

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

Trade Mark No. 40201810156W
1 September 2021

**IN THE MATTER OF A TRADE MARK APPLICATION BY
HEALTH AND HAPPINESS (H&H) HONG KONG LIMITED**

AND

**OPPOSITION THERETO BY
MONSTER ENERGY COMPANY**

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

Representation:¹

Mr Anan S. Sivananthan and Mr Mok Ho Fai (Bird & Bird ATMD LLP) for the Opponent

Mr Tan Sin Su (Quality Oracle Pte. Ltd.) for the Applicant²

GROUND OF DECISION

Introduction

1 This trade mark opposition was commenced by Monster Energy Company (the “Opponent” or “MEC”) against a trade mark application filed by Health and Happiness (H&H) Hong Kong Limited (the “Applicant”).

2 Both sides filed their pleadings and evidence in accordance with the usual procedure. However, when the case was set down for a hearing, the parties elected to be heard solely “on paper” without an oral hearing in order to save costs.³ Guidance as to this option is provided for in HMD Circular 5.2 at Paragraph F, which explains that parties that prefer a written decision without a hearing may make such a request as the Registrar “*may, without proceeding*

¹ There was no oral hearing. The decision is made on the basis of the Opponent’s written submissions only. (See [2] of this decision.)

² The Applicant did not file any written submissions. (See [2] of this decision.)

³ That is, on the basis of the pleadings, evidence and any written submissions.

with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit” (see rule 37(4) of the Trade Marks Rules (Cap. 332, R1) (“TMR”). The parties’ choice to have a written decision without a hearing was endorsed by the Registrar, and the parties were given timelines to file written submissions. The Opponent did so. The Applicant did not, explaining in a letter that it was unable to allocate further financial resources to the dispute.⁴


3 The applicable rules do not penalise a trade mark applicant for not tendering written submissions in the context of a trade mark opposition: see rule 37(2) TMR. This is different from a situation where no counter-statement or evidence is filed: see rules 31(3) and 31A(9) TMR, which may lead to the trade mark application being treated as withdrawn. Although the Applicant did not have the benefit of submissions put forward on its behalf, its position on the key issues is sufficiently clear from the pleadings and evidence filed.

Statutory declarations

4 The Opponent’s evidence was set out in a statutory declaration (“SD”) of its chairman and CEO, Rodney Cyril Sacks (hereafter the “Opponent’s SD”). The Applicant’s evidence was set out in a SD of its director, Laetitia, Marie, Edmée, Jehanne Albertini ép. Garnier (hereafter the “Applicant’s SD”). The Opponent did not file evidence in reply. Since there was no cross-examination, the aforementioned SDs formed the entirety of the evidence before me.

Background

5 On 31 May 2018, the Applicant filed to register the mark set out in the table below (the “Application Mark”). Based on the Applicant’s SD, it appears that the Application Mark was used in connection with “Noisy Beast”, a full-service communications agency which provides customised services such as sales promotion, marketing and advertising. This company was founded in 2012 and is headquartered in Collingwood, Victoria, Australia.

Application Mark	TM No.	Class and specification of services
	40201810156W	<u>Class 35</u> <i>Sales promotion for others; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising; Commercial intermediation services; Organisation of exhibitions for commercial or advertising purposes; Provision of commercial and business contact information; Market studies; Business management and organization consultancy; Marketing; Negotiation and conclusion of commercial transactions for third parties</i>

6 After the Application Mark was published for opposition, the Opponent filed this action. The Opponent is no stranger to this tribunal. From late-2012 to the hearing date (1 September

⁴ See Applicant’s letter dated 11 June 2021.

2021), MEC filed more than forty actions to oppose trade mark applications in Singapore. It won more than half of these actions by default because no counter-statement was filed in defence. A number of the remaining cases were settled with the opposed mark withdrawn as a result. In certain cases,⁵ MEC withdrew the opposition and the application eventually proceeded to registration. Others remain pending. To date, only five MEC cases (prior to this one) reached a full hearing on the merits,⁶ and MEC was unsuccessful in all of them. Although MEC filed appeals to the High Court in three of these cases, in each instance the court upheld this tribunal's decision with finality. All of this information is a matter of public record.

7 Given that the earlier decisions of this tribunal have described the nature of MEC's business at length, I can afford to be brief. The Opponent, a company incorporated in Delaware, USA, is a global leader in the beverage industry. Its core business is in "MONSTER ENERGY" energy drinks, although it also engages in a variety of other activities as well. This dispute, however, is not about "MONSTER ENERGY". Instead, MEC's objection relates to "BEAST" in the Application Mark. The Opponent's case is that the Application Mark should not be registered because it conflicts with its registered trade marks set out in the table below (collectively: the "Opponent's Earlier Marks"), all of which contain "BEAST" as an element.

Registered Marks	TM No.	Class and specification of goods
UNLEASH THE BEAST!	T0601902F	<u>Class 32</u> <i>Fruit juice drinks, soft drinks, carbonated soft drinks and soft drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, aerated water, soda water and seltzer water.</i>
UNLEASH THE BEAST!	T1202150I	<u>Class 5</u> <i>Nutritional supplements in liquid form in Class 5.</i> <u>Class 32</u> <i>Non-alcoholic beverages, namely energy drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs (other than for medicated use); all included in Class 32.</i>
UNLEASH THE BEAST!	T1402590J	<u>Class 5</u> <i>Nutritional supplements.</i> <u>Class 32</u> <i>Non-alcoholic beverages.</i>
REHAB THE BEAST!	T1108653D	<u>Class 5</u> <i>Nutritional supplements in liquid form.</i>

⁵ See, for example: (a) opposition to trade mark no. 40201904962W in the name of The Coca-Cola Company; and (b) opposition to trade mark no. 40201714108R in the name of Puma SE.

⁶ In chronological order: *Monster Energy Company v Mixi, Inc* [2017] SGIPOS 12, *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 17 (appeal dismissed by the High Court with no written decision), *Monster Energy Company v Glamco Co., Ltd.* [2018] SGIPOS 7 (appeal dismissed by the High Court in [2018] SGHC 238), *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9, *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16 (appeal dismissed by the High Court with no written decision).

		<p><u>Class 30</u> <i>Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages.</i></p> <p><u>Class 32</u> <i>Non-alcoholic beverages, namely, energy drinks, sports drinks and fruit juice drinks; all the foregoing enhanced with vitamins, minerals, nutrients, proteins, amino acids and/or herbs.</i></p>
REHAB THE BEAST!	40201606883W	<p><u>Class 30</u> <i>Coffee, tea, cocoa and artificial coffee; coffee-based beverages; tea-based beverages; chocolate-based beverages; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.</i></p> <p><u>Class 32</u> <i>Non-alcoholic beverages; beer</i></p>

8 This is not the first time that the parties have crossed swords. MEC also filed an opposition based on its earlier “UNLEASH THE BEAST!” mark to the Applicant’s parallel trade mark application (involving the same trade mark in respect of what appears to be the same services) in Korea. It is not necessary to go into the specifics. All that needs to be said is that the action was dismissed on grounds that the marks are dissimilar and the Opposition Division of the Korean Intellectual Property Office ruled in favour of the Applicant.⁷

Sole ground of opposition: s 8(2)(b) TMA

9 This opposition is based on a single ground: s 8(2)(b) of the Trade Marks Act (Cap. 332) (“TMA”). It provides that:

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

(a) *[omitted]*

(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.”

10 The earlier trade marks in this dispute are the Opponent’s Earlier Marks, namely: “UNLEASH THE BEAST!” and “REHAB THE BEAST!”. (See [8] above.)

11 In *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal held that the provision entails a three-step test: First, are the competing marks similar? Second, are the goods identical or similar? Third, is there a likelihood of confusion arising from (or to use the words of the section: because of) the

⁷ Applicant’s SD at Exhibit LG-6

foregoing? All three steps must be established for the opposition under this ground to succeed. If any one step cannot be established, the opposition under this ground will fail.


Dealing with the second step first

12 *Staywell* makes it clear that the proper approach is to assess the three steps in sequence. However, for reasons that will become clear shortly, it makes sense to deal with the second step first. Under the second step, I must compare the goods under each of the Opponent’s Earlier Marks as against the services applied for under the Application Mark.

13 In the assessment for goods/services similarity, the tribunal or a court may have regard to the factors set out in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) at 296-297, which have been looked to and applied in *Staywell* as well as a number of other local court decisions. These so-called *British Sugar* factors or guidelines are as follows: (a) the respective *uses* and *users* of the goods or services; (b) the physical nature of the goods or acts of service; (c) the respective trade channels through which the goods or services reach the market; (d) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and (e) the extent to which the respective goods or services are competitive, including how the trade classifies them.

14 The reader would note that the Application Mark is sought to be registered in Class 35 for a variety of *services* relating to sales, advertising and marketing, whereas *none* of the Opponent’s Earlier Marks are registered for services. Indeed, the “UNLEASH THE BEAST!” mark is registered in respect of *goods* in Classes 5 and 32 which may be broadly described as nutritional supplements (in Class 5) and beverages (in Class 32). As for the “REHAB THE BEAST!” mark, apart from being registered in Classes 5 and 32 for the same aforementioned goods, it is also registered in Class 30 for food products such as “coffee”, “tea” and “sugar”. Responding to this, the Applicant’s pleaded case was that the relevant “*services are totally and completely dissimilar to the Opponent’s goods and there could be no likelihood of confusion*”.⁸

15 In seeking to bridge the gap between the respective goods and services, the Opponent argued that the services under the Application Mark marked in bold in the table below are complementary and hence similar in nature to the goods covered under the Opponent’s Earlier Marks. By complementary, the Opponent meant that the specifications have a close connection with each other in the sense that one is indispensable or important for the use of the other such that consumers may think that the goods or services originate from the same trade source.⁹ In this connection, it submitted that there is an inseparable and close relationship between the goods and services such that they should be considered similar overall.

Opponent’s Earlier Marks (Goods)		Application Mark (Services)
<p>UNLEASH THE BEAST!</p> <p><u>Class 5</u> <i>Nutritional supplements.</i></p> <p><u>Class 32</u></p>	<p>REHAB THE BEAST!</p> <p><u>Class 5</u> <i>Nutritional supplements in liquid form.</i></p>	 <p><u>Class 35</u></p>

⁸ Counter-statement at [5.2]

⁹ Opponent’s Written Submissions at [55]-[59]

<i>Non-alcoholic beverages.</i>	<u>Class 30</u> <i>Coffee, tea, cocoa and artificial coffee; coffee-based beverages; tea-based beverages; chocolate-based beverages; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.</i> <u>Class 32</u> <i>Non-alcoholic beverages; beer</i>	<i>Sales promotion for others; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising; Commercial intermediation services; Organisation of exhibitions for commercial or advertising purposes; Provision of commercial and business contact information; Market studies; Business management and organization consultancy; Marketing; Negotiation and conclusion of commercial transactions for third parties.</i>
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16 I am not persuaded by the Opponent’s arguments in the slightest. I fail to see how the services highlighted in bold above, or indeed any of the other services applied for under the Application Mark, can be said to be similar to the relevant goods in Classes 5, 30 or 32. The uses and users of the respective goods and services are very different: on one side are consumer goods whereas on the other are services that are typically engaged by businesses. The same can be said for their nature, as well as the relevant trade channels. The goods covered by the Opponent’s registrations would ordinarily be found in supermarkets, but no one goes to the supermarket to engage in the services of an advertising company or a provider of an online platform for buyers and sellers to transact with each other. No reasonable person in the respective lines of trade would classify the goods and services in question to be competitive or complementary or inseparably close. Whether one conducts the analysis by reference to the *British Sugar* guidelines or plain old common-sense, the result is the same.

17 To be clear, this does not mean that a good can never be similar to a service. In certain limited circumstances, it may be possible to make such a finding. As observed (albeit *obiter*) in *British Sugar*, “a service of repair might well be similar to the goods repaired”. Following that line of reasoning, in *Daidoh Limited v New Yorker S.H.K Jeans GmbH & Co. KG* [2018] SGIPOS 18, I made the finding that “clothing” (as a good) was similar to the service of “retail services with regard to clothing”. However, there are limits to how far the proposition can go and on the present facts it is simply not possible to make such a finding. As the learned IP Adjudicator David Llewelyn observed in *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 at [35], “it cannot be the case that a general retail services specification that does not refer to any particular goods must be regarded as similar to any goods that may be sold in a retail outlet”. The same logic, which I respectfully adopt, applies here as well.

18 Hypothetically speaking, if the services under the Application Mark were worded differently in a way that specifically referred to, say, energy drinks, beverages or nutritional supplements, the Opponent might have an arguable case. But on these present facts I cannot see how the goods and services can be said to be similar. Indeed, if one were to follow the Opponent’s reasoning to its logical conclusion, the bolded services could be said to be similar to any product at all. Surely that cannot be the case. To find otherwise would undermine the policy undergirding the trade marks registration scheme.

19 Before moving on, I should also address two aspects of the Opponent’s evidence. First, the evidence showed that in one instance, the “Noisy Beast” agency was engaged to conduct a marketing campaign (via TV, the internet, and in-person physical billboards) in Australia on behalf of one of its clients, “Pana Chocolate”.¹⁰ Second, there was evidence that online marketplaces can and do offer goods such as nutritional supplements, beverages, coffee, and tea (these being goods that are covered under one or more of the Opponent’s Earlier Marks).¹¹

20 However, neither of these categories of evidence materially advance the Opponent’s case. It is obvious that the service of advertising / marketing / sale promotion can be provided to (and engaged by) all sorts of clients in connection with virtually any type of product or service. But it does not follow that such services are similar to *all* products and services. Likewise, the mere fact that an online platform can be used to sell foodstuff and beverages and nutritional supplements is neither here nor there. Anyone can buy or sell just about anything on these online marketplaces. But the service of providing such a platform is very different from the actual goods/services transacted on it.


21 For the reasons above, I find it eminently clear that there is no similarity at all between the goods and services in issue. Therefore, the second step of the three-step test is not established. Consequently, the opposition must fail. I have dealt with this second step prior to addressing similarity of marks because I regard the dissimilarity between the goods and services as the most straightforward reason why this opposition should be dismissed.

22 Having made the finding that the goods for which the Opponent’s Earlier Marks are registered are wholly dissimilar to the services for which the Application Mark, I dismiss the sole ground of opposition (premised on s 8(2)(b) TMA) on this basis. As such, the remainder of this decision is academic. Nevertheless, for completeness, I will state my observations in relation to some of the pertinent issues under s 8(2)(b) TMA.

The first step: marks similarity

23 Under the first step, the task is to compare each of the Opponent’s Earlier Marks (namely: “UNLEASH THE BEAST!” and “REHAB THE BEAST!”) as against the Application Mark



(that is: ) in order to come to a decision as to whether they are similar or not. The comparison is mark-for-mark, without consideration of any external matter (*Staywell* at [20]).

24 The key principles relating to the evaluation for marks-similarity have been set out in a number of decisions of the Court of Appeal, including *Staywell* and *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”), which I have regard to. These fundamental propositions have also been restated time and again in various decisions of this tribunal (see, for example, my recent decision in *GCIH Trademarks Limited v Hardwood Pte Ltd* [2021] SGIPOS 6 (“*GCIH*”), and will not be repeated in full here for brevity’s sake.

¹⁰ Opponent’s SD at [10] and Exhibit RCS-3

¹¹ Opponent’s SD at [9] and Exhibit RCS-2

Distinctiveness of Opponent’s Earlier Marks

25 I begin with the issue of distinctiveness. It is trite law that a mark which has greater technical distinctiveness enjoys a higher threshold before a competing sign would be considered dissimilar to it (see *Staywell* at [25] and *Sarika* at [36]).¹² The Opponent sought to argue that this higher threshold applied on the facts of this case.

26 The Opponent’s submissions on distinctiveness were structured as follows. First, it contended that the Opponent’s Earlier Marks possess a normal level of inherent distinctiveness because they do not describe or allude to the goods for which they are registered.¹³ Second, it argued that the Opponent’s Earlier Marks and in particular the “BEAST” component of each mark enjoyed a substantial degree of acquired distinctiveness through use.

27 I have no difficulty accepting the first submission. The slogan “UNLEASH THE BEAST!” may be considered by some as suggesting the release of a powerful beast, whereas “REHAB THE BEAST!” might be regarded as a reference to rehabilitating a beast. Nevertheless, the Opponent is right that neither of these phrases describe or allude to the goods (namely: beverages or nutritional supplements or coffee, tea and the like). As such, I agree that each of the Opponent’s Earlier Marks possess a normal level of inherent distinctiveness.

28 I turn now to the second submission regarding acquired distinctiveness. The Opponent’s evidence showed that from the time it first launched its products in Singapore in October 2012 through September 2019, it had sold more than 13.4 million cans of its “MONSTER ENERGY” drinks in Singapore. Significantly, most, if not all, of the cans bore at least one of MEC’s “THE BEAST!” slogans at the back of each drink can.¹⁴ There was also other evidence which showed that its “THE BEAST!” slogans had been used in various other ways, including on its website.¹⁵ I reproduce two extracts from the evidence below.



a.

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¹² Opponent’s Written Submissions at [14]-[27]

¹³ Opponent’s Written Submissions at [12]-[13]

¹⁴ Opponent’s SD at [2] and [14]

¹⁵ Opponent’s SD at Exhibit RCS-4

¹⁶ Opponent’s SD at [2]



b.

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29 Having considered the evidence as a whole, I accept that the slogan “UNLEASH THE BEAST!” has been used in Singapore, at least in stylised form. Comparatively speaking, “REHAB THE BEAST!” has been used to a much lesser extent as compared to “UNLEASH THE BEAST!”. This is because “REHAB THE BEAST!” is only used in relation to the “REHAB” line of energy drinks, whereas “UNLEASH THE BEAST!” appears to be the main slogan in use (as evidenced by the fact that it is featured on the website).

30 However, I find it difficult to see how the Opponent’s Earlier Marks can be said to enjoy a greater level of technical distinctiveness through use. It appears that these slogans are primarily—if not always—used in conjunction with the main house marks (stylised “MONSTER ENERGY” and the claw device) but in a way that is less prominent or eye-catching. Examples of this include how the slogans are placed at the back of each energy drink can and marketed or displayed in ways which are clearly subsidiary to the main house marks. As a consequence, average consumers are likely to rely on the main house marks and not the Opponent’s Earlier Marks as a badge or guarantee of trade origin. (For the applicable test for acquired distinctiveness, see *Societe des Produits Nestle S.A. & Anor v Petra Foods Limited & Anor* [2017] 1 SLR 35.¹⁸)

31 Even if I am wrong in my analysis above, I consider that the distinctive character of the Opponent’s Earlier Marks lies in the combination of the words comprising the respective slogans, not “BEAST” in particular. What is a slogan if not a short, striking phrase? Every word in a slogan is carefully chosen and has its place. If there is an invented word in the slogan, average consumers might arguably pay more attention to it. But “BEAST” is an ordinary English word. In and of itself, it does not enjoy a high degree of inherent distinctiveness. Moreover, it is not given any degree of visual prominence in the Opponent’s Earlier Marks. Consequently, the relevant public would not accord “BEAST” alone any special significance. It cannot be regarded as the distinctive and dominant element of the Opponent’s Earlier Marks.

¹⁷ Opponent’s SD at Exhibit RCS-4

¹⁸ Although the decision was on the issue of acquired distinctiveness through use in the context of registrability as a trade mark under s 7(1)(b) TMA, I see no reason why the test for acquired distinctiveness should be different for the purposes of s 8(2)(b) TMA.

Thus, even assuming *arguendo* that a finding of acquired distinctiveness through use should be made, this would not materially advance MEC’s case because any enhanced distinctiveness would relate to each of the slogans as a whole (and not “BEAST” in particular).

32 Finally, there is the vexed issue of whether—and if so, the extent to which—evidence of acquired distinctiveness through use plays a role in the assessment for marks-similarity. I recently expressed the view that while the law is less than clear on this point, it appears from *Staywell* that this sort of evidence should not be taken into account at the marks-similarity stage; instead, it should be reserved for the likelihood of confusion assessment (see *GCIH Trademarks Limited v Hardwood Pte Ltd* [2021] SGIPOS 6 (“*GCIH*”) at [33]-[40] and [103]-[113]).¹⁹

33 In addressing *GCIH*,²⁰ the Opponent drew my attention to a recent decision of the High Court, *Digi International Inc v Teraoka Seiko Co., Ltd* [2021] SGHC 165 (“*Digi*”), and submitted that part of *Digi*’s *ratio decidendi*, which would bind this tribunal, was that evidence of acquired distinctiveness could be taken into account in the marks-similarity assessment.²¹ While I acknowledge the force of the Opponent’s arguments, it is not necessary for me to decide the issue. Accordingly, I will refrain from further comment.

Visual, aural and conceptual analysis

34 It is trite law that the competing marks are to be compared having regard to three aspects of similarity: visual, aural and conceptual. Each of these are signposts towards answering the question of whether the marks are similar. There is no prescribed requirement that all three aspects must be made out before the marks can be found to be similar (see *Staywell* at [18]).

35 First, visual similarity. In the assessment for visual similarity, one may have regard to the distinctive and dominant components of the marks (see principles in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [62]). MEC’s case was that the competing marks are visually more similar than different. In particular, the Opponent focussed on the fact that both marks contain “BEAST” which—according to the MEC—is the distinctive and dominant element of the competing marks.²² As for the Applicant, it acknowledged the respective marks coincided in the word “BEAST” but pointed out that they differed in all other respects including: (a) the elements “NOISY” and the “*animal head with horns*” device, both of which are not in the Opponent’s Earlier Marks; and (b) the elements “UNLEASH THE” / “REHAB THE”, which are not in the Application Mark.²³

¹⁹ In *Law of Intellectual Property of Singapore (3rd Ed, Sweet & Maxwell Asia)*, Prof Ng-Loy Wee Loon, S.C. (Hon.) mentions at footnote 159 to sub-para (c) of [21.5.18] the divergence of views at the Registry level. The learned author also notes that the High Court in *Digi* took acquired distinctiveness into account at the mark-similarity stage but the issue was not raised to the High Court because “*the parties proceeded on the basis that this was a relevant consideration*”.

²⁰ After the Opponent filed its written submissions, this tribunal issued two decisions dealing with this topic. The first is *Combe International Ltd. v Dr. August Wolff GmbH & Co. KG Arzneimittel* [2021] SGIPOS 10 (“*Combe*”) where the learned IP Adjudicator Sheik Umar Bin Mohamed Bagushair took a different view from that expressed in *GCIH* (see *Combe* at [28]-[30]). An appeal against the *Combe* decision has been filed to the High Court. The second is *Louis Vuitton Malletier v Human Horizons Holding (Shanghai) Co. Ltd.* [2021] SGIPOS 13 where the learned IP Adjudicator Adrian Tan Gim Hai acknowledged the views set out in *Combe* but nevertheless endorsed the approach in *GCIH*.

²¹ Opponent’s Written Submissions at [18]-[20]

²² Opponent’s Written Submissions at [36]-[38]

²³ Counter-statement at [9.1]

36 In my assessment, it is self-evident that “BEAST” is the only point of visual similarity between the marks. In all other respects, the marks are visually dissimilar. As observed in the discussion on distinctiveness, “BEAST” is an ordinary English word that does not enjoy a high degree of inherent distinctiveness. I do not think that “BEAST” is the distinctive and dominant element in the Opponent’s Earlier Marks. The distinctive character lies in MEC’s slogans as wholes. As for the Application Mark, the distinctive character clearly lies in the combination of “NOISY” and “BEAST”, set against the “*animal head with horns*” device background which plays a significant visual role in the mark. I do not think that one can simply disregard these elements and cherry pick “BEAST” as the crucial point of reference in the Application Mark. In all, I consider the marks to be visually more dissimilar than similar.

37 Second, aural similarity. *Staywell* makes it clear that there are two possible approaches: the first is to consider the dominant components of both marks (“Dominant Component Approach”), and the second is to undertake a quantitative assessment as to whether the competing marks have more similar syllables than not (“Quantitative Approach”). Here, the Opponent’s case once again largely focussed on the commonality of “BEAST” (which it considered to be the common dominant element),²⁴ while downplaying the aural significance of the other elements. In its submission, the marks should be considered aurally similar at least to an average degree. In contrast, the Applicant’s case was that the marks are phonetically dissimilar having regard to the different number of syllables, length, rhythm and intonation.²⁵

38 To my mind, “BEAST” cannot be regarded as the aurally dominant component of the marks. The first word in the Application Mark (“NOISY”), as well as the first two words in each of the slogans in issue (“UNLEASH THE” / “REHAB THE”) are at least equally aurally significant. Accordingly, the Dominant Component Approach does not assist the Opponent’s case. As for the Quantitative Approach, it is obvious that this approach would weigh against a finding of similarity since apart from the common word “BEAST” the other syllables, when spoken, are aurally very dissimilar. All things considered; the marks are aurally more dissimilar than similar.

39 Third, conceptual similarity. It is well established that the analysis here “*seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole*” (*Staywell* at [35]). The Opponent’s case was that there is at least an average level of conceptual similarity between the marks, having regard to concept of a “BEAST” on each side.²⁶ While the Applicant accepted that the marks coincided in the word “BEAST”, its case was that a “NOISY BEAST” (especially with the animal head device) would be perceived as conceptually different from unleashing or rehabilitating a beast.²⁷

40 I think that there is a material difference between describing a beast as being “NOISY” on the one hand, as compared to the issuance of a command or instruction to “UNLEASH” or “REHAB” (presumably: rehabilitate) a beast. It is true that they both relate to a beast or animal of some sort as the subject, but the ideas and concepts that are conveyed in relation to that subject are not the same. Thus, I would consider the marks to be conceptually more dissimilar than similar.

²⁴ Opponent’s Written Submissions at [39]-[44]

²⁵ Counter-statement at [9.1]

²⁶ Opponent’s Written Submissions at [47]

²⁷ Counter-statement at [9.1]

41 In summary, I regard the marks, on the whole, as being visually, aurally and conceptually more dissimilar than similar.

Third step: likelihood of confusion

42 I have found that there is no similarity at all between the goods and services and disposed of the opposition on this basis. If I had to decide, I would have also found the competing marks to be more dissimilar than similar. Since it is artificial to examine likelihood of confusion (as there can be no confusion where there is no similarity at all between the goods and services), I will not offer any further comments in this vein.

Conclusion

43 The opposition is dismissed with costs to be paid by the Opponent to the Applicant. For the record, I would like to say that the written arguments presented by Opponent's counsel were succinct, helpfully structured, and as balanced as possible given the circumstances. Nevertheless, the opposition was completely unsustainable from its inception. In this case, the goods covered under the Opponent's Earlier Marks cannot by any stretch of the imagination be regarded as similar to the services for which registration is sought under the Application Mark.

Date of issue: 18 November 2021