

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: May 24, 2023

Mailed: September 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Monster Energy Company

v.

Eben McGarr

—
Opposition Nos. 91239678 and 91244601
—

Steven J. Nataupsky, Matthew S. Bellinger, Baraa Kahf, Alexander D. Zeng, and Michael R. Garcia of Knobbe Martens Olson & Bear LLP for Monster Energy Company.

Peter C. Beirne of Law Office of Peter C. Beirne for Eben McGarr.

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Before Wolfson, Greenbaum, and Allard,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Eben McGarr (“Applicant”) filed an application to register on the Principal Register the standard character mark MAD MONSTER PARTY (“MONSTER PARTY” disclaimed),¹ and the design mark depicted below (“MONSTER PARTY” disclaimed):

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¹ Application Serial No. 87333442 was filed February 13, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s alleged first use anywhere and first use in commerce of June 1, 2010.



for “Organizing exhibitions for educational and entertainment purposes services, namely, organizing and conducting conventions in the fields of horror and popular culture,” in International Class 41.²

Applicant also filed an application on the Principal Register to register the mark depicted below (“MONSTER” disclaimed):



for “General feature magazine in the field of horror and pop culture,” in International Class 16.³

² Application Serial No. 87333464 was filed on February 13, 2017, supported by the same allegations of use. The mark is described as follows: “The mark consists of the wording ‘Mad Monster Party’ outlined to appear as liquid dripping from the words ‘Mad Monster’ and where the ‘O’ in ‘Monster’ is the head of a monster, the wording ‘Party’ is in a different font and to the right of the word ‘Party’ is a martini glass.” Color is not claimed as a feature of the mark.

³ Application Serial No. 87328584, filed February 8, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging dates of first use of March 1, 2010 and first use in commerce of April 8, 2011. The mark is described as follows: “The mark consists of the wording ‘Mad Monster’ with the ‘O’ in ‘Monster’ being a monster head and the letters outlined with dripping liquid.” Color is not claimed as a feature of the mark.

Monster Energy Company (Opposer) filed notices of opposition against the registration of Applicant's marks. 1 TTABVUE.⁴ The notices plead 12 registered marks encompassing or including the terms MONSTER ENERGY or MONSTER in connection with energy drinks, supplements, fruit juice and soft drinks; clothing, sports bags and stickers; and the services of promoting sports and music events and competitions for others. Opposer attached status and title copies of the pleaded registrations to its notices of opposition.

As grounds for opposition, Opposer claims its marks are famous and have been used and promoted as a family of marks for the registered goods, related promotional items, and in association with "sponsoring musicians, bands, athletes, and various live events such as concerts, music festivals, sporting events, and auto exhibitions." 1 TTABVUE 11. Opposer further claims that Applicant's marks so resemble Opposer's marks as to be likely, when used on or in connection with Applicant's services, to cause confusion, or to cause mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). 1 TTABVUE 19.

Applicant's answers to the notices of opposition generally deny the salient allegations. 4 TTABVUE. Each party filed a trial brief and Opposer filed a reply brief.⁵ For the reasons discussed below, we dismiss the oppositions.

⁴ Citations to TTABVUE are to the Board's public online database that contains the file of the appeal in Opp. No. 91239678, the parent case, available at www.uspto.gov. The first number represents the docket number and any second number represents the page in the TTABVUE electronic proceeding file.

⁵ Opposer's brief is at 72 TTABVUE (confidential version at 73 TTABVUE) and its reply brief is at 76 TTABVUE. Applicant's brief is at 75 TTABVUE (confidential version at 74 TTABVUE).

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved applications. In addition, the parties introduced the following evidence.

A. Opposer's Evidence

1. Pleaded registrations

Opposer properly made of record copies of its 12 pleaded registrations by submitting with its notices of opposition printouts of the registrations from the USPTO's Trademark Electronic Search System (TESS). Those registrations are identified below by registration number, year of issue, mark (in standard characters except in three instances as noted), and abbreviated descriptions of their respective goods or services:

- Reg. No. 4721433 (2015) for the mark MONSTER ENERGY for promotional services “in the sports, motorsports, electronic sports, and music industries”; “promoting sports and music events and competitions for others”;⁶
- Reg. No. 3044315 (2006) for the mark MONSTER ENERGY for nutritional supplements;
- Reg. No. 4036680 (2011) for the mark MONSTER ENERGY for nutritional supplements;
- Reg. No. 4036681 (2011) for the mark MONSTER ENERGY for energy drinks;
- Reg. No. 3057061 (2006) for the mark MONSTER ENERGY for fruit juice drinks; carbonated drinks;


⁶ On June 9, 2023, Opposer filed a request for express abandonment of the Section 15 affidavit portion of the declaration it filed under Trademark Act Sections 8 and 15, 15 U.S.C. §§ 1058 & 1065, for Reg. No. 4721433, which Opposer had filed on April 22, 2020. The Director granted the petition on August 24, 2023.

- Reg. No. 3959457 (2011) for the mark JAVA MONSTER for beverages;
- Reg. No. 3044314 (2006) for the mark M MONSTER ENERGY for nutritional supplements;
- Reg. No. 3852118 (2010) for the mark LO-CARB MONSTER ENERGY for nutritional supplements; energy drinks;
- Reg. No. 3134842 (2006) for the mark M MONSTER ENERGY for energy drinks;




- Reg. No. 3908601 (2011) for the mark  for clothing;⁷



- Reg. No. 3923683 (2011) for the mark  for sport bags, backpacks; and




- Reg. No. 3908600 (2011) for the mark  for stickers, decals.

2. Notices of Reliance

- a. First Notice of Reliance on Applicant's responses to Opposer's discovery requests (interrogatories, request for production of documents, and requests for admissions) and copies of Opposer's 10-K reports filed with the Security and Exchange Commission from 2002-2020. 34-41 TTABVUE, Exhibits 1-47.
- b. Second Notice of Reliance on copies of generally available printed publications. 42-3 TTABVUE, Exhibits 48-64.
- c. Third Notice of Reliance on printouts from Opposer's and third-parties' Internet websites; posts on Opposer's

⁷ This mark is sometimes hereinafter referred to as the MONSTER ENERGY and claw design mark.

Facebook, Instagram, YouTube, and Twitter pages; a post from a third-party Facebook page; and copies of Opposer's California trademark registration for the mark MONSTER⁸ and its federal registration for the unpleaded mark ⁹ 44-5 TTABVUE, Exhibits 65-99.


d. Fourth Notice of Reliance on excerpts from the May 25, 2021 discovery deposition of Eben McGarr under Fed. R. Civ. Pro. 30(b)(6) and selected exhibits. 46 TTABVUE, Exhibits 100-112.

e. Rebuttal Notice of Reliance on Exhibits 113-16 from the cross-examination deposition of Eben McGarr. 63 TTABVUE, confidential Exhibit 114 at 64 TTABVUE.

3. Testimony

a. Declaration of Opposer's Chairman and Co-Chief Executive Officer Rodney Sacks. 47-50 TTABVUE (public version); 51-53 (confidential version), Exhibits 1-59.¹⁰

⁸ Calif. Reg. No. 108124, issued April 24, 2002 for "Fruit Juice drinks, soft drinks, carbonated soft drinks and soft drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, aerated water, soda water and seltzer water." By its terms, the registration expired on April 24, 2012. 45 TTABVUE 15. There is no evidence in the record that it was renewed.

⁹ This opposition was filed in 2018. Opposer's application for  for "non-alcoholic beverages, namely, soft drinks, energy drinks, sports drinks, and fruit juice drinks," was filed December 13, 2017, but was not mentioned in the notice of opposition. However, "MONSTERTM" was listed as a common law mark in paragraph 2, 1 TTABVUE 10, and Reg. No. 6451182 issued from the application on August 17, 2021, prior to the opening of trial. It has thus been considered as part of the record. *Cf. Nkanginieme v. Appleton*, 2023 USPQ2d 277, at *4-8 (TTAB 2023) (if plaintiff's pleaded application matures into a registration before trial opens and defendant does not counterclaim to cancel it, plaintiff may rely on that registration). The description of the mark reads: "The mark consists of the stylized term 'MONSTER' with a slash mark through the letter 'O'." Color is not claimed as a feature of the mark.


¹⁰ Many of the exhibits in the Notices of Reliance submitted by Opposer are duplicates. Applicant also submitted a duplicate version of McGarr's confidential testimony declaration. 67 TTABVUE. The parties are admonished that submitting duplicate copies of trial evidence is extremely wasteful of the Board's limited resources as well as indicative of sloppy practice. Every page filed with the Board carries a unique TTABVUE docket entry and page number that facilitates the handling of evidence and should be used to refer back to earlier-filed material. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 801.01 (2023); *see also Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014)

b. Rebuttal Declaration of Rodney Sacks. 65 TTABVUE (public version), 66 TTABVUE (confidential version), Exhibits 60-1 (confidential Exhibit 60 at 66 TTABVUE).

c. Cross-examination testimony of Eben McGarr taken June 6, 2022. 70 TTABVUE, Exhibits 1-15, confidential version of certain exhibits at 71 TTABVUE.

Copies of registration certificates for the unpleaded marks MONSTER ASSAULT



for beverages (Reg. No. 6734053);  for sports helmets (Reg. No. 3914828);



for wristbands and bracelets (Reg. No. 4332062); and



for

lanyards (Reg. No. 4660598) were included with Opposer's first notice of reliance. 34 TTABVUE 94-113. Although we accept the record copies of the certificates of registration for these additional marks for whatever probative value they may have under the *DuPont* factors, we do not accord them any weight in establishing priority or entitlement on behalf of Opposer. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *1 n.5 (TTAB 2019) (unpleaded registration may be considered like third-party registrations).

Opposer also improperly claims to have included in the record copies of the "corresponding file histories" for both its pleaded and unpleaded registrations. 73

(Board primarily uses TTABVUE in reviewing evidence, thus citations to material or testimony in the record that has not been designated confidential should include the TTABVUE docket entry and page number). Further, the parties have failed to use the Board's designated system of citation in their briefs, which also obstructs the Board's attempt to locate relevant evidence. The Board urges the parties to refer to TTABVUE in citing the evidentiary record in all future cases, failing which the Board may refuse to consider the submission or require the offending party to refile it to correctly cite to TTABVUE.

TTABVUE 11. There are no file histories in the record for any of Opposer's marks. Opposer is directed to review TBMP § 704.03(b)(1)(A), which explains how a plaintiff may make the file history of a pleaded registration of record. Opposer is cautioned against overstating the record on appeal in any future proceedings it may file before the Board.


B. Applicant's Evidence

1. Notices of Reliance

a. First Notice of Reliance on excerpts from the May 14, 2021 discovery deposition of Rodney Sacks and selected exhibits. 54 TTABVUE, Exhibits 113-120.

b. Second Notice of Reliance on additional excerpts from the May 25, 2021 discovery deposition of Eben McGarr and selected exhibits. 56 TTABVUE, Exhibits 121-125.

c. Third Notice of Reliance on

- printouts from the TSDR database of Applicant's prior registrations:
 - Reg. No. 4049254 for the mark MAD MONSTER for "General feature magazine in the field of horror," issued April 10, 2011 ("MONSTER" disclaimed);
 - Reg. No. 5572940 for the mark  for "Radio broadcasting," issued October 2, 2018 ("RADIO" disclaimed);
- printouts from the USPTO's Trademark Electronic Search System (TESS) database of a list of third-party marks including "monster"; and

- printed publications in general circulation purporting to show Applicant's use of his marks. 55 TTABVUE, Exhibits 126-135.¹¹

2. Testimony

- a. Declaration of Eben McGarr. 68 TTABVUE (public version), 53 TTABVUE (confidential version), Exhibits A-T.

II. Entitlement to a Statutory Cause of Action

In every inter partes case, the plaintiff must establish its statutory entitlement to bring an opposition or cancellation proceeding. To establish entitlement to a statutory cause of action, a plaintiff must demonstrate both: (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at 7-8.

Opposer has properly made its pleaded registrations of record by submitting a "current copy of information from the electronic database records of the Office showing the current status and title of [each] registration." Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122 (d)(1). The pleaded registrations establish Opposer's direct commercial interest and real interest in the proceeding and its reasonable


¹¹ Opposer filed a motion to strike Applicant's Exhibit 131, which is a 2-page printout from TESS listing the "first 50 of the 1751 Live trademarks using the word "Monster" in their Mark." 61 TTABVUE. The motion was granted as conceded by Board order dated August 3, 2022. 62 TTABVUE. We have not considered the listing.

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belief in likely damage, thereby establishing its entitlement to oppose registration of Applicant's marks. *See Herbko Int'l v. Kappa Books*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) ("In most settings, a direct commercial interest satisfies the 'real interest' test."); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations "suffice to establish ... direct commercial interest"; a belief in likely damage can be shown by establishing a direct commercial interest); *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *11 (TTAB 2023) (valid and subsisting pleaded registrations made of record establish entitlement to oppose).

III. Likelihood of Confusion

A. Priority

Because Opposer's pleaded registrations are of record and Applicant has not brought a counterclaim against any of them, priority is not at issue with respect to the goods and services identified in the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). We also find priority is not at issue with respect to the  registration (status and title copy submitted under notice of reliance) for its identified goods.

B. Analysis of the *DuPont* Factors

Our determination under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be

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considered, referred to as “*DuPont* factors”). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011) (“Not all of the *DuPont* factors are necessarily ‘relevant or of equal weight in a given case, and any one of the factors may control a particular case.’”); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key factors are the similarities and dissimilarities between the marks and the degree of relatedness between the goods or services as set forth in the application(s) and registrations of record. See *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l*, 64 USPQ2d at 1380; *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Because we consider the likelihood of confusion factors for which there is evidence and argument, *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019), we further consider whether Opposer’s marks comprise a family of marks, the strength of Opposer’s marks, the trade channels and classes of prospective consumers, the alleged sophistication of the consumers, whether there

has been actual confusion given any opportunity for confusion to have arisen, and Applicant's intent in selecting its marks. Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

1. Opposer's Alleged Family of Marks – *DuPont* Factor Nine

We first consider whether Opposer has proven that it owns a family of marks under the ninth *DuPont* factor. This factor considers “[t]he variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark).” *DuPont*, 177 USPQ at 567. Opposer alleges in the notices of opposition that it owns a family of marks containing the term MONSTER, 1 TTABVUE 10, and refers to its alleged family in its brief. “The family of MONSTER Marks share at least the term MONSTER as a common characteristic and the MONSTER Marks appear together at least in the same advertisements and/or at point-of-sale displays (e.g., store displays, refrigerator racks).” Opposer's Brief, 72 TTABVUE 9.

“A family of marks is a group of marks having a common characteristic ... [that] only arises if the purchasing public recognizes that the common characteristic is indicative of a common origin of the goods.” *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001) (quoting *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991)); *see also Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *15 (TTAB 2022) (“Recognition of the family of marks is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the

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family.”); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *7-8 (TTAB 2020).

“Although the USPTO may register several individual marks comprising a family element together with one or more other elements, it does not register ‘families’ of prefixes, suffixes, or other components of a mark.” *New Era Cap*, 2020 USPQ2d 10596, at *6-7. “Thus, an opposer relying on a family of marks is relying on common law rights in the alleged family.” *Id.* at *7. As a well-known trademark law commentator explains:

Whether a family of marks exists is a question of fact based on the family formative’s distinctiveness, and the nature of the use, advertising and promotion in which the alleged family of marks appear. Relevant to this enquiry is the extent to which the proponent of the family has used joint advertising and promotion of the family in a manner designed to create an association of common origin for all marks containing the family formative or “surname.”

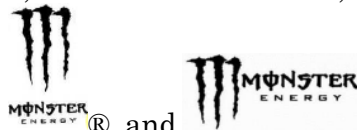
4 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23.61 (5th ed. 2023).



Opposer bears the burden of proving the existence of a family of MONSTER marks. *New Era Cap*, 2020 USPQ2d 10596, at *7; *TPI Holdings Inc. v. Trailertrader.com, LLC*, 126 USPQ2d 1409, 1419 (TTAB 2018). Simply owning multiple registrations or using a number of marks sharing a common element is not enough. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) (“Simply using a series of similar marks does not of itself establish the existence of a family.”) (quoting *J & J Snack Foods*, 18 USPQ2d at 1891); *Truescents LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006) (“Mere ownership

of the various marks, or registrations thereof, does not suffice to establish a family of marks.”). Although Opposer’s Chairman and Co-Chief Executive Officer, Rodney Sacks, declares that Opposer’s federal trademark registrations, along with point-of-sale catalogs, comprise “exemplary exhibits” showing that “many of Monster’s MONSTER-inclusive marks share the similar characteristics and are advertised and sold alongside each other,” 47 TTABVUE 4, as noted, the federal trademark registrations have no probative value by themselves in showing how consumers may perceive Opposer’s marks. *See, e.g., Hester Indus., Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1647 (TTAB 1987) (“[I]t is well settled that the mere ownership of a number of marks sharing a common feature (or even ownership of registrations thereof) is insufficient to establish a claim of ownership of a ‘family’ of marks[.]”).

We turn then to an examination of which marks are used by Opposer, its licensees, and its sponsored teams and athletes. In his declaration, Sacks identified Opposer’s family as including the marks MONSTER, MONSTER ENERGY, JAVA MONSTER, M MONSTER ENERGY, LO-CARB MONSTER ENERGY, and the MONSTER ENERGY and claw design mark. 47 TTABVUE 4.¹² The mark MONSTER, however,




¹² Opposer has been inconsistent in defining its alleged family. *Compare* Opposer’s brief: “Monster’s family of MONSTER-inclusive marks has grown to include many other marks that contain MONSTER, such as MONSTER™, MONSTER®, MONSTER ENERGY®, MONSTER ASSAULT®, JAVA MONSTER®, M MONSTER ENERGY®, LO-CARB





MONSTER ENERGY®, ®, and ® (hereinafter collectively the ‘MONSTER Marks’),” 72 TTABVUE 8, *with* Sacks’s Decl., 47 TTABVUE 4: “[Opposer’s] family of MONSTER-inclusive marks has grown to include, for example, the following: MONSTER™, MONSTER ENERGY®, JAVA MONSTER®, M MONSTER ENERGY®, LO-CARB



is not strictly speaking a member of Opposer’s claimed MONSTER family of marks because it lacks a second term. *See McDonald’s Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1276 (TTAB 2014) (finding the “Mc” mark not part of McDonald’s family of “Mc-formative” marks). The other marks may form a purported family of MONSTER-formative marks; thus we examine below the extent to which the evidence shows they are “displayed together in advertising and promotional materials and on product shelves.” Sacks Decl., 47 TTABVUE 5.

Sacks refers to Opposer’s marks collectively as though they were all used together,




but the evidence shows that only  (the claw design), , and  are used together, with two exceptions.


The first is a series of advertisements for energy drinks from Opposer’s website dated October 2020.¹³ Each ad features a single drink, but includes at the top of the


MONSTER ENERGY®, and  among others (hereinafter collectively, the ‘MONSTER Marks’), and Opposer’s Notice of Opposition, 1 TTABVUE 10: “Opposer’s family of MONSTER Marks includes, but [is] not limited to, the following: MONSTER™, MONSTER ENERGY®, JAVA MONSTER®, M MONSTER ENERGY®, LO CARB MONSTER


ENERGY®, and  (hereinafter collectively, the ‘MONSTER Marks’).”

Further, three marks are discussed in the brief that are unpleaded and not included in the definition of “MONSTER Marks” by either Sacks or in the Notice of Opposition: (1)

, (2) MONSTER ASSAULT, and (3) . As with the mark MONSTER, the  mark is also not considered part of the family. *McDonald’s Corp. v. McSweet*, 112 USPQ2d at 1276.

¹³ The mark  is also displayed on the October 2020 advertisements.

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ad, a banner with logos for several of Opposer's drinks. An example of such an advertisement, for MONSTER ENERGY ZERO ULTRA, is shown below, with a blow-up of the banner reprinted below the ad:



44 TTABVUE 114-15, Exhibit 82. The beverage titles include JUICE MONSTER, MONSTER REHAB and MONSTER MAXX.

The second is a photograph that shows five of these same beverages being sold side-by-side at the NASCAR Cup Series:






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Testimony Declaration of Rodney Sacks

49 TTABVUE 329. This evidence, although sparse, may show the existence of a family of MONSTER-formative marks for beverages, in particular energy drinks.

On collateral goods or with its services, the evidence shows Opposer primarily

uses the marks  MONSTER ENERGY,  and . *See, e.g.,* 44 TTABVUE 14, Exhibit 65, a “printout of the NASCAR Shop webpage,”




Ready to Ship

\$25.59 with code

Regular: \$31.99

Men's Kurt Busch New Era Black
Monster Energy 9FIFTY Snapback
Adjustable Hat

 Most Popular in Kurt Busch



Ready to Ship

\$25.59 with code

Regular: \$31.99

Men's Kyle Busch New Era Black 2019
Monster Energy NASCAR Cup Series
Champion Victory Lane 9FORTY
Adjustable Hat

 Most Popular in Hats

id. at 32, Exhibit 66, a printout of “a post on Opposer’s MUSCLE MONSTER® page,”

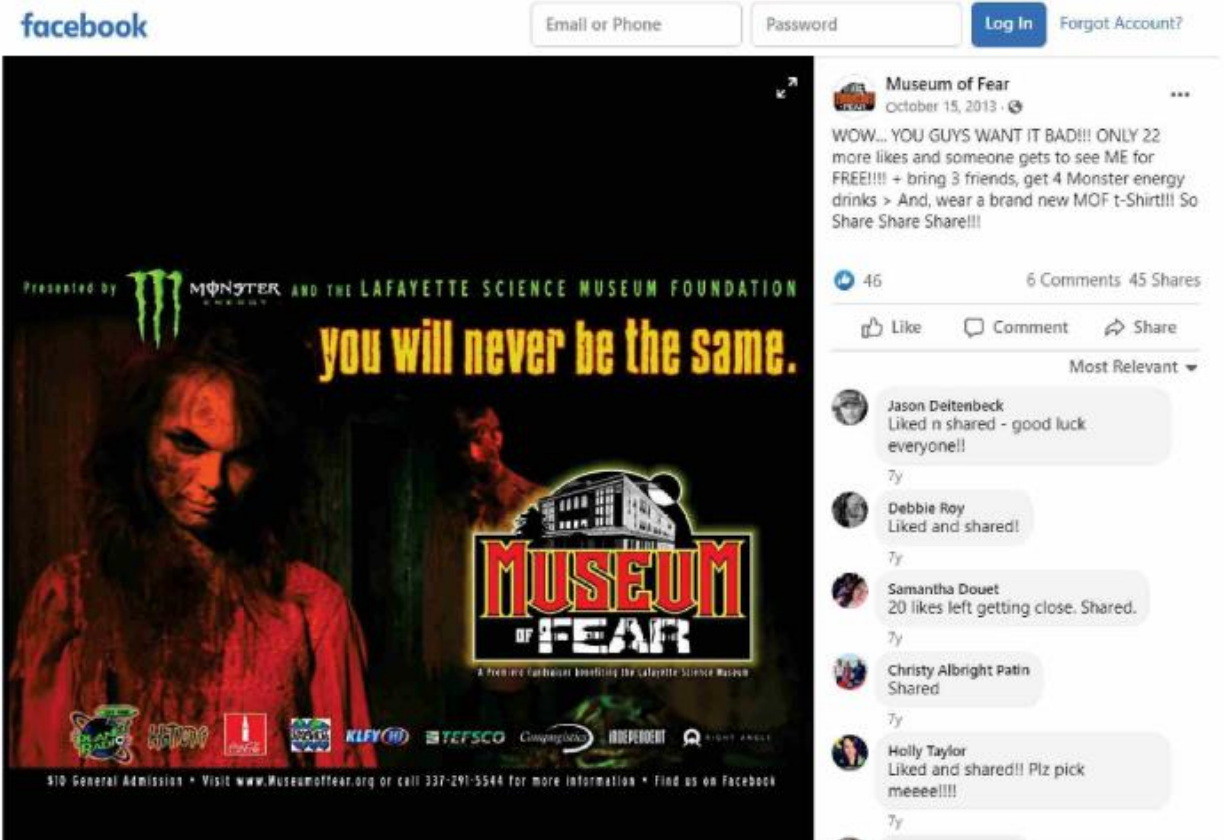


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and 45 TTABVUE 7, Exhibit 95, a “printout of a post on Museum of Fear’s Facebook page.” 44 TTABVUE 8. The Museum of Fear post states, “Presented by



and the Lafayette Science Museum Foundation:”



In association with its collateral goods and services, Opposer’s use of these MONSTER ENERGY-formative marks identifies Opposer as an event sponsor and producer of energy drinks. To the extent the evidence shows a family of marks on collateral goods or with its services, the family “surname” would be MONSTER ENERGY. Because Applicant’s mark could not be considered a member of any MONSTER ENERGY family, the claim fails with respect to goods or services other than beverage goods.

Significantly, Opposer must establish “that prior to the entry into the field of [Applicant’s] mark, the marks containing the claimed ‘family’ feature or at least a substantial number of them, were used and promoted together by [Opposer] in such a manner as to create public recognition coupled with an association of common origin predicated on the ‘family’ feature.” *J & J Snack Foods*, 18 USPQ2d at 1891-92. Assuming arguendo that Opposer’s marks constituted a family for collateral goods or services, and that the family characteristic was MONSTER rather than the more likely MONSTER ENERGY, Opposer has failed to prove that its purported family of marks came into existence prior to Applicant’s first use in March of 2010.¹⁴ *New Era Cap*, 2020 USPQ2d 10596, at *7 (opposer must prove family of marks existed “prior to any date Applicant can rely upon for purposes of priority”); *Hester Indus.*, 2 USPQ2d at 1647 (owner of family of marks must show by competent evidence that “prior to the first use by the alleged interloper,” the use and promotion of the alleged family created “among purchasers an association of common ownership based upon the ‘family’ characteristic.”).

Accordingly, the ninth *DuPont* factor is neutral insofar as Opposer has not shown the existence of a family of marks prior to any date upon which Applicant may rely. In addition to “family” considerations, however, this factor considers the variety of goods on which a mark is used. The evidence proves that Opposer uses and licenses its marks for use on a wide array of collateral goods such as clothing, jewelry, sports

¹⁴ Applicant testified that he first used his mark in March of 2010. 53 TTABVUE 3. A flyer from October 24, 2011 bearing the mark MAD MONSTER PARTY and design was attached to his declaration. *Id.* at 31, Exhibit I.

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bags, and calendars and promotes its goods through the sponsorship of athletes and athletic competitions, 47 TTABVUE 13-20, and through promotional giveaways of beverages during sporting professional events. 47 TTABVUE 24-5. Opposer may also offer restaurant or bar services at sporting events, such as the Summer X-Games in 2015.



49 TTABVUE 314, Exhibit 40.

Based on the evidence, we find the ninth *DuPont* factor favors a finding of likelihood of confusion insofar as it relates to the variety of goods upon which Opposer uses its mark, but not with respect to Opposer's attempt to show the existence of a family of marks. Thus, Opposer must establish the presence of a likelihood of confusion based upon one or more of the separately pleaded marks. *TPI Holdings*, 126 USPQ2d at 1420 (citing *Truescents*, 81 USPQ2d at 1338). Of the marks Opposer asserts, its registration for the mark MONSTER ENERGY, coupled with its

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corresponding identified goods and services, is most likely to support a likelihood of confusion claim.¹⁵ We also consider Reg. No. 6451182 for the mark  for “non-alcoholic beverages, namely, soft drinks, energy drinks, sports drinks, and fruit juice drinks.”

If Opposer prevails on its Section 2(d) claim on these registrations, then consideration of the others would be unnecessary. If Opposer does not, then consideration of the other less relevant registrations would not assist Opposer. Accordingly, we focus on these two registrations. *See, e.g., N. Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015) (citing *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010)).

2. Strength of Opposer’s marks

In determining the strength of a mark, we consider both its conceptual strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength”); *Top Tobacco, L.P. v. North Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength).

¹⁵ Reg. No. 4721433, for the services of “promoting goods and services 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.”

a. Inherent Strength of MONSTER ENERGY and 

To determine the conceptual strength of Opposer’s marks, we evaluate their intrinsic nature, that is, where the marks lie “along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words.” *In re Davia*, 110 USPQ2d 1810, 1814 (TTAB 2014). We may consider dictionary definitions in connection with determining conceptual strength of a mark. *See, e.g., Hancock v. Am. Steel & Wire Co. of N. J.*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) (dictionary definitions considered “to determine the ordinary significance and meanings of words”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1673 (TTAB 2018) (dictionary definition of “smoking hot” considered in relation to cosmetics).

Because the marks are registered on the Principal Register, we presume they are inherently distinctive. Trademark Act Section 7(b), 15 U.S.C. § 1057(b). Moreover, although the term “monster” has several common meanings in English, none of them relate to beverages or the provision of sporting or music events.¹⁶ Conceptually,

Opposer’s MONSTER ENERGY and  marks are strong marks.

¹⁶ The Merriam-Webster online dictionary defines “monster” as something or someone unusually large, strange, or terrifying: “an animal of strange or terrifying shape (a sea monster); one unusually large for its kind ([t]hat truck is a monster); an animal or plant of abnormal form or structure; one who deviates from normal or acceptable behavior or character (an immoral monster); a threatening force; something monstrous; and one that is highly successful ([t]hat movie was a monster at the box office).” At <https://www.merriam-webster.com/dictionary/monster>, accessed August 14, 2023. The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018).

b. Market Strength of MONSTER ENERGY and 


Market, or commercial, strength of a mark is the extent to which the relevant public recognizes a mark as denoting a single source. Market strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co., Inc.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689-90 (Fed. Cir. 2018); *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength even in absence of market share statistics where other indicia point to strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.”). In tandem, if there is evidence in the record, we consider whether the mark has commercial weakness in the marketplace. *DuPont*, 177 USPQ at 567.¹⁷ A mark’s renown “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings*,

¹⁷ We have been presented with no such evidence in this case.

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LLC, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (internal quotations omitted).

Although Opposer first used its mark in 2002, long use is not determinative of market strength absent other indicia of commercial awareness. *See, e.g., GJ & AM*, 2021 USPQ2d 617, at *41-42 (TTAB 2021) (25+ years not sufficient to prove acquired distinctiveness); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc*, 107 USPQ2d 1750, 1766 (TTAB 2013) (19 years use insufficient to prove acquired distinctiveness); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (16 years “is a substantial period but not necessarily conclusive or persuasive” on acquired distinctiveness).

In support of its argument that its “MONSTER brand has become famous,” 72 TTABVUE 19, Sacks testified that Opposer yearly sells about 2.5 billion cans bearing the “MONSTER Marks” in the United States, resulting in \$3.52 billion in gross sales of “its Monster line of beverages” in the year ending December 31, 2021, steadily increasing each year from \$1.43 billion in 2011. 47 TTABVUE 19. Opposer’s energy drinks are allegedly “among the top two best-selling energy drinks in the United States,” holding “a 31.9% share of the measured Total Non-Alc (TNA) energy drink market [for a] five week period ending January 1, 2022.” *Id.* Sacks also stated that a “vast majority” (but no specific figure is given) of Opposer’s 9.4 billion dollar promotional costs has gone towards promoting the “MONSTER Marks” in the United States. *Id.* at 20. As noted, Opposer also sells a variety of collateral merchandise bearing the MONSTER ENERGY and  marks through third-party

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licensing arrangements, and by “sponsoring and participating in live events such as auto exhibitions, sporting events, parties, conventions, trade shows, and Halloween and horror events.” *Id.* at 8. Many news articles and media report on the success of Opposer’s beverages and its sponsorship of such events.

Injecting a measure of alleged weakness in Opposer’s marks, Applicant testified that the “generic term monster is commonly used among horror conventions,” and that he has “personal knowledge of Monsterpalooza, Monster-Mania Con and Monster Comic Con.” 53 TTABVUE 12-13. Copies of advertisements for these conventions are attached as Exhibits, along with Applicant’s flyer advertising a “MAD MONSTER PARTY. The flyer describes the actor David Prowse as having portrayed “The Monster from Hammer’s The Horror of Frankenstein,”



53 TTABVUE 31, Exhibit I.

We find that Sack’s testimony and the articles and stories about the renown of MONSTER ENERGY drinks establish that MONSTER ENERGY and **MONSTER** are well-known marks for beverages. The use of “monster” for activities connected to the horror-genre, however, signal the term has been weakened in that category.

The *Dupont* factors relating to strength of the mark overall favor a finding of likelihood of confusion.


B. Similarity or Dissimilarity of the Marks


Under the first *DuPont* factor, we examine the similarities and dissimilarities of the parties’ marks in their entirety as to appearance, sound, meaning, and commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (*quoting DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d at 1812; *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”).


“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the

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recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant's marks each contain the words MAD MONSTER. They vary with respect to additional elements: the standard character mark and one of the design marks include the word PARTY; both design marks include additional designs (the "head of a monster" or depiction of a martini glass). Opposer's marks are MONSTER ENERGY and .

Comparing Applicant's MAD MONSTER PARTY mark and Opposer's MONSTER ENERGY and  marks for similarities and differences in appearance, pronunciation, and connotation, although all contain the term MONSTER, none of the additional features of Opposer's marks suggest a "mad monster" or a "monster party." Applicant's mark does not suggest "energy." Even if we construed Applicant's standard character mark as depicted in the same font style as Opposer's mark, *see* Trademark Rule 2.52(a), the words "Mad ... Party" surrounding the word "MONSTER" alter its meaning from that of the word "monster" alone. Further, assuming strict application of Rule 2.52, there is nothing in the record to suggest that the stylized "O" has acquired distinctiveness as a source indicator such that consumers would perceive its (assumed) presence in Applicant's mark as indicating the source of the services to emanate from Opposer.

The wording “MAD MONSTER” personalizes the general idea of a monster and changes it, with assistance from the alliteration and, for the design marks, the portraiture, into a specific character. That is, the word “MAD” does more than simply inform the consumer of the type of monster involved, it forms a unitary phrase personifying the creature. The additional word “PARTY” suggests a gathering of such creatures. These connotations are entirely absent from Opposer’s MONSTER ENERGY or  marks. Opposer’s mark MONSTER ENERGY is further attenuated from Applicant’s marks given the meaning of the term “energy,” which imbues the mark with allusion to the energy-providing nature of Opposer’s drinks and supplements; or when applied to extreme sports, competitions, and music events.¹⁸ As for the unusual and unique monster head design, it creates a strong impression upon the viewer by immediately drawing one’s attention, and thus further distinguishes the two marks in which it appears from each of Opposer’s marks. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015) (Board can “in appropriate circumstances, give greater weight to design component of a composite mark”); *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014).

When Applicant’s and Opposer’s marks are considered in their entirety in connection with the parties’ goods and services, the marks engender sufficiently

¹⁸ “Energy” is defined, inter alia, as a “dynamic quality,” “the capacity of acting or being active,” and as a “vigorous exertion of power.” At <https://www.merriam-webster.com/dictionary/energy>, accessed September 1, 2023. Judicial notice may be taken of dictionary evidence. *Univ. of Notre Dame du Lac*, 213 USPQ at 594.

different overall commercial impressions such that they would not be considered confusingly similar. The first *DuPont* factor weighs in favor of a finding of no likelihood of confusion.

C. Similarity or Dissimilarity of the Goods and Services

We next consider the second *DuPont* factor, “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 177 USPQ at 567. Our comparison is based on the goods and services as identified in Applicant’s applications and the goods and services identified in Opposer’s pleaded registrations. See *Stone Lion Cap. Partners v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (citation omitted). The goods and services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven*, 83 USPQ2d at 1724).

Applicant’s goods are a “general feature magazine in the field of horror and pop culture” and his services are “organizing exhibitions for educational and entertainment purposes services, namely, organizing and conducting conventions in the fields of horror and popular culture.” Inasmuch as the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods and/or services set forth in the application, *Octocom Sys. Inc. v. Houston Comps. Svcs.*

Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), we are mindful that Applicant's magazines and conventions are restricted to the fields of horror and popular culture.

Opposer argues that both parties' entertainment events relate to popular culture: "e.g., sports, music, e-sports, auto conventions," and that "[Opposer] has also organized, sponsored, and/or participated in events related to the horror genre." Opposer's Brief, 72 TTABVUE 51. We accept Opposer's argument that its services may be described as relating to popular culture and are not restricted to Halloween or horror-themed events. An example is Opposer's sponsorship of the Winter and Summer "X Games" for extreme sports, which it has sponsored from 2014 to 2021. 47 TTABVUE 34. "Monster-sponsored athletes, with MONSTER-branded gear and equipment, participated in all of these games." *Id.* at 36. Opposer has also sponsored Olympic athletes, *id.* at 38, and NASCAR's drivers, *id.* at 39. However, given the somewhat vague nature of the term "popular culture," we believe, in this particular situation, it is not improper to consider the extrinsic evidence showing that Applicant restricts his services to horror-themed activities, including "sci-fi." McGarr Deposition, 46 TTABVUE 10. Applicant uses the term "pop culture" in describing the "celebrities and other influencers" that are featured at his conventions as being "from pop culture." *Id.*

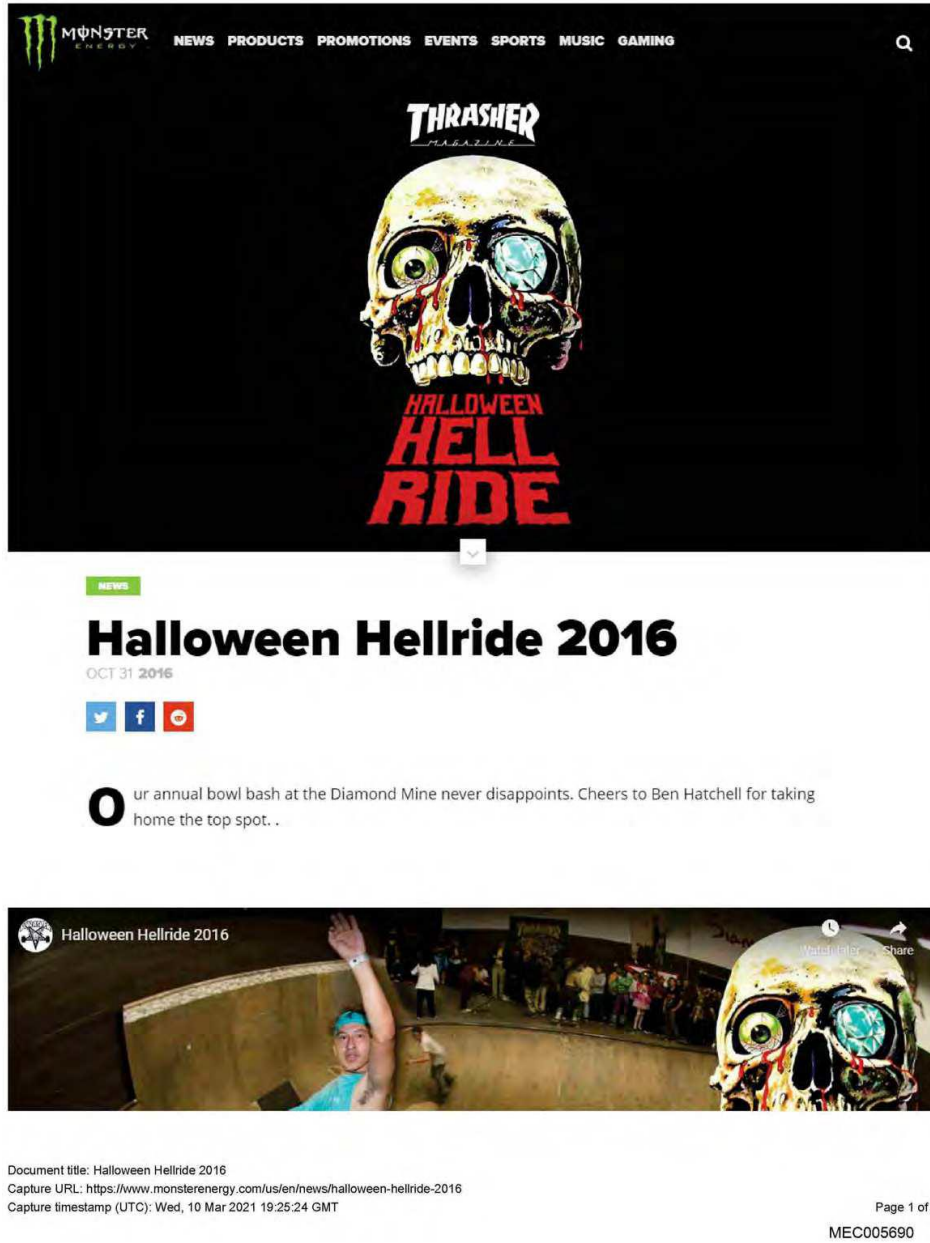
As for Opposer, to the extent Opposer argues that its entertainment events relate to the horror genre, Sacks identified four Halloween or horror-themed events at which Opposer supplied beverages: the October 2012 Oblivion Haunted House event in

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Menasha, Wisconsin; the October 2013 Museum of Fear in Lafayette, Louisiana; the October 2016 Halloween Hell Ride in Los Angeles, California; and the October 2019, New York City, NY, Dia de los Muertos parade. Sacks Decl., 47 TTABVUE 10, Exhibits 6 and 7. Opposer submitted copies of photographs and promotional materials in connection with these events, and attached two spreadsheets to the Sacks declaration: (1) “Halloween events from 2017 to 2020 that [Opposer] sponsored or attended,” and (2) Opposer’s “product sampling activities” at these events. *Id.*, Exhibit 9. These spreadsheets indicate Opposer’s activities at the Halloween events focused on treating attendees to samples of various of Opposer’s beverages.

The Museum of Fear flyer is depicted supra. Further examples of Opposer’s advertising for its “horror events” are depicted below:¹⁹

¹⁹ Several of the exhibits are repeats from Opposer’s Notice of Reliance, 45 TTABVUE. Submitting the documents more than once does not increase their probative value or make them more convincing evidence.

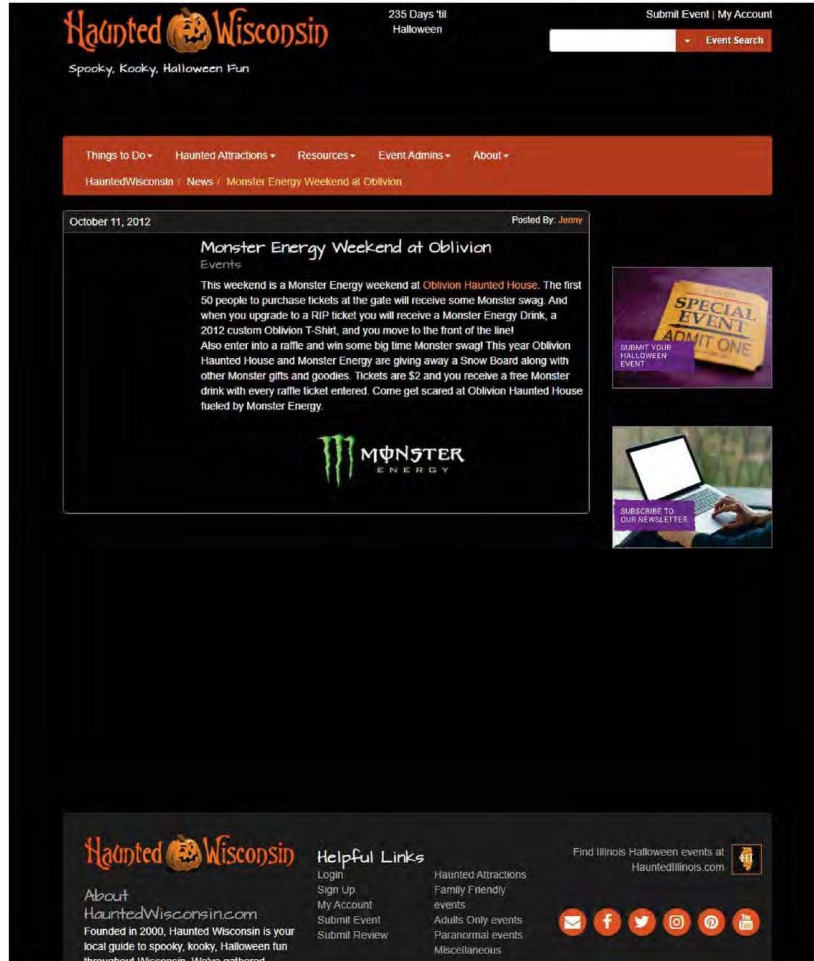


The image is a screenshot of a web page from the Monster Energy website. At the top, there is a navigation bar with the Monster Energy logo on the left and links for NEWS, PRODUCTS, PROMOTIONS, EVENTS, SPORTS, MUSIC, and GAMING on the right. Below the navigation bar is a large graphic featuring a stylized skull with glowing eyes and the text 'THRASHER MAGAZINE' at the top and 'HALLOWEEN HELL RIDE' in large red letters at the bottom. Below the graphic is a green 'NEWS' tag and the main title 'Halloween Hellride 2016' in bold black text. Underneath the title is the date 'OCT 31 2016' and three social media icons for Twitter, Facebook, and Google+. A paragraph of text begins with a large 'O' and reads: 'ur annual bowl bash at the Diamond Mine never disappoints. Cheers to Ben Hatchell for taking home the top spot. .'. Below the text is a video player showing a person in a blue shirt performing a trick on a skateboard ramp. The video player has a title 'Halloween Hellride 2016' and a 'Share' button. At the bottom of the page, there is a document title 'Halloween Hellride 2016', a capture URL 'https://www.monsterenergy.com/us/en/news/halloween-hellride-2016', a capture timestamp '(UTC): Wed, 10 Mar 2021 19:25:24 GMT', and the page number 'Page 1 of 3' with the identifier 'MEC005690'.

Document title: Halloween Hellride 2016
Capture URL: <https://www.monsterenergy.com/us/en/news/halloween-hellride-2016>
Capture timestamp (UTC): Wed, 10 Mar 2021 19:25:24 GMT

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Id. at 260.



Document title: Monster Energy Weekend at Oblivion - Events - News & Updates - News - HauntedWisconsin.com
Capture URL: https://www.hauntedwisconsin.com/news/2012/10/11/monster-energy-weekend-at-oblivion
Capture timestamp (UTC): Wed, 10 Mar 2021 19:31:16 GMT

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Id. at 264. The fine print reads:



Opposer also submitted “fan” photos, of which at least 5 were taken at the same venue. These depict attendees drinking Opposer’s beverages; two of them include promotional banners displaying the MONSTER ENERGY and claw design and a truncated version of Opposer’s stylized MONSTER mark,



Sacks also asserted that some sponsored musical events feature musicians “associated with the horror genre.” 47 TTABVUE 12, Exhibit 13. Sacks attached to his declaration a copy of “a June 2015 announcement showing Rob Zombie’s and Korn’s participation in Monster’s Rock Allegiance music festival.” *Id.* at 12. This flyer uses “Monster Energy” as a trade name. 47 TTABVUE 315, Exhibit 13. In 2016, Sacks testified that Opposer announced “the ‘MONSTER ENERGY PARTY ZONE’ at the Vans Warped Tour,” which “included side-by-side stages prominently displaying Monster’s MONSTER Marks.” However, the only exhibit that concerns this tour, Exhibit 11 to his declaration, is a copy of a 2007 promotion that identifies Opposer’s marks only as beverage brands. 47 TTABVUE 311.

Turning to Applicant’s mark  for a “general feature magazine in the field of horror and pop culture,” Opposer argues that Applicant’s magazine is “very similar to the paper goods (e.g., calendars, posters, poster books, stickers) that [Opposer] distributes.” 47 TTABVUE 18. Opposer further argues that its “extensive collateral licensing program” makes it more likely that relevant consumers would perceive Applicant’s magazine as having been published by Opposer. *Id.* at 52-53. Applicant testified that his magazine “is a retro-style vintage monster magazine covering contemporary horror.” 53 TTABVUE 3. Applicant described his magazine as not being “limited to horror” but also containing “pop culture.” 46 TTABVUE 59. Again viewing the term “popular culture” in context, we find that none of Opposer’s paper promotional goods sold as merchandising items (e.g., signage, stickers, paper cups) are related to Applicant’s monster magazines such that consumers would

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perceive a common source of origin. *See, e.g.*, 51 TTABVUE 130-175 (2009 catalog, submitted under seal).

Although Opposer's services of "promoting sports and music events and competitions for others" may include horror-themed events at which attendees imbibe Opposer's beverages, consumers are unlikely to perceive Applicant's conventions, restricted to the horror and popular culture fields, or its horror and pop culture-related magazines, as emanating from the same source as sporting or music events sponsored by Opposer.

The second *DuPont* factor favors a finding of no likelihood of confusion.

D. Similarity or Dissimilarity of Trade Channels

Under the third *DuPont* factor, we consider the "similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567. We base our consideration of the channels of trade on the basis of the goods and services recited in Applicant's applications and Opposer's registrations. *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 16 USPQ2d at 1787 ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application, regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.").

Because there are no restrictions or limitations in Opposer's identifications of goods or services as to trade channels, we presume that the goods or services would be marketed in all normal trade channels and to all normal classes of purchasers for such goods or services. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352,

56 USPQ2d 1351, 1357 (Fed. Cir. 2000) (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”). These include ordinary young adults interested in consuming energy beverages or attending sporting or music events at which these beverages are sold. “Monster allocates a large proportion of its marketing, advertising, and promotional budget on athlete endorsements and sponsoring athletic competitions and other events in order to reach our primary target market of young adults aged 18 to 34 years old, primarily males.” 47 TTABVUE 21.

Applicant’s services are directed to those individuals who are interested in horror-themed conventions, but also “fans of pop culture.” 46 TTABVUE 97. His magazine is also directed to “horror and pop culture.” *Id.*, at 59. Both parties have a presence on the Internet through proprietary websites and various social media platforms, 53 TTABVUE 8 (Applicant); 47 TTABVUE 52 (Opposer), and both advertise on radio and television. 46 TTABVUE 95 (Applicant); 47 TTABVUE 56 (Opposer). Opposer’s beverage products were also distributed at Applicant’s “Mad Monster Party’s 2013 New Orleans horror show.” 53 TTABVUE 6-8, Exhibits F-H.

The *Dupont* factor relating to channels of trade favors a finding of likelihood of confusion.

E. Conditions of Sale

The fourth *DuPont* factor considers the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. We must make our determination based on the least sophisticated

consumer. *Stone Lion*, 110 USPQ2d at 1163-64 (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that precedent requires consumer care for likelihood-of-confusion decision to be based “on the least sophisticated potential purchasers”).

Opposer argues that “Applicant’s Goods and Services are relatively inexpensive.” 72 TTABVUE 55. However, Applicant’s price of admission for its events ranges from \$30 to \$200, prices that do not appear to be particularly cheap or subject to impulse purchasing. 46 TTABVUE 53. Applicant’s magazines cost \$13 per copy. *Id.* at 320. Again, the record does not support a finding that this is particularly inexpensive.

Accordingly, we find the fourth *DuPont* factor neutral. *See Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *8 (TTAB 2019) (finding fourth *DuPont* factor neutral even if parties’ goods are not subject to impulse buying in the absence of evidence in the record showing consumers will exercise a higher degree of care).

F. Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion in light of the length of time and conditions under which there has been contemporaneous use of Opposer’s and Applicant’s marks. *DuPont*, 177 USPQ at 567. The seventh and eighth *DuPont* factors are interrelated; the absence of evidence of actual confusion, under the seventh *DuPont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence, under the eighth *DuPont* factor, that there has been a significant opportunity for actual confusion to have occurred. *See In re Cont’l Graphics Corp.*, 52 USPQ2d 1374, 1377 (TTAB 1999); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB

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1992). Under the eighth *DuPont* factor, we “look at actual market conditions, to the extent there is evidence of such conditions of record.” *See In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020).

Opposer argues that there is circumstantial evidence to suggest “a high potential” for actual confusion based on Applicant’s use of an allegedly distorted version of Opposer’s MONSTER ENERGY and claw design mark on a flyer to promote Applicant’s 2013 New Orleans event. 72 TTABVUE 45. The parties agree that “on September 5, 2013, Jason Mitchell, a New Orleans Marketing Ambassador Team (“MAT”) team leader, reached out to Applicant’s business” to see whether Opposer could donate some product for Applicant’s 2013 New Orleans event. Sack’s Rebuttal Testimony Declaration, 65 TTABVUE 4 (citing email from Mr. Mitchell to Applicant, 53 TTABVUE 25, Exhibit F). A copy of the flyer is presented below:



There is little chance that the flyer would have caused participants in Applicant's MAD MONSTER PARTY GRAS to assume an affiliation with Opposer of anything other than that Opposer's beverages would be available for consumption at the event. The tagline: "ENERGY FOR MONSTERS IS PROVIDED BY" followed by the (albeit allegedly distorted) MONSTER ENERGY and claw design mark further dispels any likelihood of actual confusion. Accordingly, we find the seventh and eighth *DuPont* factors are neutral.

G. Applicant's Intent to Trade on Opposer's Goodwill

Opposer argues that Applicant's unauthorized use of Opposer's mark on the 2013 New Orleans event flyer "reveals Applicant's intent to confuse attendees that

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[Opposer] was a national sponsor of Applicant’s event” and that his statement to Mitchell that Applicant had worked with Opposer in California and could therefore “call [Opposer] a national sponsor proves his malintent.” 72 TTABVUE 46. We find Applicant’s statement that his MAD MONSTER Marks “are a tribute to the 1967 Rankin Bass stop-motion movie ‘Mad Monster Party?’ [p]opular in horror circles,” 68 TTABVUE 3, and his ownership of prior registrations for similar marks (discussed more fully below) effectively rebut Opposer’s allegations of bad faith adoption.

This *DuPont* factor is neutral.

H. Applicant’s Prior Registrations

Applicant owns two prior registrations: Reg. No. 4049254 for the mark MAD MONSTER for “general feature magazine in the field of horror,” and Reg.



No. 5572940 for the mark for “Radio broadcasting.”

The thirteenth *DuPont* factor pertains to “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. This factor “accommodates the need for flexibility in assessing each unique set of facts...” *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012), including the coexistence of an applicant’s prior-registered mark with the cited registration. Applicant’s marks have co-existed with Opposer’s marks since 2011 (MAD MONSTER) and 2018 (MAD MONSTER RADIO and design).

Where an applicant owns a prior registration and the mark is “substantially the same” as in the applied-for application, this can weigh against finding that there is a

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likelihood of confusion. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1748 (TTAB 2018) (citing *Strategic Partners*, 102 USPQ2d at 1399), *aff'd mem.*, (Fed. Cir. Sept. 13, 2019)); *see also In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *16 (TTAB 2019). For example, in *Strategic Partners*, no likelihood of confusion was found with the registered mark ANYWEAR BY JOSIE NATORI and design where the applicant's prior registered mark ANYWEARS was substantially similar to the applied-for mark ANYWEAR for identical goods.

Here, Applicant's prior registered mark MAD MONSTER is substantially the same as each of his three applied-for marks. The identifications of goods in the



application (Serial No. 87328584) and Applicant's prior registration (Reg. No. 4049254) are virtually identical. The registration has co-existed with Opposer's marks since 2011. The addition of the monster head design element further attenuates any perceived similarity between Applicant's mark and any of Opposer's marks. This weighs heavily in favor of a finding of no likelihood of confusion with respect to this application.

With respect to Applicant's other two applications, although the marks are similar, the goods and services of the prior registrations are dissimilar from those


services recited in Applicant's MAD MONSTER PARTY and



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applications. Accordingly, the thirteenth *DuPont* factor is neutral with respect to these two applications.

IV. Balancing the factors

The final step is to weigh together the findings we have made on the relevant *DuPont* factors to determine if, on balance, confusion is likely. *See, e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023) (“Assigning weight to the factors is typically the Board practice.”). Opposer has not proved its ownership of a family of marks on this record prior to any date upon which Applicant may rely. Opposer has shown that its MONSTER ENERGY and  marks are well-known for beverages and for promotional services in the “sports and motorsports” industries, but not in the music industry or in association with “promoting music events.” *See, e.g., Monster Energy*, 2023 USPQ2d 87, at *29 (finding fame of MONSTER ENERGY beverages did not extend to restaurant services generally); *Jockey Int’l, Inc. v. Butler*, 3 USPQ2d 1607, 1612 (TTAB 1997) (“[A] mark’s fame may not extend to all products.”).

The goods and services are unrelated, even considering that both parties participate in events that may be considered “horror-themed”; Applicant organizes and conducts these conventions while Opposer’s involvement is to promote the events by sponsorship. Opposer has shown that the trade channels overlap and that the variety of goods upon which Opposer uses its marks favors a finding of likelihood of confusion. The *DuPont* factors relating to conditions of sale, actual confusion, and Applicant’s alleged bad faith intent are neutral.

Significantly, we find the marks differ sufficiently in their connotations and overall commercial impressions that, when applied to the goods and services involved, confusion is unlikely, even considering the variety of goods on which Opposer's marks are used, the limited overlap of the goods and services, and their trade channels. The first *DuPont* factor is dispositive, in that this factor of the dissimilarities of the marks simply outweighs the other factors. See *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“a single *du Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were considered in [Opposer's] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”); *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). Prospective consumers are unlikely to confuse the source of the involved goods and services, recognizing that they originate from different entities. Applicant's ownership of its prior registrations further corroborates our finding of no likelihood of confusion, especially with respect to its Class 16 application.

Decision: The oppositions are dismissed.