

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

[2023] SGIPOS 13

Trade Mark No. 40201902574X

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

IICOMBINED CO., LTD

... Applicant

AND

AN OPPOSITION BY

MONSTER ENERGY COMPANY

... Opponent

FOUNDATIONS OF DECISION

TABLE OF CONTENTS

INTRODUCTION.....	1
BACKGROUND	1
NOTICE OF OPPOSITION	4
STATUTORY DECLARATIONS	4
FIRST GROUND: S 8(2)(B) TMA	5
OPPONENT’S EARLIER MARK.....	6
SIMILARITY OF MARKS	6
<i>Visual similarity.....</i>	<i>7</i>
<i>Aural similarity.....</i>	<i>10</i>
<i>Conceptual similarity.....</i>	<i>12</i>
<i>Overall conclusion on marks-similarity</i>	<i>14</i>
SIMILARITY OF GOODS	15
LIKELIHOOD OF CONFUSION	16
SECOND GROUND: S 8(7)(A) TMA	16
GOODWILL.....	17
MISREPRESENTATION.....	18
DAMAGE	19
CLOSING OBSERVATIONS ON OPPONENT’S EVIDENCE	19
OVERALL CONCLUSION AND COSTS.....	23

Monster Energy Company
v
IICOMBINED Co., Ltd.

[2023] SGIPOS 13

Trade Mark No. 40201902574X
Principal Assistant Registrar Ong Sheng Li, Gabriel
7 December 2023

26 December 2023

Principal Assistant Registrar Ong Sheng Li, Gabriel:

Introduction

1 This case is about a trade mark application by IICOMBINED Co., Ltd. (“Applicant”) to register “**GENTLE MONSTER**” (Trade Mark No. 40201902574X) in Class 09 for “*smartglasses*” (“Application Mark”). After the Application Mark was published for opposition purposes, Monster Energy Company (“Opponent”) commenced these proceedings.

Background

2 GENTLE MONSTER is a South Korean luxury eyewear brand with some following in Singapore. Founded in 2011 and first launched in Seoul, Republic of Korea, the brand has since expanded its reach globally. At the time the evidence was recorded, there were 54 GENTLE MONSTER stores worldwide, including in South Korea, mainland China, Hong Kong, Taiwan, Singapore, the United Arab Emirates, the United Kingdom, and the United States. GENTLE MONSTER eyewear may also be purchased online.

3 There are two GENTLE MONSTER stores in this country. The first, located within the ION Orchard shopping mall, opened in 2017. The second,

located at the Shoppes at Marina Bay Sands, opened in 2019. Both stores feature unconventional styling featuring elaborate display pieces that would, I think, not seem out of place if exhibited at an art museum. This is said to be a hallmark of the GENTLE MONSTER branding. The following extract from the evidence should speak for itself.



Figure 1: GENTLE MONSTER Ion Orchard

The Applicant

4 The owner of the GENTLE MONSTER brand is the Applicant, a company incorporated in the Republic of Korea. The Applicant (formerly known as SNOOPBY Co., Ltd.) has various trade mark registrations and applications for “GENTLE MONSTER” around the world. In Singapore, the Applicant’s earliest trade mark registration is “**GENTLE MONSTER** „ (Trade Mark No. T1309263I), registered on 11 June 2013 in Class 09 for “*Spectacles, Sunglasses*”.

5 Although GENTLE MONSTER started out by selling sunglasses and

optical glasses, it later expanded its range of luxury eyewear to include smartglasses. On 31 December 2018, it applied to register the Application Mark. And in 2019, following a collaboration with Huawei Technologies Co., Ltd., the two companies launched smartglasses under the label HUAWEI x GENTLE MONSTER Eyewear. These co-branded smartglasses were first made available internationally in August 2019 and were subsequently sold in the GENTLE MONSTER Singapore stores from November 2019.

The Opponent

6 The Opponent is a company incorporated in the state of Delaware, in the United States of America. It is a global leader in the energy drinks beverage industry, where it enjoys considerable success. It also owns, in Singapore and many countries around the world, various "MONSTER", "MONSTER ENERGY" and "MONSTER" formative marks in differing formats; some of these are stylised, others are in plain word mark form, while yet others are registered as composite marks. It appears that the trade mark most frequently used by the Opponent (including on each drink can of its core line of MONSTER ENERGY beverages) is the following stylised composite mark:



7 A frequent user of this tribunal’s services,¹ the Opponent’s actions have left in their wake a number of court and tribunal decisions chronicling its attempts to prevent other traders from registering certain trade marks that contain the word “MONSTER”.² Of course, there is nothing wrong with protecting one’s brand. It is the Opponent’s prerogative to pursue all legal means in doing so. These observations are not to be taken as criticism. Rather, they are meant to inform any readers who may be unaware: this is but one battle amidst a much larger global war for control over “MONSTER”.

Notice of opposition



8 Two grounds of opposition are pleaded against the Application Mark, namely: ss 8(2)(b) and 8(7)(a) of the Trade Marks Act 1998 (“TMA”).

Statutory declarations

9 As per standard procedure, the parties gave evidence through statutory

¹ This is the eighth trade mark case commenced by the Opponent (since the first was heard in 2017) to have reached the full hearing stage before the Registrar of Trade Marks. The seventh—which concerned consolidation oppositions to YG Entertainment Inc.’s trade mark applications for “BABYMONSTER” and “BABYMONSTERS”—was heard by an IP Adjudicator in mid-October 2023, slightly less than two months before this case.

² See *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12 (unsuccessful opposition against application mark: “MONSTER STRIKE” in Classes 09 and 41); *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 17 (unsuccessful

opposition against application mark “” in Classes 30 and 43, upheld on appeal by the High Court with no public written grounds of decision; *Monster Energy Company v Glamco Co., Ltd.* [2018] SGIPOS 7 (unsuccessful opposition against application mark “SWEET MONSTER” in Class 30, upheld on appeal by the High Court in [2021] SLR 319); and *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9 (unsuccessful opposition against application mark “” in Classes 9, 41 and 42).

declarations (“SD(s)”). Paul J. Decharay, Senior Vice President and Deputy General Counsel of the Opponent, gave evidence as well as evidence-in-reply on its behalf. Hyeun Jung Lee, Legal Counsel for the Applicant, gave evidence on its behalf. Since there was no cross-examination, these SDs formed the entirety of the evidence before this tribunal.

10 For the record, I should mention that the Opponent’s bundle of authorities contained a printout of a published interview titled “Interview with Gentle Monster” dated 11 October 2013. I have not taken this document into account in my assessment. The proper way to introduce such a document is through an SD, not submissions.

First ground: s 8(2)(b) TMA

11 Section 8(2)(b) of the TMA reads:

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.

12 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc.* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal held that the provision requires a 3-step test: First, are the competing marks similar? Second, are the goods identical or similar? Third, is there a likelihood of confusion arising from (that is: because of) the foregoing? All three steps must be established for the opposition under s 8(2)(b) TMA to succeed.

Opponent’s earlier mark

13 Although the Opponent referred to numerous “MONSTER” and “MONSTER ENERGY” marks, by the time written submissions were filed, its arguments had coalesced around “**MONSTER ENERGY**” (Trade Mark No. 40201401724W) in Class 09 (“724W”). On 10 December 2014, 724W was registered for the following goods in Class 09.

Class 09

Protective clothing; protective footwear; protective headwear; protective eyewear, sports helmets; eye glasses; eye glass cases; sunglasses; sunglass cases; video recordings featuring sports, extreme sports, and motor sports; eyeglass cords.

14 During the hearing, I asked Mr Brendan Loy, counsel for the Opponent, whether 724W represented its best case in the opposition (meaning that if the opposition under s 8(2)(b) TMA did not succeed on the basis of 724W, it would not succeed at all). He forthrightly confirmed that this is indeed the case.

15 Given this, the task under the first step is to compare 724W against the Application Mark to assess whether they are similar or not. Although it is trite law that the marks should not be compared side-by-side, it is convenient in a decision such as this to set them out for ease of reference.

Opponent’s Earlier Mark (724W)

Application Mark

MONSTER ENERGY

GENTLE MONSTER

Similarity of marks

16 The key principles relating to the evaluation for marks-similarity under s 8(2)(b) TMA have been set out in a number of decisions of the Court of

Appeal, including *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] (“*Sarika*”), *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941, *Staywell*, and *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308, all of which I have given due consideration to. These fundamental propositions have also been restated in numerous decisions of this tribunal (including in my earlier decision in *GCIH Trademarks Limited v Hardwood Pte Ltd* [2021] SGIPOS 6 at [30]-[32]) and will not be repeated here.

17 While the law in Singapore on marks-similarity is largely settled, there was for a time some uncertainty on a specific issue concerning the role (if any) of acquired distinctiveness in the marks-similarity comparison. This has now been resolved following the decision of the General Division of the High Court in *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 (“*Twitter*”), wherein JC Goh Yihan (as he then was) endorsed the view that technical distinctiveness should be considered at the likelihood of confusion stage (and not marks-similarity). A summary of the court’s conclusions in this regard can be found at [119] of *Twitter*.

Visual similarity

18 I begin with visual similarity.

19 Here, the Opponent’s case is that there is a moderate degree of visual similarity between the competing marks. In its submission, this similarity arises from the prominent common denominator that the marks share: “MONSTER”. In brief, its arguments are pinned on the following related contentions: (a) “GENTLE” in the Application Mark holds little-to-no weight in the analysis because it is descriptive of the Applicant’s smartglasses; (b) just because “GENTLE” is the first word does not automatically mean that it would capture more of the consumers’ attention; and (c) “MONSTER” does not convey any

meaning or have any allusive quality in relation to smartglasses and would therefore stand out in the consumer's imperfect recollection.

20 While the Applicant does not dispute that the marks share the common element "MONSTER", its case is that the degree of visual similarity is not high. It points to the fact that the Application Mark starts with "GENTLE" whereas the Opponent's earlier mark has "MONSTER" as its first word. In the Applicant's submission, the first word in a trade mark would have a greater impact on consumer perception. In this connection, the Applicant contends that the additional different words (namely: "GENTLE" and "ENERGY") would distinguish the marks from each other. The Applicant also argues that weight should be given to the different fonts used in the respective marks, which would give a different visual impression to persons viewing the marks.

21 In my view, the marks may coincide in the common English word "MONSTER", but that is as far as it goes. On the whole, the marks are visually more dissimilar than similar. My analysis on this aspect is as follows.

22 First, it is clear that the differences in font in this case should not be given any weight. Both marks are set out in block letters and any miniscule differences can be attributed solely to the typeface in the chosen fonts. (In other words, there is no added stylisation.) It is a longstanding and trite principle that word marks registered in plain block capital letters are protected for use in that word in any clearly legible form of lettering, regardless of the font, typeface, or design of the later mark (see *Sarika* at [24]-[25]).

23 Second, I am unable to see how the argument that "GENTLE" is descriptive of "smartglasses" can be taken seriously. Smartglasses are essentially wearable technology in the form of eyewear or headgear. Words

such as “GENTLE”, “MONSTER” and “ENERGY” are ordinary words in the English language. None of them describe smartglasses. Therefore, the word “GENTLE” cannot be given lesser significance in the visual-similarity analysis.

24 Third, I do not think it would be right to dissect the competing marks in the way that the Opponent has suggested. The earlier mark “MONSTER ENERGY” is more than the sum of its parts. Its technical distinctiveness resides in the mark as a whole. Together, the words form a sign that distinguishes the goods under 724W in a way that is not only different but also stronger than either “MONSTER” or “ENERGY” alone. The same is also true of “GENTLE MONSTER”. The public would not refer to the Applicant’s goods as belonging to the “GENTLE” brand. Nor would they consider them “MONSTER” eyewear. The effect of all of this is that no particular element of either mark would stick out in the imperfect recollection of the consumer. In other words, “MONSTER” cannot be said to be the distinctive and dominant component of either mark.

25 Fourth, it cannot be assumed that average consumers would always regard the first word of a trade mark (with more than one word element) as being the most significant or attention grabbing. Whether this is so depends on the trade mark in issue. That said, I respectfully agree with my learned colleague’s observation in *Apple Inc. v Swatch SG (Swatch SA)(Swatch Ltd.)* [2018] SGIPOS 15 at [32] (made in the context of the plain word marks “THINK DIFFERENT” versus “Tick different”) that it is “*well established that English words are ordinarily viewed and read from left to right. As such, the differences in the first words of both marks... being seen first, should have greater visual impact...*”. Similarly, in this case the fact that the competing marks start with different first words would not be lost on average consumers. But perhaps more importantly, the relevant public would surely be aware that the first word in the

Application Mark, “GENTLE”, does not appear in “MONSTER ENERGY”. The same goes for “ENERGY”, which is in 724W but not the Application Mark.

26 The Opponent placed some reliance on *In Trade Mark Inter Partes Decision O/185/19* (“O/185/19”), a decision of the UK Intellectual Property Office. In that case, a hearing officer found the Opponent’s “MONSTER ENERGY” plain word mark to be visually similar to the stylised application

mark “**MONSTER**” to a medium degree. (The goods in question were, broadly speaking, personal electronic devices in Class 09.) In analysing the Opponent’s mark, the hearing officer found that although both words in “MONSTER ENERGY” contributed to the overall impression, “MONSTER” seemed slightly more distinctive (O/185/19 at [41]). However, no reasons were given for this view, and I am not sure why this should necessarily be the case.

27 In any event, the facts of this case are quite different from O/185/19. There, the contested mark did not have any other elements apart from the stylised word “MONSTER”. On the other hand, the Application Mark in this case has two words, one of which is not present in 724W: “GENTLE”. For these reasons, I think that the Opponent’s case finds little support in O/185/19.

Aural similarity

28 I turn to the second aspect: aural similarity.

29 Here, the analysis may be conducted by reference to two accepted approaches (see *Staywell* at [31]-[32]). The first focusses on the dominant component of the marks (the “Dominant Component Approach”). The second involves a quantitative assessment as to whether the competing marks have more syllables in common than not (the “Quantitative Approach”).

30 Consistent with its arguments on visual similarity, the Opponent advocated for the application of the Dominant Component Approach. Under this line of argument, I was invited to focus the analysis on the common “MONSTER” component, which is said to be dominant in both marks. In the Opponent’s submission, having regard to this common component, the competing marks are aurally similar to an average degree.

31 Naturally, the Applicant does not agree with the use of the Dominant Component Approach. It argues that there is no distinctive and dominant component to be found in either mark. As such, the marks should be assessed through the Quantitative Approach. In its submission, when articulated, the differences would render the marks aurally more different than similar.

32 Earlier, in the context of visual similarity, I found that “MONSTER” is not the distinctive and dominant component of either mark. This finding must necessarily apply here as well. Since there is no dominant component to speak of, the Quantitative Approach is to be preferred. Now, it is undisputed that the Applicant’s Mark has four syllables (namely: “GEN-TLE-MON-STER”) while the Opponent’s earlier mark has five (that is: “MON-STER-EN-ER-GY”). Only two syllables are shared (“MON-STER”). Furthermore, as the Applicant rightly points out, “MON-STER” appears at the 1st and 2nd syllables of the Opponent’s earlier mark, but at the 3rd and 4th syllable of the Application Mark. I accept that these differences in the first words would have some aural impact. Moreover, depending on the actual speaker uttering the words, the rhythm and stress of the spoken syllables may also lead to further aural differentiation.

33 All in all, my assessment is that the aural dissimilarities outweigh the common aural “MONSTER” element.

Conceptual similarity

34 In *Staywell*, the Court of Appeal made clear (at [35]) that:

... 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 (*Bently & Sherman* at p 866). 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...

35 In advancing the submission that the competing marks are conceptually similar, the Opponent argues that the dominant or overall concept behind both marks is that of a monster. While the Application Mark may denote a gentle monster whilst 724W refers to a monster with energy (or something with a monstrous amount of energy), the contention is that there is nevertheless some level of conceptual similarity in that both refer to monsters.

36 The Applicant’s submission is that the marks represent concepts that are polar opposites to each other on a sliding scale of forcefulness. It contends that the Application Mark contains a paradox that is engendered through the juxtaposition of the adjective “gentle” with the noun “monster”. This is because monsters are ordinarily associated with the idea of something threatening, abnormal, and large. The term “gentle”, the argument goes, carries a meaning that is in contradistinction to something with great or monstrous energy.

37 Some years ago, in *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12 (“*Mixi*”) (where I found the competing marks “MONSTER ENERGY” and “MONSTER STRIKE” to be more dissimilar than similar overall), I observed that “MONSTER ENERGY” could mean one of two things. It could refer to some sort of mythical monster or bestial creature that is great,

powerful, and full of energy. Or it could refer to something or someone possessed of such a great and powerful energy that is akin to that which is possessed by a monster. Although different words can always be used to illustrate the point, my views remain substantially the same.

38 As for the word “gentle”, it is an adjective that is obviously out of place with the ordinary definition of “monster”. Monsters are supposed to be scary and fearsome, not gentle. An analogous situation arose in *Monster Energy Company v Glamco Co, Ltd* [2021] SLR 319 (“*Glamco*”) where the High Court upheld this tribunal’s decision in [2018] SGIPOS 7. There, the competing marks were the Opponent’s plain earlier “MONSTER” mark and the application mark “SWEET MONSTER”. In the conceptual similarity comparison, the court took the view that the marks are conceptually dissimilar for the following reasons. When the word “sweet” (which refers to things which are pleasing, delightful, charming, or endearing) is used as an adjective to describe “monster”, it changes the impression of the large, ugly, and frightening creature to a delightful and endearing imaginary creature. Consequently, the court found that the impression that each mark conveys is very different (*Glamco* at [64]-[65]).

39 So, too, here: the use of “gentle” completely changes the concept of “monster”. Instead of thinking of something strong, dangerous, and powerful, one is presented with the mental image of a creature that is mild and temperate in character. When contrasted with the concept of a monster or creature that is imbued with great power and energy, the two ideas could not be more different. Given this, it would be an error to consider “MONSTER” as the dominant concept in both marks. To do so would be to blindly ignore the modifier words “gentle” and “energy”, which completely change the character of what kind of monster is being referred to.

40 To my mind the presence of the modifying words and their resultant effect (which I have described above) make this case manifestly different from the two cases which the Opponent relies on to support its case: (a) *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459, where the court found “GLAMOUR” to be conceptually similar in some way to “HYSTERIC GLAMOUR” because the additional word modified but did not reverse (or to put it another way: completely change) the main concept of glamour; and (b) *Staywell*, where some conceptual similarity was found on the basis that both “ST. REGIS” and “PARK REGIS” evoke a place or location.

41 For these reasons, I find that the competing marks are dissimilar to a material degree notwithstanding the fact that they both contain “MONSTER”.

Conclusion on marks-similarity

42 I have found the marks to be more dissimilar than similar in the visual and aural assessment. I have also found the marks to be conceptually dissimilar to a material degree. On the whole, I conclude that the marks are dissimilar.

43 Even if I were to assume, purely for the sake of argument, that I have underestimated the importance of “MONSTER” in the visual and aural inquiry, the marks would—at the very most—be considered visually and aurally similar to a slim or marginal degree. Nevertheless, given the significant conceptual differences between the two, the marks would, in my assessment, be regarded by average consumers as more dissimilar than similar on the whole.

44 Since the first step of the three-step test cannot be established, the opposition under s 8(2)(b) TMA must be dismissed.

Similarity of goods

45 Having found that the opposition fails at the first step, it is, strictly speaking, unnecessary for me to proceed any further. Be that as it may, in case my views are of assistance elsewhere, I now proceed to set out some brief comments on the issue of goods-similarity.

46 Although the Opponent’s earlier mark 724W covers a range of goods in Class 09, its focus is on the items in the specification “*eye glasses; sunglasses*”. In the Opponent’s submission, these are the goods that are highly similar to “*smartglasses*” for which protection is sought in Class 09 under the Application Mark. It points to the fact that both goods have similar purposes or uses in that they improve vision and/or protect eyes from the sun. Furthermore, the users of the goods also overlap. Additionally, they share a similar physical nature and appearance, and may be sold through the same trade channels.

47 In written submissions, the Applicant provided various reasons why it considers the goods to be different. Arguably its most persuasive point is that smartglasses are, essentially, wearable electronic products whereas eyeglasses and sunglasses serve different purposes such as vision correction or optical protection. I would also observe that the Applicant’s conduct is consistent with this view: after all, it already has an earlier registration for “GENTLE MONSTER” in Class 09 for “*Spectacles, Sunglasses*” that dates back to 11 June 2013 (see [4] above) and pre-dates 724W (registered on 10 December 2014). Thus, the whole point of the Application Mark is to add smartglasses to the scope of protection as well.

48 To my mind, although smartglasses have additional uses and functions arising from their technological capabilities, the fact of the matter is that these are typically built upon frames for spectacles or sunglasses. This is something

we know not only through common experience but I can also see in the Applicant's own evidence relating to its HUAWEI x GENTLE MONSTER Eyewear. And one can readily see why: the beauty of integrating technology into existing forms of eyewear is that their users can blend in. They would not appear out of the ordinary. Another way of looking at it is that no matter how one slices and dices it, both smartglasses and eyeglasses/sunglasses are sub-categories of eyewear. It would not be surprising for a manufacturer of sunglasses and optical glasses to also sell smartglasses as well. The fact that the Applicant itself has branched out in this way demonstrates the point.

49 After careful consideration, I find that the goods in question are similar to each other but only to a slight degree.

Likelihood of confusion

50 The third step of the three-step test is likelihood of confusion. Where the marks are dissimilar, there can be no likelihood of confusion within the meaning of s 8(2)(b) TMA. Since it is not meaningful for me to offer further comments in this regard, I will conclude the inquiry here.

Second ground: s 8(7)(a) TMA

51 I now turn to the second ground of opposition, s 8(7)(a) TMA. The provision 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;

52 To succeed under s 8(7)(a) of the Act, the Opponent must establish a notional case of passing off: see *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]. The classic elements of the tort of passing off are trite. They are: (a) goodwill; (b) misrepresentation; and (c) damage. The key principles in relation to each element have been discussed in various decisions of the Court of Appeal, including the following, which I have given due consideration to: *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216, *The Singapore Professional Golfers' Association v Chen Eng Waye and others* [2013] 2 SLR 495, *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”), and *Tuitiongenius Pte Ltd v Toh Yew Keat and another* [2021] 1 SLR 231 (“*Tuitiongenius*”).

Goodwill

53 Goodwill essentially describes the state of the trader’s relationship with its customers. In a passing off action, goodwill is not concerned specifically with the get-up (meaning the mark, brand, or logo) used by a trader. Rather, it is concerned with the trader’s business as a whole. (See *Tuitiongenius* at [81]; *Singsung* at [32]-[34].)

54 It is clear that the Opponent has a business presence in Singapore in the form of a local subsidiary. It has also marketed and sold its energy drinks in Singapore through the subsidiary (and before that, through a local distributor) for some years. For these reasons, I hold that this element of the tort has been established. This is consistent with the conclusions reached by other decisions of this tribunal (and the court) flowing from the other oppositions commenced

by the Opponent involving “MONSTER” as an element of the application mark.³

Misrepresentation

55 The Opponent’s pleaded case (in the Notice of Opposition at [10]-[11]) is that the prominent and consistent use of its marks (which include "MONSTER", "MONSTER ENERGY" and "MONSTER" formative marks in differing formats; some stylised and/or in composite mark form) has caused the public to identify “MONSTER ENERGY” with the Opponent and its goods. According to the Opponent, the use or proposed use of the Application Mark on the relevant goods will mislead the public into thinking that there is some commercial connection between the two when there is in fact no such connection.

56 The Applicant argues that “MONSTER ENERGY” is not distinctive of the Opponent in relation to eyewear because there has been insufficient use of the plain “MONSTER ENERGY” word mark in connection with eyewear in Singapore. Instead, the bulk of the Opponent’s activities (which is self-evident from the evidence tendered) is directed at the marketing and promotion of its energy drinks. Following this line of argument, any generated goodwill in the eyewear industry in connection with the sign “MONSTER ENERGY” would be minimal at best. The Applicant also submits that the dissimilarity between the marks means that consumers are unlikely to be misled as to trade origin.

57 I begin by observing once again that the Opponent’s pleaded case under s 8(7)(a) TMA is premised on the plain “MONSTER ENERGY” word mark. Earlier, in the context of s 8(2)(b) TMA, I have found the competing marks

³ See cases referenced at footnote 2 above.

“MONSTER ENERGY” and “GENTLE MONSTER” to be dissimilar. Those findings apply with equal force here. Since the marks are dissimilar, there can be no misrepresentation as to trade origin. Since this second element of the tort is not established, I must dismiss the opposition under s 8(7)(a) TMA.

Damage

58 The third element of the tort is damage to the claimant’s goodwill. However, since I have found that there is no misrepresentation, the issue of damage to goodwill does not even arise.

Closing observations on Opponent’s evidence

59 Although the inquiry has concluded, in case it is helpful, I proceed to briefly outline some final observations on the Opponent’s evidence of use.

60 In *Mixi*, I undertook a detailed and extensive review of the Opponent’s evidence of use. After doing so, I arrived at the conclusion (at [186]) that the plain “MONSTER ENERGY” mark could not be said to be distinctive of the Opponent’s energy drinks in Singapore because that was not the trade mark by reference to which the Opponent’s goods were primarily marketed and sold. Although each case must be analysed on the basis of its own facts, much of the evidence filed in this case is broadly similar in nature to that which was filed in *Mixi* (and, as far as I can tell, the other opposition cases commenced by the Opponent involving “MONSTER” as an element of the application mark). Perhaps a different finding could be made on the basis of better evidence. But on the basis of the evidence presently before me, I remain of the view that average consumers in Singapore would not regard the plain word mark “MONSTER ENERGY” as being distinctive of the Opponent’s energy drinks.

61 Furthermore, it has been said that “*To be known to everyone is not to be known for everything*”. That phrase comes from Millett LJ’s judgment in *Harrods Limited v Harrodian School Limited* [1996] EWCA Civ 1315, where the renowned department store, Harrods of Knightsbridge, was unsuccessful in its attempt to bring a passing off action against a private preparatory school named “The Harrodian School”, located in Barnes, UK. While Harrods was considered to be universally recognised (at least in the UK), the business with which it was associated in the minds of the public was found to be not all-embracing. Although the circumstances of this case are different, even if one were to accept (which I do not) that “MONSTER ENERGY” is distinctive of the Opponent’s energy drinks, given the very different fields of activity it does not follow that the public would consider “MONSTER ENERGY” to be distinctive in relation to smartglasses or eyewear.

62 This brings me to the evidence on eyewear. I can accept that there has indeed been some use by the Opponent of its various trade marks in connection with sunglasses and eyewear. However, the Opponent faces at least three major hurdles with this evidence in relation to the present dispute.

63 First, there is scant evidence that “MONSTER ENERGY” eyewear has been distributed or sold in Singapore.⁴ After being challenged on this point by the Applicant, the Opponent tendered in its evidence-in-reply what it described as additional photos of its eyewear, together with invoices from sales of such eyewear across the world.⁵ However, it is impossible to tell from the photographs alone whether the products were actually sold to or purchased by consumers in this country. The sole document with any clear connection to

⁴ Opponent’s SD at exhibit PJD-2

⁵ Opponent’s SD-in-Reply at paragraphs 6 and 7, and exhibits PJD-33 and PJD-35

Singapore was an invoice for a shipment of 55 pieces of “MON WOODEN GOLD SUNGLASSES” to the Opponent’s local subsidiary. Moreover, this invoice was dated 24 September 2020, sometime after the date on which the Application Mark was applied for (on 31 December 2018).

64 Second, it is clear that the primary marks used on the eyewear (which in most instances appear to be co-branded with brands such as “WOODZEE” and “D.Franklin”) are the Opponent’s stylised and/or composite marks, not the plain word mark “MONSTER ENERGY”. This reinforces my view that the public would not consider the plain “MONSTER ENERGY” to be distinctive of the Opponent in relation to eyewear. I reproduce some relevant extracts below to illustrate this point.

No.

Extract from the evidence

(a)



⁶ Opponent’s SD-in-Reply at Exhibit PJD-33

(b)



(c)



65 Third, there is evidence that customers in this country have purchased the Applicant's GENTLE MONSTER eyewear through its official website (since 2015) and/or its two physical stores in Singapore (which opened in 2017 and 2019 respectively). I do not think it necessary to go through the Applicant's evidence of use in detail. A brief snapshot of the GENTLE MONSTER sales

⁷ Opponent's SD Exhibit PJD-2

⁸ Opponent's SD at Exhibit PJD-2

figures in 2017 to 2018 relating to Singapore should suffice.⁹ (The Application Mark was filed on 31 December 2018, so the Opponent needs to establish its case by reference to that date.) In 2017, revenue from sales through the official website and Ion store was US\$131,920 and US\$940,814 respectively (approx. S\$1.48m). In 2018, the sales figures were US\$42,618 and US\$3,768,736 respectively (approx. S\$5.14m). These sales under the “GENTLE MONSTER” mark predate and far outstrip the extremely limited use of “MONSTER ENERGY” in relation to eyewear in Singapore.

66 In the circumstances, I find it inconceivable that the public would associate “GENTLE MONSTER” with the Opponent or think that the parties are commercially connected.

Conclusion and costs

67 For the reasons above, I dismiss the opposition on both pleaded grounds: ss 8(2)(b) and 8(7)(a) TMA.

68 I award costs to the Applicant. After considering the parties’ submissions on costs, I would award the Applicant the total amount of S\$ 9256.50 (inclusive of disbursements).

Ong Sheng Li, Gabriel
Principal Assistant Registrar

⁹ Applicant’s SD at [14]-[15] and Exhibit B (specifically, page 152)

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