looking at the trade mark, or how he is likely to understand or interpret its components, the IP Adjudicator took the view that adopting the average consumer’s perspective in assessing whether or not the Application Mark was similar to the Opponent’s earlier trade marks made it appropriate to take into consideration those surrounding circumstances that are relevant towards establishing the general knowledge possessed by the average consumer.

The opposition proceedings brought by the Opponent were therefore unsuccessful.

*Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2018/monster-energy-v-nba-properties-2018-sgipos-16.pdf?sfvrsn=0>.*