IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2018] SGHC 238

Tribunal Appeal No 5 of 2018

In the matter of Trade Mark Registration No 40201515702X for "**SWEET MONSTER**" in Class 30 in the name of Glamco Co., Ltd of (SK M-City, Janghang-Dong) #B1101, 195, Baengma-Ro, Ilsandong-Gu, Goyang-Si, Gyeonggi-Do, Republic of Korea

And

In the matter of an opposition thereto by Monster Energy Company of 1 Monster Way, Corona, California 92879, United States of America

And

In the matter of Section 75(2)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) and
Order 55 and Order 87 of the Rules of Court (Cap 322, R 5, 2014 Rev Ed)

Between

Monster Energy Company

… *Appellant*

And

Glamco Co., Ltd

… *Respondent*

JUDGMENT

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[Trade Marks and Trade Names] — [Registration criteria] — [Conflicts with earlier marks]

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Monster Energy Company
v
Glamco Co, Ltd

[2018] SGHC 238

High Court — Tribunal Appeal No 5 of 2018
Chan Seng Onn J
24 August 2018

5 November 2018 Judgment reserved.

Chan Seng Onn J:

Introduction

1 This is an appeal by Monster Energy Company (the "Appellant"), a company incorporated and existing under the laws of Delaware, United States of America,[1] against the decision of the Principal Assistant Registrar of Trade Marks (the "PAR") in *Monster Energy Company v Glamco Co., Ltd* [2018] SGIPO7S 7 (the "GD").[2] Glamco Co., Ltd (the "Respondent") had applied to register the trade mark, SWEET MONSTER (the "Application Mark"), which is a plain word mark, in Class 30 of the International Classification of Goods and Services ("ICGS") in respect of the following goods ("Application Goods"):[3]

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1 Appellant's Bundle of Documents ("ABD") Vol 1, p 3.

2 ABD Vol 7, p 2503.

3 ABD Vol 1, p 2.

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> Popcorn; food products containing (principally) cereals; confectionary; gum sweets; biscuits; bread; sweetmeats (candy); iced cakes; ice cream; non-medicated confectionary in jelly form; chocolate; cookies; rice cakes; chemical seasonings (cooking); sauces; tea; coffee; cocoa products; non-medicated tea based beverages; chocolate based products.

2 This application was opposed by the Appellant, which is the registered proprietor of the following prior marks in Singapore (collectively, the "Appellant's Earlier Marks").[4] For ease of reference, I have grouped the Appellant's Earlier Marks in the same broad categories as the PAR.

S/N	Mark and Registration No	ICGS class and specification of goods
Appellant's Earlier Monster Marks		
1	MONSTER T0605638Z	Class 5: Nutritional supplements; vitamin drinks; drinks containing vitamins and minerals.
2	MONSTER T0605639H	Class 32: 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	Class 5: Nutritional supplements in liquid form in Class 5. Class 32: Non-alcoholic beverages in Class 32.
Appellant's Earlier Monster Prefix Marks		
4	MONSTER REHABITUATE T1210719E	Class 5: Nutritional supplements in liquid form.

[4] ABD Vol 1, pp 5 to 7.

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		Class 30: Ready to drink tea, iced tea and tea based beverages; ready to drink flavoured tea, iced tea and tea based beverages; all included in Class 30. Class 32: Non-alcoholic beverages, namely energy drinks, energy drinks flavoured with tea, energy drinks flavoured 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.
5	MONSTER REHAB T1107597D	Class 5: Nutritional supplements in liquid form; vitamin drinks; beverages containing added vitamins and minerals (for medical purposes); all included in Class 5. Class 30: Ready to drink tea, iced tea and tea based beverages; ready to drink flavoured tea, iced tea and tea based beverages; all included in Class 30. Class 32: Non-alcoholic beverages, namely energy drinks, energy drinks flavoured with tea, energy drinks flavoured with juice, sports drinks, and fruit juice drinks; all of the aforegoing enhanced with vitamins, minerals, nutrients, amino acids and/or herbs; all included in Class 32.
6	MONSTER DETOX T1206503D	Class 5: Nutritional supplements in liquid form in Class 5. Class 30: Ready to drink tea, iced tea and tea based beverages; ready to drink flavoured tea, iced tea and tea based beverages; all included in Class 30. Class 32:

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		Non-alcoholic beverages, including energy drinks, energy drinks flavoured with tea, energy drinks flavoured 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.
Appellant's Earlier Monster and Claw Device Marks		
7	 T0609605E	Class 32: Beverages; preparations for making beverages.
8	 T0813672J	Class 9: Protective clothing; protective footwear; protective headwear; protective eyewear; all included in Class 9. Class 16: Printed matter and publications; posters; stickers; transfers; cards; stationary; signboards; all included in Class 16. Class 18: Bags; backpacks; wallets; cases; key cases; leather and imitations of leather, and goods made of these materials and not included in other classes; all included in Class 18. Class 25: Clothing; footwear and headgear; all included in Class 25.

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9	 T1402721J	Class 16: Printed matter and publications; posters; stickers; sticker kits comprising stickers and decals; decals; transfers; cards; stationery; signboards of paper or cardboard. Class 25: Clothing, namely t-shirts, hooded shirts and hooded sweatshirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely hats and beanies.
Appellant's Earlier Monster Energy Marks		
10	MONSTER ENERGY T0603081Z	Class 32: Mineral and aerated waters and other non-alcoholic drinks; energy drinks; isotonic beverages (non-medicated); fruit drinks; fruit juices and syrups for preparing beverages.
11	MONSTER ENERGY T0813668B	Class 9: Protective clothing; protective footwear; protective headwear; protective eyewear; all included in Class 9. Class 16: Printed matter and publications; posters; stickers; transfers; cards; stationery; signboards; all included in Class 16. Class 18: Bags; backpacks; wallets; cases; key cases; leather and imitations of leather, and goods made of these materials and not included in other classes; all included in Class 18. Class 25: Clothing; footwear and headgear; all included in Class 25.
12	MONSTER	Class 35:

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	ENERGY 40201501193T	Promoting goods and services of others in the sports, motorsports, electronic sports, and music industries through the distribution of printed, audio and visual promotional materials; promoting sports and music events and competitions for others; retail and wholesale foods and beverage distributorship services; Online retail store services in the field of beverages, clothing, headwear, calendars, posters, stickers, promotional items. Class 41: Entertainment services; organizing, conducting and staging sports events, live musical performances, exhibitions and competitions; on-line publication and provision of multimedia content in the nature of multimedia files containing audio, video, text, still images, and graphics in the fields of sports, people, entertainment, and music; providing a website featuring non-downloadable publications in the nature of multimedia content in the nature of multimedia files containing audio, video, text, still images, and graphics in the fields of sports, people, entertainment and music via a website.
13	MONSTER ENERGY 40201401724W	Class 9: Protective clothing; protective footwear; protective headwear; protective eyewear, sports helmets; protective covers and cases for electronic devices; earphones and headphones; eye glasses; eye glass cases; sunglasses; sunglass cases; video recordings featuring sports, extreme sports, and motor sports; cell phone cords; eyeglass cords; lanyard for holding ID tag; lanyards for holding credential certificate; lanyards for holding encoded key cards; lanyards for holding keys; lanyards for holding sound recording carriers; lanyards for holding portable media players. Class 16: Printed matter and publications; posters; stickers; decals; transfers; cards; stationery; signboard of paper and cardboard; sticker kits comprising

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		stickers and decals. Class 18: Bags; backpacks; wallets; cases; key cases; duffle bags; book bags; handbags; all-purpose sports bags; all-purpose bags; leather and imitations of leather, and goods made of these material and not included in other classes. Class 25: Clothing, footwear, and headgear.
Appellant's Earlier Monster Suffix Marks		
14	JAVA MONSTER T0611182H	Class 32: 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; flavoured waters, fruit juices; concentrates, syrups or powders used in the preparation of soft drinks or energy drinks.
15	JAVA MONSTER T1402722I	Class 32: Non-alcoholic beverages.
16	X-PRESSO MONSTER T1009880F	Class 5: Nutritional supplements in Class 5. Class 32: Non-alcoholic beverages being energy drinks in Class 32 flavoured with coffee.

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3 I note that the Appellant relies predominantly on the Appellant's Earlier Monster Marks for its opposition application, both at the hearing before the PAR and the hearing before me. This is on the basis that out of all the Appellant's Earlier Marks, these are the marks most similar to the Application Mark.[5] I agree with the PAR that if the Appellant's Earlier Monster Marks are found to be dissimilar to the Application Mark, the same would follow for the rest of the Appellant's Earlier Marks (GD at [20(ii)]). This therefore focuses the inquiry to a comparison between the Application Mark and the Appellant's Earlier Monster Marks.

4 Before the PAR, the Appellant based its opposition on the following grounds:

(a) Section 8(2)(*b*) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("TMA");

(b) Section 8(4)(*b*)(i) of the TMA;

(c) Section 8(4)(*b*)(ii)(A) and (B) of the TMA; and

(d) Section 8(7)(*a*) of the TMA.

The Appellant's opposition failed on all grounds.

5 In dismissing the Appellant's opposition application under s 8(2)(*b*) and s 8(4)(*b*)(i), the PAR found that the Application Mark and the Appellant's Earlier Monster Marks were more dissimilar than similar (GD at [90] and [93]). In dismissing the Appellant's opposition application under s 8(4)(*b*)(i) and (ii), the PAR also found that the Appellant's Earlier Monster Marks were neither

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[5] Appellant's Written Submissions, para 39.

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"well-known in Singapore" nor well-known "to the public at large" (GD at [100] and [114]). Finally, in dismissing the Appellant's opposition under s 8(7)(*a*), the PAR found that there was no likelihood of misrepresentation that the Applicant and the Respondent are one and the same, or that they are economically linked, given the dissimilarity of the marks (GD at [126]).

6 In the Appellant's appeal before me, it once again canvasses all of the grounds that it had relied on at the hearing below (as stated at [4] above). Having heard the parties' oral submissions and considered their written submissions, I dismiss the appeal and allow the Respondent's trade mark application No 40201515702X for the "SWEET MONSTER" word mark in Class 30 to proceed to registration. These are the reasons for my decision.

Background Facts

Facts pertaining to the Appellant

7 With respect to the Appellant, the PAR set out the following background facts at [8] to [9] of her GD:

> 8 The [Appellant] deposed that it is in the business of designing, creating, developing, producing, marketing and selling energy drinks ([3] of the [Appellant's] 1st SD). The [Appellant] also deposed that it has been acknowledged as a leader in the beverage industry, and has received recognition and awards ([4] of [Appellant's] 1st SD). The [Appellant's] MONSTER marks have also been filed/registered worldwide in more than 150 countries ([7] of the [Appellant's] 1st 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 ([24] of [Appellant's] 1st SD).
>
> 9 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 ([31] of [Appellant's] 1st SD).

Facts pertaining to the Respondent

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8 With respect to the Respondent, the following background facts were set out at [11] to [12] of the PAR's GD:

> 11 The [Respondent] deposed that it was incorporated in 2014 in the Republic of Korea ([4] of the [Respondent's] SD), that it is the creator of "popcorn soft-serve ice cream" and is known for its colourful creations featuring generous portions of soft-serve ice cream, made from the [Respondent's] ice cream milk powder and topped with the [Respondent's] air popped gourmet popcorn ([5] of the [Respondent's] SD).
>
> 12 The [Respondent] deposed that while it opened its first store in Korea, owing to its popularity and success, it expanded its operations overseas. To-date, in addition to the 23 outlets in Korea, there are 13 outlets overseas ([6] of the [Respondent's] SD).

The decision of the PAR

The PAR's findings with respect to the Appellant's contention that it had a "family of marks"

9 As a preliminary point, the PAR dealt with the issue of whether the Appellant has a "MONSTER" family of marks. The PAR held that the Appellant had not established that it has a family of trade marks in relation to the Appellant's Earlier Monster Marks (GD at [52]). Specifically, the evidence that the Appellant had tendered did not support the Appellant's contention that there was a "MONSTER" family of marks, because the actual marks which were exposed via the promotional materials were not the plain word mark "MONSTER" *simpliciter* (GD at [32] and [51]).

*The PAR's findings with respect to s 8(2)(*b*) of the TMA*

10 Section 8(2)(*b*) of the TMA states:

> **Relative grounds for refusal of registration**
>
> **8.**— …
>
> (2) A trade mark shall not be registered if because —

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> …
>
> (*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.

11 With respect to the Appellant's opposition under s 8(2)(*b*) of the TMA, the PAR adopted the "step-by-step approach" (PAR's GD at [14]) which was re-affirmed by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 ("*Staywell*") at [15]:

> … Under the step-by-step approach, *the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically*. The first two elements are assessed individually before the final element which is assessed in the round. … [emphasis added]

12 On the first requirement of similarity of the marks, the PAR found that having regard to the allusive quality of the word mark "MONSTER", it did not fall into the category of inherently distinctive marks which have no or little significance to the goods or services in question. Therefore, it could be said to be at the lower end of the spectrum of distinctiveness, and would not enjoy a high threshold before the Application Mark would be considered dissimilar to it (GD at [60] and [61]).

13 The PAR found that the marks were visually more dissimilar than similar (GD at [74]), given that:

(a) The Appellant's Earlier Monster Mark comprises one word whereas the Application Mark has two words.

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(b) Both words in the Application Mark – "sweet" and "monster" – are of equal prominence.

(c) The additional word "sweet" appears at the beginning of the Application Mark, and is therefore unlikely to be overlooked by the average consumer.

(d) The word "sweet" being an adjective, colours the noun "monster" such that the Application Mark forms a unitary whole and projects a different overall impression (relative to the Appellant's Earlier Monster Mark).

14 With regard to aural similarity, the PAR applied the "Quantitative Assessment Approach" and found that the marks have more syllables in common than not (GD at [80]). Therefore, she concluded that the Appellant's Earlier Monster Marks were aurally more similar than dissimilar in comparison to the Application Mark.

15 With regard to conceptual similarity, the PAR found that taking into account the allusiveness of each mark when considering the marks as a unitary whole, the marks were conceptually more dissimilar than similar (GD at [86] and [87]). Overall, she was of the view that the marks were more dissimilar than similar (GD at [90]). The PAR stated that having regard to the "3-step test", her conclusion that the marks were more dissimilar than similar ended the inquiry with regard to the objection under s 8(2)(*b*) of the TMA.

The PAR's findings with respect to s 8(4)(b)(i) of the TMA

16 Section 8(4)(*b*)(i) of the TMA states:

> 8.–(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004,

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> *if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark*, the later trade mark shall not be registered if –
>
> > (*a*) the earlier trade mark is *well known in Singapore*; and
> >
> > (*b*) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered –
> >
> > > (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark…
>
> [emphasis added]

17 On the threshold requirement for the "whole or an essential part of the trade mark [to be] identical with or similar to an earlier trade mark", the PAR stated that this was essentially the same as the similarity element under s 8(2)(*b*). Given that she had found the marks to be more dissimilar than similar, there was strictly no need for her to look into the other elements of this ground of objection (GD at [93] to [94]).

18 Nevertheless, she went on to consider the question of whether the Appellant's Earlier Monster Marks were well known in Singapore as at the date of application of the Application Mark. She found that the Appellant's Earlier Monster Marks were not well known since the actual marks which were portrayed as shown via the evidence were not the "MONSTER" word mark *simpliciter* (GD at [100]). Therefore, she concluded that the ground of opposition under s 8(4)(*b*)(i) TMA fails.

The PAR's findings with respect to s 8(2)(b)(ii)(A) and (B) of the TMA

19 Section 8(4)(*b*)(ii) of the TMA states:

> 8.–(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004,

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> *if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark*, the later trade mark shall not be registered if –
>
> > (*a*) the earlier trade mark is *well known in Singapore*; and
> >
> > (*b*) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered –
> >
> > …
> >
> > > (ii) if the earlier trade mark is well known to the public at large in Singapore –
> > >
> > > > (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
> > > >
> > > > (B) would take unfair advantage of the distinctive character of the earlier trade mark.

20 With regard to the requirement that the mark must be "well known to the public at large in Singapore", the PAR found that the Appellant's figures relating to expenditure on marketing, exposure via physical sales outlets, sales figures and surveys fell short in comparison to other cases where the marks were found to satisfy this requirement. Further, the evidence that was tendered with regard to the use of the mark in Singapore did not reflect use of the Appellant's Earlier Monster Marks and therefore provided no assistance to the Appellant's case (GD at [107] and [108]). Therefore, the PAR concluded that the Appellant's Earlier Monster Marks have not attained the coveted status of being a mark that is "well known to the public in Singapore" (GD at [113]).

21 Given that the "well known to the public in Singapore" element was not made out, in addition to her prior conclusion that the marks were not similar, she stated that there was no need for her to go further and look at the other limbs of dilution and unfair advantage. Therefore, she found that the ground of opposition under s 8(4)(*b*)(ii) fails.

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The PAR's findings with respect to s 8(7)(a) of the TMA

22 Section 8(7)(*a*) of the TMA states:

> (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…

In relation to this ground of opposition, the classical trinity of (a) goodwill, (b) misrepresentation, and (c) damage has to be established.

23 Given the sales and promotional figures that were adduced by the Appellant, the PAR stated that she was prepared to accept that the Appellant had the relevant goodwill in Singapore (GD at [119]). As for the element of misrepresentation, the PAR found that taking into account the dissimilarity of the marks, and the difference in the overall impression conveyed by the marks, there was no likelihood of misrepresentation that the Appellant and the Respondent are economically linked (GD at [126). There was no need to consider the damage element and she found that the ground of opposition under s 8(7)(*a*) fails.

The Appellant's arguments on appeal

24 In its written submissions, the Appellant relies on the same grounds of opposition and arguments as it did before the PAR below. However, counsel for the Appellant, Mr Just Wang, informed me that he would be focusing his oral submissions on what he thought was his strongest case, *ie*, opposition under s 8(2)(*b*) of the TMA. Be that as it may, I will in this judgment also make a determination on the other grounds of opposition raised by the Appellant.

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25 As a preliminary point, the Appellant argues that its brand architecture involves the distinctive mark "MONSTER" on its own, and also a family of "MONSTER"-formative marks such as "JAVA MONSTER", "X-PRESSO MONSTER", "MONSTER DETOX", "MONSTER REHABITUATE" and "MONSTER ENERGY". Therefore, in many instances, the Appellant's "MONSTER" family of marks are used in a format comprising the pairing of the word "MONSTER" with another subsidiary word element and the highly distinctive element "MONSTER" brings with it instant consumer recognition and goodwill associated with the Appellant.[6]

Appellant's arguments for s 8(2)(b) of the TMA

26 On the ground of opposition under s 8(2)(*b*) of the TMA, the Appellant argues that the word mark "MONSTER" possesses a high level of inherent distinctiveness in relation to the registered goods in question. This is on the basis that the word "MONSTER" bears no descriptive significance in relation to the Appellant's registered goods *ie*, nutritional supplements and beverages.[7] In that regard, the Appellant argues that the PAR had erred in finding that the "MONSTER" mark would be "at the lower end of the spectrum of distinctiveness" given its "allusive quality".[8] On the point of visual similarity, the Appellant states that the Appellant's Earlier Monster Mark is wholly subsumed within the Application Mark, and the additional word "SWEET" is merely a word used to describe the Respondent's goods and is therefore insufficient to distinguish the marks. The focus of the consumer will be on the dominant element "MONSTER" given that the average consumer is unlikely to attach much significance to a mere descriptive element of the mark.[9] The

6 Appellant's Written Submissions, para 11.

7 Appellant's Written Submissions, para 45.

8 Appellant's Written Submissions, para 42.

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Appellant analogises this to the Court of Appeal case of *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 ("*Ceramiche Caesar*") which involved a comparison of the stylized marks ·CÆSAR· and caesarstone. The Court found that the word "caesar" was distinctive in relation to non-metallic building materials and that the word "stone" was merely descriptive of the goods in Class 19, and therefore held that the marks were visually similar.[10]

27 With regard to conceptual similarity, the Appellant states that the inquiry is directed at the ideas which lie behind or inform the understanding of the marks in question. Therefore, even if the word "SWEET" conveys a sense of cheerfulness and friendliness in contrast to the concept of a monster, a "sweet" monster is ultimately still a type of monster and the word "sweet" is insufficient to distinguish the Application Mark from the Appellant's Earlier Monster Marks conceptually.

28 With regard to the similarity of the registered goods, the Appellant argues that both the Appellant's and the Respondent's registered goods are similar given that they:

(a) Are for the same purpose (*ie*, beverages for the purpose of drinking and satiating thirst);[11]

(b) have the same users (*ie*, the general public);[12]

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9 Appellant's Written Submissions, para 48.

10 Appellant's Written Submissions, para 52.

11 Appellant's Written Submissions, para 86.

12 Appellant's Written Submissions, para 87.

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(c) have the same physical form (*ie*, liquid);[13]

(d) are sold through the same channels (*ie*, supermarkets and convenience stores);[14] and

(e) are highly substitutable, given that tea and coffee are caffeinated beverages which consumers turn to for an energy boost.[15]

29 With regard to the final element on likelihood of confusion, the Appellant argues that there exists a likelihood of confusion amongst members of the general public, due to:

(a) The high degree of similarity between the marks;

(b) The strength and reputation of the "MONSTER" family of marks which would cause an average consumer to be confused into thinking that the goods offered under the Application Mark are part of the Appellant's family of marks;

(c) The high degree of similarity of the parties' registered goods;

(d) The goods are low-priced and frequently purchased and therefore the average consumer will not exercise a high level of attention when making a purchase.

Appellant's arguments for s 8(4)(b)(i) of the TMA

30 As a preliminary point, the Appellant appeals against the finding of the PAR that the "MONSTER" mark was not well known in Singapore since the

13 Appellant's Written Submissions, para 91.

14 Appellant's Written Submissions, para 93.

15 Appellant's Written Submissions, para 96.

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actual marks which were portrayed in the evidence were instead the stylised mark, on the basis that the stylisation is not so significant as to detract from the average consumer's reading of the mark as "MONSTER".[16]

31 With regard to the first element of the similarity of marks, the Appellant repeats its arguments as I have reproduced at [26] and [27] above. With regard to the second element of whether the Appellant's Earlier Monster Marks are "well known in Singapore", the Appellant identifies the relevant sector of the public in Singapore as "actual and potential consumers of beverages, and in particular, energy drinks", and relies on evidence of its promotional and marketing material to show that the use of the mark is widespread in Singapore.[17] With regard to the third element on a "connection between the Respondent's goods and the Appellant", the Appellant relies on the same arguments it made in relation to the "likelihood of confusion limb of s 8(2)(*b*) at [29] above. Finally, with regard to the last element that the "connection is likely to damage the Appellant's interests", the Appellant argues that there will be damage from the blurring of the distinctiveness of the Appellant's Earlier Monster Marks when consumers buy the Respondent's goods thinking that they belong to the Appellant, and further that there will be damage by restricting the Appellant from expanding into related fields of activity such as coffee or cocoa products.[18]

Appellant's arguments for s 8(4)(*b*)(ii) of the TMA

32 With regard to the first element of the similarity of marks, the Appellant repeats its arguments made above. With regard to the second element for the

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16 Appellant's Written Submissions, para 120.

17 Appellant's Written Submissions, para 129 and 130.

18 Appellant's Written Submissions, para 140 and 142.

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mark to be well known to the public at large in Singapore, the Appellant repeats its evidence of its promotional and marketing material, and further states that the sales and marketing expenditure figures of the Appellant are similar to other companies whose marks have attained the status of "well known to the public at large in Singapore".[19] With regard to the element of "dilution in an unfair manner", the Appellant repeats its arguments on damage caused by blurring as in [31] above. Finally, with regard to the element of "taking unfair advantage of the distinctive character of the earlier marks", the Appellant states that the Application Mark is a clear attempt at exploitation on the coat-tails of the Appellant's well known "MONSTER" trade mark, in order to benefit from its power of attraction, reputation and prestige, without any financial compensation to the Appellant.[20]

Appellant's arguments for s 8(7)(a) of the TMA

33 Given that the PAR had found that the Appellant has the relevant goodwill in Singapore, this point is not heavily pursued by the Appellant. With regard to the element of misrepresentation, the Appellant essentially repeats its arguments in relation to the "similarity of goods" and "likelihood of confusion" elements of s 8(2)(*b*) as stated at [28] and [29] above. Finally, on the element of damage, the Appellant cites the risk of blurring the distinctiveness of its marks as well as restrictions on its expansion into related goods.

The Respondent's Arguments

34 In relation to the Appellant's contention that it has a family of "MONSTER" marks, the Respondent submits that the Appellant's evidence relates primarily to the use of the Appellant's Earlier Monster and Claw Device

19 Appellant's Written Submissions, paras 149 and 150.

20 Appellant's Written Submissions, para 175.

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Marks as well as the Appellant's Earlier Monster Energy Marks.[21] Therefore, there is insufficient evidence to support a finding that the Appellant has a family of "MONSTER" marks.

35 In relation to the technical distinctiveness of the Appellant's Earlier Monster Mark, the Respondent adopts the reasoning of the PAR and argues that the word "monster" is allusive of an animalistic level of energy, akin to that of a monster which the consumer may be imbued with after consuming the Appellant's energy drinks and caffeinated beverages. Therefore, having regard to this allusive quality, the "MONSTER" mark is on the lower end of the spectrum of distinctiveness.[22]

36 In relation to the visual similarity between the Application Mark and the Appellant's Earlier Monster Mark, the Respondent argues that both words "SWEET" and "MONSTER" are of equal prominence. Both words are in plain font, with no differences in font size, and are also of similar length. Therefore, there is no reason why the word "MONSTER" would be the dominant component of the mark that stands out relative to the word "SWEET".[23] Further, the Respondent argues that monsters are not typically described as being "sweet" and therefore the atypical nature of the Application Mark will have an impact on the consumer as a composite whole.[24]

37 In relation to the conceptual similarity, the Respondent relies on *Itochu Corporation v Worldwide Brands, Inc*. [2007] SGIPOS 9 ("*Itochu*") where it was found that the application mark "SWEETCAMEL" was not conceptually

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21 Respondent's Written Submissions, para 64.

22 Respondent's Written Submissions, paras 19 and 20.

23 Respondent's Written Submissions, para 28.

24 Respondent's Written Submissions, para 33.

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similar to the opponent's earlier "CAMEL" marks. While the "CAMEL" marks evoke a "sense of ruggedness, adventure and masculinity", being preceded by the adjective "SWEET" projects the totally opposite impression. Similarly, the "MONSTER" mark being preceded by the adjective "SWEET" changes the impression it conveys, from one that is terrifying and ferocious, to one that is sweet, loveable and cute.[25]

38 In relation to the similarity of the registered goods, the Respondent states that it would be too general and simplistic an approach to find that the Respondent's registered goods *ie*, tea; coffee; non-medicated tea based beverages are similar to the Appellant's registered goods based simply on the fact that both types of goods may come in a liquid form.[26] Further, the users and uses of tea and coffee versus energy drinks are also different. Consumers of energy drinks are typically concerned with getting a quick boost of energy, whereas drinking coffee and tea has more of a social element.[27]

39 Ultimately, the Respondent argues that the likelihood of confusion is low given that:

(a) There is a low degree of similarity between the marks. Specifically, the differentiating word "SWEET" appears at the start of the mark and given that consumers would ordinarily read from left to right, they would pay attention to the beginning of the mark.

(b) The overall impression of "SWEET MONSTER" is very different from "MONSTER".

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25 Respondent's Written Submissions, paras 43 and 44.

26 Respondent's Written Submissions, para 58.

27 Respondent's Written Submissions, para 61.

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(c) Even if consumers were initially confused, such confusion would be dispelled by the time of purchase since there would be time to inspect the goods.

(d) The level of attention is likely to be higher given that there is a high degree of brand loyalty in the food and beverage industry as it is largely dependent on personal preference.

40 In relation to whether the Appellant's Earlier Monster Marks can be regarded as well known, the Respondent states that the Appellant's evidence shows that it is the Appellant's Earlier Monster and Claw Device Marks and to a limited extent, the Appellant's Earlier Monster Energy Marks which are being used on its goods. Therefore, the plain word mark "MONSTER" cannot be said to be well known in Singapore.[28]

41 In relation to whether there is the risk of dilution, the Respondent argues that due to the dissimilarity between the marks and the registered goods under those marks, it is unlikely that consumers will form a "link" between the Respondent's goods and the Appellant such that there will be a gradual whittling away or dispersion of the identity and hold of the Appellant's Earlier Monster Marks.

42 In relation to whether there is unfair advantage, the Respondent states that a good gauge that there has been an unfair advantage is when there is evidence that the goods or services bearing the later mark sold because of the mental association with the earlier mark. However, the Appellant has not adduced any evidence of the Respondent having enhanced sales as a result of consumers' mental associations with the Appellant's Earlier Monster Mark.

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[28] Respondent's Written Submissions at para 95.

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43 Finally, in relation to the element of passing off, the Respondent states that if a mark is not distinctive of the Appellant's goods, the mere fact that the Respondent has used something similar or even identical in marketing or selling its products would not amount to a misrepresentation that the products are economically linked. Since, it was not the Appellant's Earlier Monster Marks under which the Appellant's goods were marketed and sold, those marks cannot be distinctive of the Appellant's goods. Therefore, the Respondent's use of the Application Mark would not amount to a misrepresentation. Further, there would be no damage given that there is no risk of blurring.

My decision

44 As a preliminary point, the Court of Appeal in *Ceramiche Caesar* ([26] *supra*) confirmed at [15] that O 87 r 4(2) of the Rules of Court (Cap 322, R 5, 2014 Rev Ed) directs an appellate court hearing an appeal from the Trade Mark Registry to hear the matter afresh. There is no threshold requirement that there must be a material error of fact or law before appellate intervention is warranted. Therefore, the applicable standard of review for this appeal will be that of a *de novo* hearing. Be that as it may, I am not precluded from, and will where appropriate, adopt the PAR's findings of fact and analyses where they accord with my own views.

The Appellant's opposition under s 8(2)(*b*) of the TMA

45 The Court of Appeal in *Staywell* ([11] *supra*) at [15] stated that the "step-by-step" approach for an opposition under s 8(2)(*b*) of the TMA requires the court to first assess the similarity of the application mark and the earlier mark(s). It is only if the marks are found to be similar does the court then move on to assess the similarity of the goods or services for which the marks are registered. It is only when both the first and second elements are satisfied that the court will

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go on to assess, on a whole, whether there is a likelihood of confusion on the part of the public.

46 Applying the "step-by-step" approach to the present case, these are the elements that have to be fulfilled before the Appellant can succeed on its opposition under this ground:

(a) that the Respondent's "SWEET MONSTER" word mark and the Appellant's "MONSTER" word mark are similar ("the first element");

(b) *if* the first element is satisfied, *then* that the Respondent's "SWEET MONSTER" word mark is to be registered for goods identical with or similar to those for which the Appellant's Earlier Monster Marks are protected ("the second element"); and

(c) *if* the first and second element are *both* satisfied, *then* that there exists a likelihood of confusion on the part of the public by virtue of the similarity of the marks (*ie*, the first element) and of the goods (*ie*, the second element) ("the third element").

The first element: similarity between the "SWEET MONSTER" and "MONSTER" word marks

(1) Technical distinctiveness

47 The Court of Appeal has stated that technical distinctiveness is an integral factor in the marks-similarity inquiry, given that a mark which has greater technical distinctiveness enjoys a higher threshold before a competing sign will be considered dissimilar to it: *Staywell* ([11] *supra*) at [25]. Technical distinctiveness is defined as "the capacity of a mark to operate as a badge of origin", as opposed to merely being a description of the goods or services. This

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technical distinctiveness can be inherent, usually where the words comprising the mark are meaningless and can say nothing about the goods or services; or acquired, where words that do have a meaning and might well say something about the goods or services, yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use: *Staywell* ([11] *supra*) at [24].

48 I am of the view that the Appellant's Earlier Monster Marks do not possess a high level of technical distinctiveness for three reasons. First, the word "monster" is not a made up or fabricated word and has the following ordinary meanings in the English language (as defined in the Oxford English Dictionary):

> Noun
>
> 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.

Therefore, the Appellant's Earlier Monster Marks would not be inherently distinctive. However, even though a word or phrase may not be newly coined, a mark may still have high technical distinctiveness if the meaning of that word has little bearing on the product to which it is to be applied: *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 at [61].

49 This brings me to my second reason, which is that the word "monster" has an allusive and laudatory meaning in relation to the Appellant's goods *ie*, energy drinks and caffeinated beverages. The word "monster" when used in relation to the Appellant's energy-boosting beverages suggests that upon consuming these beverages, a consumer would gain a great level of energy and strength, much like a large and ferocious monster. Therefore, it cannot be said

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that the word "monster" has no bearing on the Appellant's products, given that it is laudatory as to the effectiveness of the beverage in achieving its intended purpose of providing an energy boost to the consumer.

50 Third, the Appellant fails to establish that the Appellant's Earlier Monster Marks have acquired distinctiveness through "long-standing or widespread use". To better explain this concept, consider the hypothetical situation where the technology giant Apple Inc. only adduces evidence of the use of its "iPad" mark. In such a situation, it cannot be said that the "i" prefix in its own right has gained distinctiveness through "long-standing or widespread use". If anything at all, it would be the "iPad" mark in its *entirety* that would be regarded as distinct. However, if Apple were to adduce evidence of the use of several other marks each bearing the "i" prefix, then perhaps a case could be made that the "i" prefix has itself gained distinctiveness.

51 In this regard, the Appellant has adduced much evidence in an attempt to demonstrate the widespread use of the Appellant's Earlier Marks both in Singapore and worldwide, and therefore that the Appellant's Earlier Monster Marks have gained distinctiveness.[29] I gratefully adopt the PAR's analysis at [21] to [52] of the GD, where she has meticulously gone through each piece of evidence cited by the Appellant and indicated which of the Appellant's Earlier Marks (if any) appear or feature in them. I note that the evidence predominantly demonstrates the use and exposure of the Appellant's Earlier Monster and Claw Device Marks as well as the Appellant's Earlier Monster Energy Marks. Therefore, if anything at all, it would only be the "MONSTER ENERGY" mark that has gained distinctiveness through widespread use. Accordingly, there is insufficient evidence to support the contention that the Appellant's Earlier

[29] Appellant's Written Submissions, paras 17 to 31.

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Monster Marks have, in their own right, gained distinctiveness through long-standing or widespread use.

52 Having determined that the Appellant's Earlier Monster Marks do not possess a high level of technical distinctiveness, there is accordingly no need for a higher threshold to be crossed before the Application Mark will be considered dissimilar to it. I now turn to consider the similarity of the marks.

(2) Visual similarity

53 At the outset, I must emphasise that when assessing the *visual* similarity of two competing marks, the court should consider the relative *appearance* of the marks. This would typically involve looking at the physical attributes and features of the marks, such as (a) the length of the marks; (b) the structure of the marks (*ie*, whether there are the same number of words); and (c) whether the same letters are used in the marks: *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 ("*Ozone Community*") at [49], citing with approval Lionel Bently and Brad Sherman, *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) at p 865.

54 Turning now to my assessment of the visual similarity of the marks, I am of the view that the Application Mark and the Appellant's Earlier Monster Marks are visually dissimilar. This is notwithstanding that the marks have a common denominator *ie*, the word "MONSTER". In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816, Lai Kew Chai J stated at [26]:

> In cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially…

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This principle was subsequently cited with approval by the Court of Appeal in *Ceramiche Caesar* ([26] *supra*) at [32]. Further, the Court of Appeal in *McDonald's Corp v Future Enterprises* Pte Ltd [2005] 1 SLR(R) 177 ("*Future Enterprises*") stated at [28]:

> A mark may very well consist of some common word(s) or device but it does not necessarily follow that it is thereby incapable of being distinctive or will be confused with an existing mark with the same word or words. One must look at the mark as a whole.

55 In the present case, I am satisfied that the differentiating element *ie*, the word "SWEET", sufficiently and substantially distinguishes the Application Mark visually from the Appellant's Earlier Monster Marks. To this end, I rely on the reasoning set out in *Ozone Community* ([53] *supra*) where Woo Bih Li J found that the marks "HYSTERIC GLAMOUR" and "GLAMOUR" were visually dissimilar (at [53]). He came to this conclusion for the following reasons:

(a) The word "HYSTERIC", which appears at the beginning of the mark, is almost of equal length to the word "GLAMOUR" and therefore would not be entirely overlooked or overshadowed by the word "GLAMOUR".

(b) The "HYSTERIC GLAMOUR" mark comprises of two words while the "GLAMOUR" mark comprises only of one. This would be a visual difference that even a consumer with imperfect recollection would remember.

56 I find that the syntax of the Application Mark vis-à-vis the Appellant's Earlier Monster Marks in the present case is almost entirely similar to the syntax of the marks that were considered in *Ozone Community*. Therefore, I am of the view that Woo J's analysis should apply with equal force in the present case.

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57 The Appellant argues that the focus of a consumer when viewing the Application Mark will be placed on the dominant element "MONSTER", given that an average consumer is unlikely to attach any significance to the descriptive element of the mark *ie*, the word "SWEET".[30] It relies on *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 in which the Court of Appeal stated that at [62]:

> (b) The visual similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components. *When the other components of a complex mark or sign are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).* [emphasis added]

58 At the outset, I disagree with the Appellant's contention that the word "MONSTER" is the dominant element of the Application Mark. In my view, both of the words in the Application Mark, "SWEET" and "MONSTER", are equally prominent and there is hence no dominant element *per se*. First, both words appear in the same font without any stylisation. Second, both words are of fairly similar length in terms of the number of letters. The effect of this is that consumers would likely view the Application Mark as a unitary whole rather than just focus on one part of it.

59 The Appellant also attempts to analogise the present case to *Ceramiche Caesar* ([26] *supra*), where the Court of Appeal found that the marks ·CÆSAR· and were visually similar, notwithstanding that both marks were stylised and contained different device components (at [43] and [44]). However, I am of the view that *Ceramiche Caesar* can be distinguished from the present case for the following reasons.

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[30] Appellant's Written Submissions, para 48.

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(a) First, the differentiating feature in that case *ie*, the word "STONE" appears *after* the common element "CAESAR". In the present case, the differentiating word "SWEET" appears *before* the common element "MONSTER". This is an important difference given that an average consumer would read the mark from left to right and would therefore have his attention on the "CAESAR" component of the mark first, whereas in the present case the consumer's attention is likely to be caught by the word "SWEET" first.

(b) Second, both the ·CÆSAR· and caesarstone marks each comprise of only one word. In the present case, the Application Mark consists of two separate and distinct words while the Appellant's Earlier Monster Marks only consist of one.

(c) Third, the Court of Appeal considered the word "CAESAR" to be the distinctive and dominant component of the caesarstone mark, given that the device is an insignificant component and the word "STONE" is merely descriptive of the goods in the ICGS class under which the mark was registered. This was a significant factor influencing the Court of Appeal's finding that the marks were visually similar. However, for the reasons I have stated at [58] above, I am of the view that the "SWEET MONSTER" mark does not have a dominant component.

60 For the foregoing reasons, I find that the Application Mark is visually dissimilar to the Appellant's Earlier Monster Marks.

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(3) Aural similarity

61 The Court of Appeal in *Staywell* ([11] *supra*) endorsed two different approaches for assessing the aural similarity of two competing marks. The first is by comparing the aural similarity of only the dominant component of the marks (at [31]). The second approach is to undertake a quantitative assessment of whether the competing marks have more syllables in common than not (at [32]). In the present case, I find it more appropriate to adopt the second approach *ie*, the quantitative assessment approach, given my finding above that the Application Mark does not have a dominant component.

62 I agree with the PAR's analysis that when applying the quantitative assessment approach, the marks have more syllables in common than not since two out of the three syllables in the Application Mark are identical to that of the Appellant's Earlier Monster Marks (GD at [80]). I would add that the *sequence* of the syllables is also relevant in determining whether the marks are aurally similar. Consider the hypothetical situation where a mark that is pronounced "ster-sweet-mon" is compared to a mark that is pronounced "mon-ster". In such a case, even though two out of three syllables may also be similar, one would be less inclined to find that the marks are aurally similar. However, in the present case, such an issue does not arise given that the syllables which are similar (*ie*, "mon" and "ster") also appear in the same sequence. Therefore, I find that the marks are aurally more similar than dissimilar.

(4) Conceptual similarity

63 In assessing the conceptual similarity of competing marks, the comparison is between the ideas that lie behind and inform the understanding of the mark as a whole: *Staywell* ([11] *supra*) at [35].

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64 I am of the view that the Application Mark and the Appellant's Earlier Monster Marks are conceptually dissimilar, because the idea and impression that each mark conveys is very different. I agree with both the PAR and the Respondent that the analysis adopted by the Registrar in *Itochu* ([37] *supra*) is applicable to the present case. *Itochu* involved a comparison of the word marks "CAMEL" and "SWEETCAMEL". The Registrar found that the "CAMEL" mark evokes a sense of ruggedness, adventure and masculinity. This is unsurprising given that a camel is usually seen as a beast of burden that has to traverse long distances across parched desert conditions. However, the Registrar found that because of the addition of the adjective "sweet", the "SWEETCAMEL" mark projects the totally opposite impression (at [37]).

65 Indeed, the word "sweet" is defined in the Oxford English Dictionary as "pleasing in general; delightful" and also "charming and endearing". Therefore, when the word "sweet" is used as an adjective to describe the word "monster", it changes the impression that a consumer would get from an image of a "large, ugly and frightening imaginary creature" (at [48] above) to a "delightful" and "endearing" imaginary creature. I note that the idea of a "sweet" monster is not unheard of, and frequently appears in children's television programmes such as the Cookie Monster in Sesame Street, as well as in animated movies such as Monsters Inc. and Hotel Transylvania to name a few.

(5) Conclusion on the similarity between the "SWEET MONSTER" and "MONSTER" word marks

66 To summarise my findings, the Application Mark and the Appellant's Earlier Monster Marks are visually and conceptually dissimilar but are aurally more similar than dissimilar. On the whole, I find that the marks are on balance more dissimilar than similar.

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67 Applying the "step-by-step" approach (at [45] and [46] above), there is strictly no need for me to consider whether the goods registered under the competing marks are similar since I have found the marks to be dissimilar. Be that as it may, I will proceed to make some observations on the second element, *ie*, whether the Application Mark is to be registered for goods identical with or similar to those for which the Appellant's Earlier Monster Marks are protected.

Second element: similarity between the Appellant's and Respondent's registered goods

68 In *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR(R) 1082 at [14], Tan Lee Meng J set out a list of factors relevant for the assessment of the similarity of goods and services, citing with approval *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

> (a) the nature of the goods or services;
>
> (b) the end users of the goods or services;
>
> (c) the way in which the services are used;
>
> (d) whether the respective goods or services are competitive or complementary, how those in the trade classify the goods and the trade channels through which the goods or services reach the market; and
>
> (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found on the same or different shelves.

69 The Appellant states that for the purpose of its submissions on the similarity of goods, it is relying on its goods registered under Class 32. These would include the goods that were registered under the Appellant's Earlier Monster Suffix Marks.[31] However, given that the Appellant has relied solely on the Appellant's Earlier Monster Marks for the purposes of its opposition up till the marks similarity stage (see [3] above), I do not find it appropriate for the

[31] Appellant's Written Submissions, paras 83 and 84.

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Appellant to now rely on the goods registered under the Appellant's Earlier Monster Suffix Marks at this stage of the inquiry. In my view, the comparison of the goods should be confined to those registered under the Appellant's Earlier Monster Marks and those under the Application Mark.

70 For ease of reference, I set out again the goods to be compared:

<table>
<tr><th>Goods registered under the Appellant's Earlier Monster Marks</th><th>Application Goods</th></tr>
<tr><td>MONSTER (T0605638Z)
Class 5:
Nutritional supplements; vitamin drinks; drinks containing vitamins and minerals.</td><td rowspan="3">SWEET MONSTER
Class 30:
Popcorn; food products containing (principally) cereals; confectionary; gum sweets; biscuits; bread; sweetmeats (candy); iced cakes; ice cream; non-medicated confectionary in jelly form; chocolate; cookies; rice cakes; chemical seasonings (cooking); sauces; tea; coffee; cocoa products; non-medicated tea based beverages; chocolate based products.</td></tr>
<tr><td>MONSTER (T0605639H)
Class 32:
Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.</td></tr>
<tr><td>MONSTER (T1111969F)
Class 5:
Nutritional supplements in liquid form in Class 5.
Class 32:
Non-alcoholic beverages in Class 32.</td></tr>
</table>

71 Given that a majority of the goods registered under the Appellant's Earlier Monster Marks are beverages, it is immediately apparent that the only goods in the Application Goods with which they have any modicum of similarity are "tea", "coffee" and "non-medicated tea based beverages". The

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Appellant argues that the uses and the physical nature of the goods are similar, given that they are all beverages which are used for the purpose of satiating thirst, and further that they are all in liquid form.[32]

72 In my view, this places the comparison at too high a level of generality and does not yield any meaningful result. Indeed, it was observed in *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 15 at [119] that:

> [T]he 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.

Instead, I agree with the Respondent that the Appellant's goods, which predominantly comprise of energy-boosting beverages and vitamin enriched nutritional supplements in liquid form, would mainly be used for providing consumers with quick boosts of energy for use in sports or to combat fatigue. On the other hand, tea and coffee, while also potentially capable of providing consumers with a momentary boost of energy due to the presence of caffeine, have a variety of other uses. People tend to socialise over a cup of tea or coffee. Additionally, there is a significant group of connoisseurs and enthusiasts who appreciate the finer aspects of tea and coffee. To use the Respondent's words, "[t]here [are] more cultural, lifestyle or preferential behavioural patterns which can be observed as regards coffee and tea, as opposed to energy drinks".[33]

73 For this same reason, the target market for the respective goods would also be very different especially when viewed from the perspective of the different purposes served by the consumption of the respective goods. I do not view tea and coffee to be good substitutes for energy drinks and *vice versa*.

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32 Appellant's Written Submissions, paras 86 and 91.

33 Respondent's Written Submissions, para 61.

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Therefore, I do not accept the Appellant's contention that both the Appellant's and the Respondent's registered goods are similar given that they are highly substitutable and the potential users for both the respective goods would be the general public.

74 Finally, I note that the trade channels through which the respective goods reach the market are also very different. The Appellant states that its MONSTER ENERGY beverages are sold mainly at convenience stores, petrol kiosks, neighbourhood shops, supermarket chains and also online through online supermarkets and grocery retailers.[34] In comparison, the Respondent deposed that its products are sold at its very own SWEET MONSTER kiosks, as well as its café-concept outlets which offer consumers a dining-in experience and a more extensive range of food and beverage products.[35] Indeed, the Appellant has failed to adduce any evidence to show that the Respondent's products are sold anywhere else.

75 Therefore, although this would strictly have no bearing on my decision, I am of the view that the Appellant's and the Respondent's respective registered goods are dissimilar. Accordingly, the Appellant's opposition under s 8(2)(*b*) of the TMA cannot succeed.

76 Before I proceed to consider the Appellant's other grounds of opposition, I note parenthetically the Appellant's contention that it possesses a "MONSTER" family of marks which forms the backdrop to several of its grounds of opposition.[36] A preliminary issue that arises is whether the "family of marks" analysis features at the marks similarity stage (*ie*, the first element)

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34 Appellant's Written Submissions, para 23.

35 ABD Vol 6, p 1857, para 18.

36 Appellant's Written Submissions, para 5.

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or at the likelihood of confusion stage (*ie*, the third element). The PAR did not think that it was necessary for her to comment on this, given that she would, in any event, find that the Appellant has not established that it has a family of marks (GD at [17]). In my view, whether or not a mark is part of a larger "family of marks" should only feature in the likelihood of confusion stage of the analysis. This is necessarily so, given the trite principle that the "assessment of marks similarity is mark-for-mark without consideration of any external matter": *Staywell* ([11] *supra*) at [20]. In any event, this position seems to have been implicitly accepted in *Future Enterprises*, where the Court of Appeal agreed with the trial judge that the existence of a "series" or family of marks was one factor that the court would take into account in determining the likelihood of confusion (at [34]).

77 Given my finding at [66] above that the competing marks are dissimilar, there is strictly no need for me to consider whether there is a likelihood of confusion. Accordingly, there is no need for me to consider whether the Appellant has a family of marks. Be that as it may, I will, for completeness, make some brief observations on this issue.

78 In *Lacoste v Carolina Herrara, Ltd* [2014] SGIPOS 3, the Assistant Registrar of Trade Marks considered certain European and UK authorities and concluded at [38]:

> What comes across in the [European and UK] cases… is that, *prima facie*, **registration of a number of marks each bearing the same element in common, does not automatically give rise to the presumption that the consumer would perceive them as being a family or series of marks**, such that the registered proprietor of the marks is entitled to have protection of that common element. … [T]he registered proprietor who claims additional protection of that common element will **have to adduce sufficient evidence to show use of a sufficient number of these marks as to be capable of constituting a family or series of trade marks, for the purposes of the**

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> **assessment of the likelihood of confusion.** [emphasis added in bold]

79 I agree with the Assistant Registrar. In order to establish that a mark falls within a larger "family of marks", which I accept is one of the factors to be considered for the specific purpose of assessing the likelihood of confusion, sufficient evidence must first be adduced to show the use of a sufficient number of "members" of this family. Indeed, in the absence of such evidence, it cannot be said that a consumer would detect the common element present in these marks and associate them with being part of the same family. Further, given that a party which successfully establishes that it has a "family of marks" will be better able to establish the likelihood of confusion (as being part of a larger "family of marks" will be an additional factor that can contribute towards the finding that there will be a likelihood of confusion), this evidential requirement acts as an important safeguard to ensure that this doctrine is not abused.

80 The Appellant states that it has registered eight unique marks each containing the common element "MONSTER", *ie,* (1) MONSTER, (2) JAVA MONSTER, (3) X-PRESSO MONSTER, (4) MONSTER ENERGY, (5) MONSTER DETOX, (6) MONSTER REHAB, (7) MONSTER REHABITUATE and (8)

.[37] However, as I have alluded to at [50] above, the evidence before me only shows the use of the Appellant's Earlier Monster and Claw Device Marks as well as the Appellant's Earlier Monster Energy Marks. This only amounts to two out of the eight marks which purportedly form the "MONSTER" family of marks. Therefore, I am of the

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[37] Appellant's Written Submissions, para 11.

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view that there is insufficient evidence to support the Appellant's contention that it has a "MONSTER" family of marks.

81 For completeness, I would also point out that the PAR was not quite right to find that the Appellant had failed to establish that it has a "MONSTER" family of marks *because* the actual marks which were exposed via the promotional materials were not the plain word mark "MONSTER" *simpliciter* (at [9] above). As I have stated, in order to establish that there is indeed a family of marks, sufficient evidence must be adduced to show the use of a sufficient number of members of this family. Therefore, it does not follow that the Appellant does not have a family of marks simply because the Appellant has failed to show that the plain word mark "MONSTER" *simpliciter* has been exposed via the promotional materials. Hypothetically, it would have sufficed for the Appellant to adduce evidence showing use of the Appellant's Earlier Monster Prefix Marks and the Appellant's Earlier Monster Suffix Marks.

The Appellant's opposition under s 8(4)(b)(i) of the TMA

82 The four elements which need to be shown for an opposition under s 8(4)(*b*)(i) of the TMA, as stated in *Staywell* ([11] *supra*) at [119] are:

(a) The marks are identical or similar; *and*

(b) the earlier mark is well known in Singapore; *and*

(c) the use of the application mark would indicate a connection between the applicant's goods/services and the incumbent proprietor; *and*

(d) the connection is likely to damage the interests of the proprietor.

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83 The Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 held at [70] and [71] that the phrase "whole or an essential part of the trade mark" does not alter the inquiry for the similarity of marks. Therefore, the requirement of similarity under s 8(4)(*b*) of the TMA is essentially the same as that in s 8(2)(*b*). Given that I have already found at [66] above that the marks are dissimilar, the first element is accordingly not made out. Applying the "step-by-step" approach, this necessarily means that the ground of opposition under s 8(4)(*b*)(i) of the TMA fails right at the outset.

84 However, I would go on to add that given my observations (and that of the PAR which I have adopted) at [50] above, the evidence adduced by the Appellant does not demonstrate the use or exposure of the Appellant's Earlier Monster Marks in Singapore. Therefore, regardless of the threshold which needs to be crossed before a mark can be regarded to be "well known in Singapore", the Appellant fails at the outset as it cannot even establish a *prima facie* case that the Appellant's Earlier Monster Marks *ie*, the "MONSTER" word mark *simpliciter* is used in Singapore. Accordingly, the second element is also not made out.

85 Having found that two out of four elements are not made out, I conclude that the Appellant's ground of opposition under s 8(4)(*b*)(i) also fails and I say nothing more on this.

The Appellant's opposition under s 8(4)(*b*)(ii)(A) and (B) of the TMA

86 For ease of reference, s 8(4)(*b*)(ii) of the TMA states:

> 8.–(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if –

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> (a) the earlier trade mark is well known in Singapore; and
>
> (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered –
>
> …
>
> (ii) if the earlier trade mark is well known to the public at large in Singapore –
>
> (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
>
> (B) would take unfair advantage of the distinctive character of the earlier trade mark.

87 In order to succeed under this ground of opposition, the Appellant would have to satisfy the following elements:

(a) The whole or an essential part of the Application Mark is similar to the Appellant's Earlier Monster Marks; *and*

(b) the Appellant's Earlier Monster Marks are well known to the public at large in Singapore; *and*

(c) the use of the Application Mark in relation to the goods for which it is sought to be registered would

(i) cause dilution in an unfair manner of the distinctive character of the Appellant's Earlier Monster Marks; *or*

(ii) take unfair advantage of the distinctive character of the Appellant's Earlier Monster Marks.

88 It is apparent that the similarity of the marks is yet again a threshold requirement to be satisfied in order for this ground of opposition to be made out.

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As I have found above at [66], the marks are dissimilar and accordingly the first element cannot be made out.

89 With regard to the second element which requires the mark to be "well known to the *public at large* in Singapore", the test to be satisfied is of a higher threshold than that for "well known in Singapore" (see [82] and [84] above). This follows from *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382, where the Court of Appeal stated at [94] that "the test 'well known to the public at large in Singapore' must mean more than just 'well known in Singapore'. To come within the former test, the mark must necessarily enjoy a much higher degree of recognition." Similarly, in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216, the Court of Appeal stated that at [233]:

> A … much more extensive level of protection is granted to trade marks which have attained the *coveted status* of being "well known to the public at large in Singapore". These trade marks, which form a *rare and exclusive class*, are entitled to protection from use of the defendant's trade mark on dissimilar goods or services even in the absence of a likelihood of confusion… [emphasis added]

90 Therefore, given that I have found at [50] above that the evidence fails to even establish that the Appellant's Earlier Monster Marks are "well known in Singapore", it follows that it would not be "well known to the public at large in Singapore". Having found that the first two elements are not made out, I do not consider it necessary to move on to examine the third element. Accordingly, I dismiss the Appellant's ground of opposition under s 8(4)(*b*)(ii)(A) and (B) of the TMA.

The Appellant's opposition under s 8(7)(a) of the TMA

91 In relation to this ground of opposition, there are three elements to be established which correspond to the elements for the tort of passing off (*The*

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Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd [2016] 3 SLR 517 ("*AMC*") at [80]), namely:

(a) goodwill;

(b) misrepresentation; and

(c) damage.

Section 8(7)(*a*) of the TMA requires an opponent to adduce sufficient evidence to establish, at the very least, a *prima facie* case on the aforestated three elements: *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164].

Goodwill

92 In relation to the element of goodwill, the court's concern is whether there exists any attractive force in the plaintiff's (or in the present case, the Appellant's) business that brings in custom: *AMC* ([91] *supra*) at [81]; *Staywell* ([11] *supra*) at [131]. Goodwill, in the context of passing off, is concerned with goodwill in the business as a whole, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses: *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 ("*Singsung*") at [34]. Evidence of the sales and income generated by the business are regarded as a proxy for the attractive force of the business: *Singsung* at [58]; *Staywell* ([11] *supra*) at [141]. Goodwill may also be proved by evidence of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear: *Singsung* at [34].

93 The Appellant deposed that it has been selling its energy drinks in Singapore since October 2012. It currently sells MONSTER ENERGY,

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MONSTER ENERGY ABSOLUTELY ZERO and MONSTER KHAOS in Singapore. Up until 31 March 2016, the Appellant has sold more than 4.7 million cans of energy drinks which bear one or more of the Appellant's Earlier Marks in Singapore, amounting to sales of approximately US$4.2 million.[38] Additionally, the Appellant deposed that from April 2012 to March 2016, it has spent in excess of US$ 2.2 million in marketing and promotional activities to promote its energy drinks in Singapore.[39] In my view, this constitutes sufficient evidence to establish a *prima facie* case that the Appellant's *business as a whole* has goodwill in Singapore.

Misrepresentation

94 The approach to establishing whether or not there has been misrepresentation in the context of passing off was elaborated upon by the Court of Appeal in *AMC* ([91] *supra*) at [88]:

> [T]he real question … is whether the goodwill in the Appellant's business was sufficiently associated with the identifiers that it *had* used; whether those identifiers are distinctive of the Appellant's business; and whether by the use of *its* identifiers, the Respondent misrepresented its services as being those of, or connected to, the Appellant. [emphasis in original]

95 I have already found at [50] above that the bulk of the Appellant's evidence relates to the use and exposure of the Appellant's Earlier Monster and Claw Device Marks as well as the Appellant's Earlier Monster Energy Marks. Therefore, it is these marks that would be the "identifiers" that the Appellant *had* used and that would, if at all, be distinctive of the Appellant's business and any associated goodwill. Therefore, the appropriate comparison to draw for the purposes of establishing whether or not there is misrepresentation is, to my

38 ABD Vol 1, p 43, para 29.

39 ABD Vol 1, p 49, para 42.

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mind, between the Application Mark, and the Appellant's Earlier Monster and Claw Device Marks and Earlier Monster Energy Marks.

96 The Court of Appeal stated in *Singsung* at [40] that "[t]he misrepresentation in question *must give rise to confusion* (or the likelihood thereof) in order to be actionable under the law of passing off" [emphasis added]. In other words, the question is whether the Respondent's use of its "SWEET MONSTER" mark is likely to cause confusion among consumers such that they would associate the Respondent's products as being those of, or related to, the Appellant.

97 In my view, the use of the "SWEET MONSTER" mark is unlikely to give rise to any confusion that would link the Respondent's products to the Appellant. Visually, the Appellant's Earlier Monster and Claw Device Marks and Earlier Monster Energy Marks are even more dissimilar to the Application Mark than the Appellant's Earlier Monster Marks. Conceptually, the Appellant's Earlier Monster and Claw Device Marks evoke the same idea of a "large, ugly and frightening imaginary creature" as the Appellant's Earlier Monster Marks (see [65] above). In fact, the inclusion of the claw device, which resembles claws or the scratch marks that would be created by claws, serves to further accentuate this idea. Similarly, the Appellant's Earlier Monster Energy Marks convey the idea of a ferocious and monstrous level of energy and power. This stands in contradistinction to the idea conveyed by the Application Mark, which is that of a "delightful" and "endearing" imaginary creature. In any event, considering that the Appellant's main business is the manufacture and sale of energy drinks, whereas the Respondent's business is in the manufacture and sale of desserts, I am convinced that there will be little risk of confusion (if any at all). Accordingly, I am of the view that the element of misrepresentation is not made out.

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98 Having found that the element of misrepresentation is not made out, there is no need for me to consider the element of damage. Therefore, the Appellant's opposition under s 8(7)(*a*) of the TMA fails.

Conclusion

99 Given the number of grounds of opposition that the Appellant has relied on, it would perhaps be useful for me to summarise my findings:

(a) Opposition under s 8(2)(*b*) of the TMA: I find that (i) the Appellant's Earlier Monster Marks do not possess a high level of technical distinctiveness; (ii) the marks are visually and conceptually dissimilar although they are aurally more similar than dissimilar; and (iii) as a whole, the marks are on balance more dissimilar than similar. Though strictly unnecessary, I also find the registered goods of each party to be dissimilar. Therefore, this ground fails (at [45] to [76] above).

(b) Opposition under s 8(4)(*b*)(i) of the TMA: I find that the marks are dissimilar, and though strictly unnecessary, I also find that the Appellant has failed to adduce sufficient evidence to show that the Appellant's Earlier Monster Marks are well known in Singapore. Therefore, this ground fails (at [82] to [84] above).

(c) Opposition under s 8(4)(*b*)(ii)(A) and (B) of the TMA: I find that the marks are dissimilar. Additionally, given that the Appellant has failed to show that the Appellant's Earlier Monster Marks are well known in Singapore, it also fails to reach the higher threshold of well known to the public at large in Singapore. Therefore, this ground fails (at [86] to [90] above).

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(d) Opposition under s 8(7)(*a*) of the TMA: I find that there is goodwill associated with the Appellant's business in Singapore. However, given the differences between the Appellant's identifiers and the Application Mark, I find that there is no likelihood of misrepresentation. Therefore, this ground fails (at [91] to [98] above).

100 For all the foregoing reasons, I dismiss the Appellant's appeal in its entirety, and allow the Respondent's trade mark application No 40201515702X for the "SWEET MONSTER" word mark in Class 30 to proceed to registration.

101 If the parties are unable to agree on costs within three weeks, the Respondent is to write to the Registrar to fix a date for hearing on costs.

Chan Seng Onn
Judge

Just Wang and Penelope Ng (Bird & Bird ATMD LLP) for the Appellant;
Tan Zhishu Gillian (Infinitus Law Corporation) for the Respondent.

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