

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

[2024] SGIPOS 8

Trade Mark Nos. 40202107523R and 40202107524Q

IN THE MATTER OF TRADE MARK APPLICATIONS

IN THE NAME OF

ARTISAN BOULANGERIE COMPAGNIE PTE LTD

... Applicant

AND

OPPOSITIONS BY

MONSTER ENERGY COMPANY

... Opponent

GROUND OF DECISION

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Monster Energy Company
v
Artisan Boulangerie Compagnie Pte Ltd

[2024] SGIPOS 8

Trade Mark Nos. 40202107523R and 40202107524Q

IP Adjudicator Vince Gui

23 July 2024

4 October 2024

IP Adjudicator Vince Gui:

Introduction





1 Monsters have long been a powerful symbol in popular culture. Their versatility allows them to feature in diverse caricatures. *Godzilla*, for instance, symbolises a fearsome monster with destructive prowess. On the other end of the spectrum lies friendly and adorable monsters in the likes of *Sesame Street* and *Pokémon*.

2 The present dispute is a battle between two monsters — in the form of trade marks. The applicant seeks to register trade marks comprising the word “Monster”. The applications for registration are opposed by another company who had previously registered trade marks comprising the same word “Monster”.

Background facts

3 Artisan Boulangerie Compagnie Pte Ltd (“the Applicant”) applied to

register the following trade marks:¹

Trade Mark No.	Mark (series of 2)
40202107523R	 
40202107524Q	 

I will refer to them collectively as the “GMS Marks”.

4 The GMS Marks were applied for in Class 43 comprising:

Restaurant services; Providing food and drink; Catering services; Take away food services; Restaurant reservation services; Cafe services; Bistro services; Providing food and drink in bistros; arranging for the provision of food; provision of information relating to the preparation of food and drink; Take-away restaurant services; Catering services for company cafeterias; Takeaway food and drink services; Take-away food and drink services; Bakery services; Catering of food and drink; Restaurants; Take-out restaurant services; Catering of food and drinks; Consultancy services relating to food; Self-service restaurants; Self-service restaurant services; Salad bars; Salad bars [restaurant services]; Snack-bar services.

¹ Applicant’s Statutory Declaration, para 11.

5 Monster Energy Company (“the Opponent”) specialises in producing energy drinks under the marks “Monster” and “Monster Energy”, and opposed the registration of the GMS Marks under section 8(2)(b) of the Trade Marks Act 1998 (“the Act”).²

The Opponent’s basis for opposition

6 The Opponent relies on the following registered marks (and the specifications stated) to oppose the applications:³

Filing Date	Mark / Status / Class
27/03/2006	<p style="text-align: center;">MONSTER</p> <p style="text-align: center;"><u>Registered</u> T0605639H</p> <p><u>Class 32</u> Beverages; fruit juices [beverages]; aerated fruit juices; soda water; vitamin enriched non-alcoholic beverages [vitamins not predominating]; isotonic beverages and drinks; energy drinks.</p>
31/08/2011	<p style="text-align: center;">MONSTER</p> <p style="text-align: center;"><u>Registered</u> T1111969F</p> <p><u>Class 5</u> Nutritional supplements in liquid form in Class 5.</p> <p><u>Class 32</u> Non-alcoholic beverages in Class 32.</p>

² Opponent’s Statutory Declaration, para 4.

³ Opponent’s written submissions (“OWS”), para 10.

13/08/2019	<p style="text-align: center;">JAVA MONSTER</p> <p style="text-align: center;"><u>Registered</u> 40201917525R</p> <p><u>Class 30</u> Coffee, tea, cocoa and artificial coffee; coffee-based beverages; tea-based beverages; chocolate-based beverages; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.</p> <p><u>Class 32</u> Non-alcoholic beverages, including carbonated drinks and energy drinks; syrups, concentrates, powders and preparations for making beverages, including carbonated drinks and energy drinks; beer.</p>
18/09/2020	<p style="text-align: center;">JUICE MONSTER</p> <p style="text-align: center;"><u>Registered</u> 40202019576T</p> <p><u>Class 32</u> Non-alcoholic beverages, including carbonated drinks and energy drinks; syrups, concentrates, powders and preparations for making beverages, including carbonated drinks and energy drinks; non-alcoholic beer.</p>
18/09/2020	<p style="text-align: center;">JUCED MONSTER</p> <p style="text-align: center;"><u>Registered</u> 40202019576T</p> <p><u>Class 32</u> Non-alcoholic beverages, including carbonated drinks and energy drinks; syrups, concentrates, powders and preparations for making beverages, including carbonated drinks and energy drinks; non-alcoholic beer.</p>

22/01/2015	<p style="text-align: center;">MONSTER ENERGY</p> <p style="text-align: center;"><u>Registered</u> 40201401724W</p> <p><u>Class 35</u> 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 of food and beverage via a distributor; retail and wholesale services featuring foods and beverages; online retail store services in the field of beverages, clothing, headwear, calendars, posters, stickers, promotional items.</p> <p><u>Class 41</u> 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 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.</p>
07/09/2016	<p style="text-align: center;">MONSTER ENERGY</p> <p style="text-align: center;"><u>Registered</u> 40201614650U</p> <p><u>Class 32</u> Non-alcoholic beverages; beer.</p>

I will refer to these marks collectively as the “Monster Energy Marks”.

7 I pause to emphasise that the Monster Energy Marks are *plain word* marks. The Opponent did not seek to rely on other stylised marks which it has also registered in Singapore for the purposes of this opposition.

8 The Opponent submits that the GMS Marks are visually, aurally and conceptually similar to the Monster Energy Marks.

(a) In terms of visual similarity:⁴

(i) The textual component of the GMS Marks dominates the visual impression conveyed by them. The device component is likely to be perceived as a decorative element. Further, the device component is unlikely to stand out for online purchases.

(ii) The textual component is merely descriptive of the services designated by the said mark. The word “green” refers to the colour of vegetables served. The word “salads” is descriptive of the food services designated by the said mark. It is the word “Monster” that would stand out in the imperfect recollection of the consumer.

(b) In terms of aural similarity, the word “Monster” is the dominant component across all the marks.⁵

(c) There is also some conceptual similarity between the marks.⁶

⁴ OWS, para 15-33.

⁵ OWS, para 34-37.

⁶ OWS, para 38-43.

9 The Opponent further submits that the services designated by the GMS Marks are highly similar to the goods and services designated by the Monster Energy Marks. It is common for restaurants and salad bars to sell non-alcoholic beverages. The Opponent has also opened a restaurant at its headquarters in California.⁷

10 Finally, the Opponent submits that the relevant public would not exercise great attention in purchasing food and beverages and may not be as cognisant of the differences in the marks. It took issue with the Applicant marketing only the textual component on web and mobile applications.⁸

The Applicant's submissions

11 The Applicant submits that the GMS Marks are different from the Monster Energy Marks.

(a) The dominant idea behind the GMS Marks is that of healthy and large salads which is conveyed in a fun and friendly manner. In contrast, the Monster Energy Marks give the idea of there being a large or monstrous amount of energy.⁹

(b) In terms of visual similarity, the device component captures the initial focus of the consumer and is most likely to leave a lasting impression. It is a unique caricature that an average consumer would not ordinarily encounter. The textual component is not the dominant component.¹⁰

⁷ OWS, para 45-58.

⁸ OWS, para 59-72.

⁹ Applicant's written submissions ("AWS"), para 18-36.

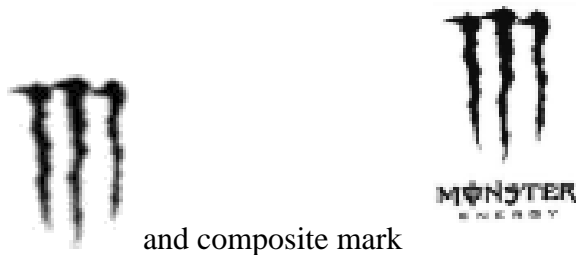
¹⁰ AWS, para 37-58.

(c) In terms of aural similarity, the word “Monster” only makes up two syllabus out of the five syllabus in the GMS Marks. The aural positioning of the word “Monster” is different to each of the Monster Energy Marks. The competing marks are therefore aurally dissimilar.¹¹

12 The Applicant submits the goods and services are more dissimilar than similar. The GMS Marks cater to health-conscious consumers which are different from the users of the beverages catered to by the Monster Energy Marks. The Applicant’s services are exclusively available through delivery. In contrast, the Opponent relies primarily on third-party distribution and retail locations such as supermarkets.¹²

13 The Applicant submits that there is no likelihood of confusion.¹³

(a) There is no evidence that the Monster Energy Marks were widely used and advertised but rather the Opponent’s claw device mark



(b) The Applicant’s marketing efforts have all been directed at salads and fresh food offerings, making it virtually impossible that an average consumer would confuse the Applicant’s use of the word “Monster” with the Monster Energy Marks.

¹¹ AWS, para 59-65.

¹² AWS, para 66-119.

¹³ AWS, para 120-142.

(c) The Applicant’s salads cater to health-focused lifestyles, contrasted with the Opponent’s energy drinks which are used for quick energy boosts.

(d) The Applicant’s salads have a higher price point compared to the Opponent’s energy drinks. The widespread availability of the Opponent’s energy drinks would lead to more impulsive buying decisions.

The law under section 8(2)(b)

14 Section 8(2)(b) of the Act reads:

(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.

15 The law governing this provision is well-settled. Courts give effect to the provision by applying a step-by-step approach under which the three requirements of (a) similarity of marks; (b) similarity (or identity) of goods or services; and (c) likelihood of confusion arising from the two similarities, are to be assessed systematically. The first two elements are assessed individually. The final element is assessed in the round (*Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”) (at [15])).

Similarity of marks

16 The assessment at this stage is whether the marks are similar rather than dissimilar. The well-established criteria of visual, aural and conceptual similarities are signposts towards that assessment.

17 The viewpoint is that of an average consumer who would exercise some care but not an unthinking person in a hurry. It is further assumed that the average consumer has imperfect recollection. The contesting marks are not to be compared side by side but rather the assessment is on the “general impression” left by the essential or dominant features of the marks on the average consumer (*Staywell* at [17] – [18]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40]). The assessment of marks similarity is done mark-for-mark without consideration of any external matter (*Staywell* at [20]).

Visual similarity

18 In cases where there is a common denominator, it is important to look at the differences between the contesting marks to decide whether the challenged mark is able to distinguish itself sufficiently and substantially (*Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) at [32]).

19 This would typically entail analysing the physical attributes of the marks such as (a) their length; (b) their structure; and (c) whether they use the same letters (*Monster Energy Company v Glamco Co., Ltd.* [2021] 3 SLR 319 (“*Glamco*”) at [53]).

20 The Court also looks at the overall impression created by the marks, bearing in mind their distinctive and dominant components. Composite marks can feature one or more dominant components, namely, the textual and/or device component(s) (*Hai Tong* at [62]).


21 The Opponent contends that the contesting marks share a prominent common denominator which is the word “Monster”. It submits that the textual component dominates the visual impression conveyed by the GMS Marks because the square device is merely decorative and the words “green” and “salad” are merely descriptive of the services designated.

22 But the fact that the contesting marks share one or more common words is not necessarily conclusive. In determining distinctiveness, the assessment focuses on the “mark as a whole” (*Glamco* at [54], citing *McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [28]).

23 In my view, the focus of the average consumer would likely be on the square device *and* the textual component “Green Monster Salads” as a whole. The square device invokes the concept of a green coloured monster. The monster is a unique caricature that consumers would rarely come across. I say so because of its unique characteristics. It has only one eye and a wide mouth with rounded teeth. Its features are all encapsulated within a square frame with rounded corners. The rounded teeth and the apparent absence of sharp limbs suggest that this monster intends to pose no harm. It seeks to portray an adorable appearance. Indeed, the Opponent adduced no evidence to show that the square device is commonplace or unoriginal. Considered as a whole, consumers would likely regard the square device as a mascot of the “Green Monster” featured in the GMS Marks, serving as a badge of origin of the Applicant’s services. Viewed in this light, the word “Salads” is the descriptive element of the textual

component; the phrase “Green Monster” refers to the mascot rather than the services designated by the GMS Marks.

24 The Opponent further submits that the textual component constitutes a significant portion of the GMS Marks. While that may be true, the device component is not insignificant in size either. Viewed as a whole, I would say that the average consumer is likely to regard both components as equally significant, especially for the coloured variation of the series of GMS Marks that features a larger version of the device component. I say so also because the device component is not merely decorative but is a unique caricature of a monster which can serve as a badge of origin (*Hai Tong*). I should also add that the device component is unique not just in its depiction of a monster but also its adaptability in potentially representing a food delivery box containing salad. Its artistic design invites consumers to pause and contemplate the various concepts that could underpin the design.


25 The Opponent cited the case of *Caesarstone* which found that the differences between the contesting marks, namely, (a) the device and (b) the word “stone” did not serve to distinguish the  mark sufficiently and substantially from the ‘*CÆSAR*’ mark. The Court found that the overall impression conveyed by both marks was dominated by the word “Caesar” (at [43]). I am of the view that *Caesarstone* is distinguishable.

(a) While the device component was small, that was not the only reason why it was regarded as insignificant. The Court went on to explain that the device did not evoke any particular concept for the average consumer (at [38]). Its uncomplicated nature was more likely to be perceived as a decorative element rather than as an element indicating commercial origin. In the present case, I am of the view that the square

device is more likely to serve as a badge of origin rather than a mere decorative element for the reasons stated above.

(b) Further, in the case of *Caesarstone* the word “stone” in the textual component was merely descriptive of the goods in Class 19 which meant that the public will generally not consider it as forming the distinctive and dominant element of the mark (*Caesarstone* at [41] – [43]). In the present case, I found that the word “Salads” is descriptive of the services designated by the GMS Marks. But the words “Green Monster” likely refer to the mascot depicted in the device component instead. The phrase “Green Monster” is quite different from the word “Monster” used in the Monster Energy Marks.

26 The present case is more analogous to the case of *Monster Energy Company vs Chun-Hua Lo* [2017] SGIPOS 17 (“*Chun-Hua Lo*”) where it was

found that the mark  was visually dissimilar to the word mark “Monster”. The Principal Assistant Registrar reasoned that the cube-man device was a depiction of a fictional character and was likely to be perceived as a mascot when viewed together with the textual component (at [82] – [86]).

27 A parallel can also be drawn with *Glamco*. In *Glamco*, the Court found that mark “Sweet Monster” was visually dissimilar from various marks featuring the word “Monster”. The Court reasoned that the word “Sweet” sufficiently and substantially distinguishes the “Sweet Monster” mark visually for the following reasons:

(a) The words “Sweet” and “Monster” were equally prominent and hence there was no dominant element *per se*. Both words appear in the

same font without stylisation. Both words were of fairly similar length in terms of the number of letters. Consumers would likely view the mark as a whole rather than focus on one part of it (at [58]).

(b) The differentiating word “Sweet” appeared before the common element “Monster”. The average consumer would read the mark from left to right. This distinguished the case from *Caesarstone* where the consumer would have his or her attention focused on the “Caesar” component of the mark first (at [59(a)]).

(c) The “Sweet Monster” mark appeared in two separate and distinct words as opposed to *Caesarstone* where the contesting marks comprised only one word each (at [59(b)]).

28 The analysis in *Glamco* is applicable to the present case in several respects.

(a) The differentiating word “Green” appears in front of the common element “Monster” in the GMS Marks.

(b) The words “Green Monster” appear in the same font without stylisation.

(c) The words “Green Monster” are also of fairly similar length, comprising five and seven letters respectively which was the case in *Glamco* as well.

29 As such, I do not think the word “Monster” in the textual component would be perceived as the dominant element.

30 In my view, the average consumer would likely view the textual component and the device component as a whole rather than focus on the word “Monster” only. The device component and the word “Green” sufficiently and substantially distinguish the GMS Marks from the Monster Energy Marks visually.

31 For these reasons, I am of the view that the contesting marks are more visually dissimilar than similar.

Conceptual similarity

32 The Opponent submits that the Monster Energy Marks and the GMS Marks convey the “same dominant concept of a monster”.¹⁴

33 Monsters manifest in all shapes and forms. In my view, the Opponent is wrong to conflate them as being one and the same.

34 The device component of the GMS Marks depicts an adorable or harmless type of monster character for the reasons mentioned above. This stands in stark contrast from the traditional definition of a monster, which is “a large, ugly, and frightening imaginary creature” (Oxford English Dictionary).

35 Further, consumers are also likely to interpret the words “Green Monster” in the textual component as a reference to a green-coloured monster. This is conceptually distinct from the Monster Energy Marks which make no reference as to the colour in which its “Monster” might feature.

¹⁴ OWS, para 43.

36 The present case is similar to *Glamco* where the Court held that the marks “Sweet Monster” and “Monster” are conceptually dissimilar for these reasons:

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.

37 The GMS Marks are also conceptually different from the idea behind the “Monster Energy” mark. In this regard, the phrase “Monster Energy” has been described to convey the idea of:

(a) there being a large or monstrous amount of energy (*Monster Energy Company v YG Entertainment Inc* [2023] SGIPOS 14 (“*YG Entertainment*”) at [28]); and

(b) giving a great level of energy and strength much like a large and ferocious monster upon consuming the Opponent’s beverages (*Glamco* at [49]).

38 Quite apart from monsters, some consumers may also interpret the device to depict a large salad packed in a food delivery box.

39 I would also add that the “Juice Monster” and “Juiced Monster” marks allude to beverages which is conceptually distinct from “salads” referred to in the GMS Marks that are typically retailed in solid food form.

40 As for the “Java Monster” mark, the Applicant submits that the word “Java” means coffee, which is also conceptually different from “salads”. The Opponent did not advance a different concept underpinning this mark.

41 I therefore disagree with the Opponent’s submissions that the Monster Energy Marks are conceptually similar to the GMS Marks.

Aural similarity

42 There are two possible approaches in comparing aural similarity. The first is to compare the dominant element. The second is to assess whether the competing marks have more syllables in common than not (*Staywell* at [31] – [32]).

43 I adopt the second approach given my finding that there is no dominant element in the textual component of the GMS Marks. In adopting this approach, I also consider that the Monster Energy Marks, unlike the case of *Staywell*, do not have a high level of technical distinctiveness (*Staywell* at [31]).

44 The common denominator across all the Monster Energy Marks is the word “monster”. As the Court in *Glamco* explained, the word “monster” has a laudatory meaning in relation to the Opponent’s goods, *i.e.*, energy drinks and caffeinated beverages. It suggests that upon consuming these beverages the consumer would gain massive energy much like a large and ferocious monster (at [49]). Indeed, the Opponent does not contend in the present case that the Monster Energy Marks are highly distinctive.

45 The same approach was adopted in:

(a) *Glamco* where it was found that the application mark in question, “Sweet Monster” did not have a dominant component (at [61]).

(b) *YG Entertainment* where it was found that the marks “Babymonster(s)” and “Monster Energy” had no dominant component. The IP Adjudicator went on to find that they were aurally dissimilar because (a) they contain different numbers of syllables; (b) the identical syllables were positioned differently; and (c) the other syllables were completely different.

(c) *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12 (“*Mixi*”) where it was found that the marks “Monster Strike” and “Monster Energy” were aurally different because out of the eight syllables across the competing marks only four were common (at [55] – [61]).

46 In the present case, I am of the view that the contesting marks are more aurally dissimilar than similar for the following reasons:

- (a) The GMS Marks contain five syllables compared to:
 - (i) two syllables in the “Monster” mark;
 - (ii) three syllables in the “Juice Monster” and “Juiced Monster” marks;
 - (iii) four syllables in the “Java Monster” mark; and
 - (iv) five syllables in the “Monster Energy” mark.
- (b) The identical syllables “Monster” are positioned differently. “Monster” appears in the middle of the GMS Marks whereas it appears at the start or end of the Monster Energy Marks.

(c) The identical syllables comprise only two out of the five syllables in the GMS Marks. The other syllables are completely different.

Conclusion on mark similarity

47 For the above reasons, I am of the view that the contesting marks are visually, conceptually and aurally more dissimilar than similar.

48 The opposition fails since the first stage of the step-by-step approach is not satisfied. But for completeness, I will briefly express some views on the remaining two stages of the assessment.

Similarity of goods and services

The law

49 In assessing similarity, a comparison is made between the goods and services under the Nice Classification (*Staywell* at [40] – [43]).

50 It is undisputed that the goods and services for which the competing marks are designated fall within different class numbers under the Nice Classification:

- (a) The GMS Marks are to be registered in Class 43.
- (b) The Monster Energy Marks were registered in Classes 5, 30, 32, 35 and 41.

51 The Opponent submits that while goods and services may be separately classified under the Nice Classification system, this does not preclude them

from being regarded as similar to each other, citing Tan Tee Jim SC, *Law of Trade Marks in Singapore* (4th Edition, Sweet & Maxwell Singapore) at [8.104]:

Finally, it is worth mentioning that the language of s 8(2) of the Trade Marks Act is wide enough to allow for goods to be compared with services to determine whether they are similar to each other. The early case *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 is again instructive in this regard. There, Jacob J opined that the equivalent provision in the UK 1994 Act provides protection not only for the actual goods and services but also “for a penumbra” and added that:

“I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance).”

52 The learned author went on to say to that goods and services are similar if they are “complementary”, in the sense that one is indispensable or important for the use of the other in such a way that consumers would think that the same undertaking is responsible for manufacturing the goods or providing the services (at [8.105]).

53 In *Chun-Hua Lo*, the Principal Assistant Registrar found some similarity between the selected goods in Class 32 and selected services in Class 43, specifically (at [123]):

- (a) Class 32: “beverages; fruit juices [beverages]; aerated fruit juices; soda water”; and
- (b) Class 43: “bar services; cafes; cafeterias; restaurants; self-service restaurants; snack bars”.

54 In determining similarity of goods or services, the following considerations are relevant (*Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [49]):

- (a) its respective uses;
- (b) its respective users;
- (c) its physical nature;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) whether they are respectively found or likely to be found in the same shelves in supermarkets; and
- (f) the extent to which the respective goods or services are competitive.

Application of the law

55 Applying the law to the present facts:

- (a) *Uses*: There is some overlap between the goods called “beverages” in Classes 30 and 32 and the services relating to “drink(s)” in Class 43. They potentially achieve the same purpose of hydrating the consumer; supplying the body with nutrients; and/or catering to the consumer’s cravings. The same logic applies to:
 - (i) “coffee”, “tea”, “coffee-based beverages”, and “tea-based beverages” in Class 30; and
 - (ii) “carbonated drinks and energy drinks”, “soda water”, “fruit juices”, “non-alcoholic beer” and “beer” in Class 32.

(b) *Users:* The consumers looking to purchase beverages and drinks in Classes 30 and 32 could similarly seek to purchase and/or be served drinks in Class 43.

(c) *Physical nature:* These goods to be purchased and services to be provided are usually in liquid form.

(d) *Trade channels:* While beverages and drinks are commonly retailed in supermarkets, they can also be purchased from “restaurants” in Class 43. There is therefore a potential overlap in the trade channels.

(e) *Shelving:* The beverages and drinks can appear on the same shelf in a restaurant, especially on takeout or self-service shelves.

(f) *Substitutability:* The beverages and drinks can potentially substitute each other.

56 For these reasons, there is similarity in the Opponent’s claimed goods and the Applicant’s claimed services as set out in the following:

(a) Classes 30 and 32: “beverages”, “coffee”, “tea”, “coffee-based beverages”, “tea-based beverages”, “carbonated drinks and energy drinks”, “soda water”, “fruit juices”, “non-alcoholic beer” and “beer”; and

(b) Class 43: Services relating to “drink(s)” and “restaurant services”.

Likelihood of confusion

57 The test to be applied is whether a substantial portion of the relevant public would be confused (*Sarika* at [57]). Confusion may arise in at least two ways (*Hai Tong* at [74]):

- (a) The first is mistaking one mark for another.
- (b) The second is mistaking the goods bearing the later mark to originate from the same source as the earlier registered mark.

58 The Court takes a holistic view of all the circumstances including “extraneous factors” to determine whether a likelihood of confusion can be said to exist (*Sarika* at [62]).

59 The permissible factors to be considered include (*Staywell* at [96] and *Caesarstone* at [56]):

- (a) the degree of similarity between the contesting marks and its effect on consumer perception; and
- (b) the degree of similarity between the goods and its effect on consumer perception.

60 I am of the view that there is a low likelihood of confusion in the present case:

- (a) The degree of similarity between the Applicant’s and Opponent’s marks is low (and in fact the marks have been found visually, aurally and conceptually dissimilar: see [47] above).

(b) Consumers are unlikely to conflate the GMS Marks with the Monster Energy Marks as they exude vastly different concepts. The former evokes fun and friendliness whereas the latter has an image of being “edgy” and “aggressive” going by the Opponent’s own position.¹⁵

61 As an aside, the Opponent contends that the Applicant has sometimes marketed the textual component of the GMS Mark without the device component.¹⁶ This hardly advances the Opponent’s case as the Applicant is not seeking to register the textual component only; the GMS Marks sought to be registered comprise the device component. The specific marketing choice of the Applicant is also not a permissible extraneous factor under *Staywell* (at [84]). If the Opponent is suggesting that the Applicant’s use of the textual component *simpliciter* infringes upon its Monster Energy Marks, it is open to the Opponent to commence infringement proceedings for determination. It is not necessary for me to comment on the merits of such prospective action.

Conclusion

62 For these reasons, I dismiss the opposition under section 8(2)(b) of the Act. I allow the GMS Marks to proceed to registration.

63 The Applicant is also entitled to costs. Having considered the parties’ submissions and the Fourth Schedule of the Trade Marks Rules, I award costs to the Applicant as follows:

- (a) Party and Party Costs: \$7,393.00
- (b) Disbursements: \$1,339.73

¹⁵ Opponent’s SD, para 36.

¹⁶ OWS, para 65.

The total assessed costs to be paid by the Opponent to the Applicant are \$8,732.73.

64 I record my appreciation for the parties' submissions from which I derived considerable assistance in the preparation of this decision.

Vince Gui
IP Adjudicator

Chan Ju-Lian and Rachelle Chew (Thomson Legal LLP) for the
Applicant;
Brendan Loy and Anan S. Sivananthan (Bird & Bird ATMD LLP)
for the Opponent.
