

**This Opinion is Not a
Precedent of the TTAB**

Mailed: February 1, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Monster Energy Company

v.

Li-Wei Chih

—
Consolidated:
Opposition No. 91205893 (parent)
Opposition No. 91205924
—

Nicole R. Townes of Knobbe, Martens, Olson & Bear, LLP
for Monster Energy Company.

Eve Brown, Boston University School of Law
for Li-Wei Chih.

—
Before Kuhlke, Wellington, and Gorowitz,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Li-Wei Chih (“Applicant”) seeks to register the marks:

MONSTERFISHKEEPERS (in standard character format) for:
“Baseball caps and hats; golf caps; hats; hooded sweat shirts; knitted caps;
long-sleeved shirts; sports caps and hats; sweaters; T-shirts” in
International Class 25;¹ and

¹ Application Serial No. 85518033 (subject to Opposition No. 91205893), filed on January 17, 2012, based upon an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming May 15, 2005 as both the date of first use and the date



for:

“Baseball caps and hats; golf caps; hats; hooded sweat shirts; knitted caps; sports caps and hats; sweaters; T-shirts; wearable garments and clothing, namely, shirts” in International Class 25.²

Monster Energy Company (“Opposer”) opposes the registration of each of Applicant’s marks on the grounds of likelihood of confusion and dilution. In support of its claims, Opposer pleaded ownership of the following registered marks:



for:

“Clothing, namely, t-shirts, hooded shirts and hooded sweatshirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely, hats and beanies” in International Class 25;³

“Stickers; sticker kits comprising stickers and decals; decals” in International Class 16;⁴

“Sports helmets” in International Class 9;⁵ and

“All purpose sport bags; all-purpose carrying bags; backpacks; duffle bags” in International Class 18;⁶

of first use in commerce.

² Application Serial No. 85508374 (subject to Opposition No. 91205924), filed on January 4, 2012, based upon an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming May 15, 2005 as both the date of first use and the date of first use in commerce.

³ Registration No. 3908601 issued on January 18, 2011. ENERGY is disclaimed.

⁴ Registration No. 3908600 issued on January 18, 2011. ENERGY is disclaimed.

⁵ Registration No. 3914828 issued on February 1, 2011. ENERGY is disclaimed.

⁶ Registration No. 3923683 issued on February 22, 2011. ENERGY is disclaimed.

“Beverages, namely, carbonated soft drinks, carbonated soft drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, carbonated energy and sports drinks, fruit juice drinks having a juice content of 50% or less by volume that are shelf stable, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not” in International Class 32.⁷



for:

“Clothing, namely, t-shirts, hooded shirts and hooded sweatshirts, sweat shirts, jackets, pants, bandanas, sweat bands and gloves; headgear, namely, hats and beanies” in International Class 25;⁸

“Drinks, namely, carbonated soft drinks, carbonated drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, carbonated and non-carbonated energy or sports drinks, fruit juice drinks having a juice content of 50% or less by volume that are shelf stable, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not” in International Class 32;⁹

“Nutritional supplements” in International Class 5;¹⁰

“Non-alcoholic beverages, namely, energy drinks, excluding perishable beverage products that contain fruit juice or soy” in International Class 32;¹¹

⁷ Registration No. 3134841 issued on August 29, 2006, Section 8 & 15 combined declaration accepted and acknowledged. ENERGY is disclaimed.

⁸ Registration No. 4051650 issued on November 8, 2011.

⁹ Registration No. 2903214 issued on November 16, 2004, renewed.

¹⁰ Registration No. 3434821 issued on May 27, 2008, Section 8 & 15 combined declaration accepted and acknowledged.

¹¹ Registration No. 3434822 issued on May 27, 2008, Section 8 & 15 combined declaration accepted and acknowledged.

“Stickers; sticker kits comprising stickers and decals; decals; posters” in International Class 16;¹²

“All purpose sport bags; all-purpose carrying bags; backpacks; duffle bags” in International Class 18;¹³ and

“Sports helmets; video recordings featuring sports, extreme sports, and motor sports” in International Class 9.¹⁴

MONSTER ENERGY (in standard character format) for:

“Non-alcoholic beverages, namely, energy drinks, excluding perishable beverage products that contain fruit juice or soy” in International Class 32;¹⁵

“Fruit juice drinks having a juice content of 50% or less by volume that are shelf stable, carbonated soft drinks, carbonated drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not” in International Class 32;¹⁶ and

“Nutritional supplements in liquid form, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not” in International Class 5.¹⁷

M MONSTER ENERGY (in standard character format) for:

“Nutritional supplements in liquid form, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not” in International Class 5;¹⁸ and

“Beverages, namely, carbonated soft drinks, carbonated drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, carbonated energy or sports drinks, fruit juice drinks having a juice content of 50% or less by volume

¹² Registration No. 3963668 issued on May 17, 2011.

¹³ Registration No. 3963669 issued on May 17, 2011.

¹⁴ Registration No. 4011301 issued on August 16, 2011.

¹⁵ Registration No. 4036681 issued on October 11, 2011. ENERGY is disclaimed.

¹⁶ Registration No. 3057061 issued on February 7, 2006, renewed. ENERGY is disclaimed.

¹⁷ Registration No. 3044315 issued on January 17, 2006, renewed. ENERGY is disclaimed

¹⁸ Registration No. 3044314 issued on January 17, 2006, renewed. ENERGY is disclaimed

that are shelf stable, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not” in International Class 5.¹⁹

MONSTER MIXXD (in standard character format) for:

“Nutritional Supplements” in International Class 5, and “Non-alcoholic beverages, namely, carbonated soft drinks; carbonated drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs; carbonated energy or sports drinks” in International Class 32.²⁰

MONSTER REHAB (in standard character format) for:

“Nutritional Supplements liquid form” in International Class 5, and “Beverages, namely, non-alcoholic non-carbonated drinks enhanced with vitamins, minerals, nutrients, proteins, amino acids and/or herbs; non-carbonated energy or sports drinks, fruit juice drinks having a juice content of 50% or less by volume that are shelf-stable; all the foregoing goods exclude perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not” in International Class 32;²¹ and

“Ready to drink tea, iced tea and tea based beverages; ready to drink flavored tea, iced tea and tea based beverages” in International Class 30.²²

Opposer also pleaded ownership of a family of marks; specifically, it alleged that by virtue of its “continuous and substantial use, [Opposer’s registered MONSTER-formative marks] have become identifiers of Opposer such that consumers have come to recognize a family of ‘MONSTER’ marks with which Opposer markets and sells its goods. 1 TTABVUE 13 (Notice of Opposition ¶ 18).²³ Opposer further pleaded that its

¹⁹ Registration No. 3134842 issued on August 29, 2006, Section 8 & 15 combined declaration accepted and acknowledged. ENERGY is disclaimed.


²⁰ Registration No. 3852123 issued on September 28, 2010.

²¹ Registration No. 4129288 issued on April 17, 2012.



²² Registration No. 4111964 issued on March 13, 2012.


²³ Record citations are to TTABVUE, the Trademark Trial and Appeal Board’s publically available docket history system, by entry and, where applicable, page number. *See Turdin v.*

“extensive common law rights in its Family of MONSTER marks ... predate the filing date of the Application.” *Id.*, ¶ 19.

In the notices of opposition and in its trial brief, Opposer frequently refers to its various pleaded marks, registered and non-registered, collectively as either its “MONSTER Marks” or its “ and MONSTER Marks.”


With regard to its likelihood of confusion claim, Opposer alleges that Applicant’s proposed mark MONSTERFISHKEEPERS “so resembles Opposer’s family of MONSTER Marks registered ... and in which Opposer owns common law trademark rights, as to be likely, when used on or in connection with the goods as they are identified in the Application, as to cause confusion.” *Id.*, ¶ 27. Opposer also alleges

that it will be “damaged by registration of the Application in that  mark so resembles Opposer’s  and MONSTER Marks registered ... and in which Opposer owns common law trademark rights, as to be likely, when used on or in connection with the goods as they are identified in the Application, as to cause confusion.”²⁴

With regard to its dilution claim, Opposer alleges that Applicant’s marks MONSTERFISHKEEPERS and  “will dilute the distinctive quality” of

Trilobite, Ltd., 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Unless otherwise indicated, all TTABVUE record citations are to Opposition No. 91205893 which has been designated as the “parent” proceeding.

²⁴ 1 TTABVUE 19 (Opposition No. 91205924, Not. of Opp. ¶ 30).

Opposer's MONSTER ENERGY and  Marks "within the meaning of Section 43(c) of the Trademark Act, 15 USC 1125(c), and will lessen the ability of [Opposer's marks] to distinguish Opposer's goods." *Id.*, ¶ 28.²⁵

Applicant, in his answers, denied the salient allegations of the notices of opposition.

The Board consolidated the opposition proceedings and matters have been presented on the same record and briefs which were filed in the parent proceeding, Opposition No. 91205893.²⁶

I. Opposer's Motion to Strike/ Evidentiary Objections

In an order issued on March 5, 2015, the Board deferred consideration with respect to Opposer's motion to strike Applicant's first, second and third notices of reliance on the ground that the documents being submitted under the notices of reliance were "improperly withheld by Applicant during discovery"; however, the Board granted the motion to strike, in part, with respect to certain materials submitted under Applicant's first notice of reliance because they were inadmissible as submitted. Applicant was allowed time to file a revised notice of reliance curing

²⁵ Opposer's allegations regarding the stylized M mark are found at 1 TTABVUE 19 (Opposition No. 91205924, Not. of Opp. ¶ 31).

²⁶ The Board *sua sponte* consolidated the proceedings prior to trial. 19 TTABUE. We note that each party filed a brief that does not conform to the rules. Specifically, Opposer's main trial brief is 58 pages and Rule 2.128(b) provides that a main brief shall not exceed 55 pages. Applicant's brief does not contain an index of cases, as required by the same rule. Inasmuch as neither party objected to the other's brief and there is no apparent intent to abuse or obfuscate the rules, we exercise our discretion and consider the briefs.

the deficiency.²⁷ Applicant filed a “revised” first notice of reliance within the time allowed.²⁸

Opposer filed a paper, concurrent with its trial brief, renewing its objections because “Applicant failed to disclose this evidence to Opposer during discovery.”²⁹ Opposer also raised objections to certain evidence because it lacked probative value and was “prejudicial” to Opposer or otherwise contained hearsay statements.

Applicant responded to the Opposer’s motion asserting that “[n]one of the evidence submitted by Applicant with his notices of Reliance was in Applicant’s possession, custody, or control, nor did it originate from any of Applicant’s websites or social media pages.”³⁰ Applicant noted that “[a]ll evidence is publicly available, was accessed through a basic Internet search, and was properly authenticated by Applicant.”³¹

We accept Applicant’s explanation that he only acquired the documents shortly before, and in preparation of, his filing the notices of reliance. Dates at the bottom of many of the Internet printouts indicate that they were accessed and printed out only a few days before, or on the same day as, the filing of the notices of reliance and thus corroborate Applicant’s explanation. Under these circumstances, we do not believe

²⁷ 54 TTABVUE.

²⁸ 55 TTABVUE.

²⁹ 59 TTABVUE 3.

³⁰ 51 TTABVUE 7.

³¹ *Id.*

that an equitable estoppel sanction is warranted. *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011) (no estoppel where objected-to documents were obtained or created by applicant during trial and were not responsive documents that were already in its possession or control when it responded to document requests). While Opposer is correct that Applicant was under a continuing duty to supplement his discovery responses, pursuant to Fed. R. Civ. P. 26, it would have been superfluous since any supplementation would have occurred contemporaneously with the notices of reliance. In other words, Opposer is hard-pressed in arguing that it was prejudiced by Applicant's conduct because Opposer was aware of the publicly available materials, including their URL's, very shortly after Applicant came into possession of the materials. *See Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1346 (TTAB 2013) (party's failure to supplement its discovery responses or initial disclosures with respect to third-party use found harmless).

With respect to Opposer's objections based on the documents containing hearsay statements or lacking probative value, it is well settled that the probative value of Internet -accessed materials is limited to what they show on their face. *See TBMP § 704.08(b)* (2015). They cannot be used to demonstrate the truth of statements made in the materials, absent an exception to the hearsay rule or testimony from an individual with personal knowledge or qualified to corroborate the truth of the statement. *See Fed. R. Evidence 801 et seq.* Nevertheless, the Board does not strike evidence on the basis that it has little probative value or may contain hearsay

statements. In short, the Board considers the evidence for whatever probative value it may have and gives no weight to any impermissible hearsay statements contained therein.

Accordingly, Opposer's motion to strike is denied.

II. Record

The record in this case consists of the pleadings and, by rule, the files of the involved applications. Trademark Rule 2.122.

Opposer submitted a copy of the deposition testimony, with accompanying exhibits, of its Chairman and CEO, Mr. Rodney Sacks.³²


Pursuant to Rule 2.122(d), Opposer introduced its pleaded registrations into the record, by attaching USPTO electronic database copies showing current status and title with its notices of opposition and under notice of reliance.³³ Rule 2.122(d). In addition, Opposer also submitted the following materials under its first notice of reliance:³⁴ copies of Opposer's state trademark registrations; copies of Applicant's responses to certain discovery requests propounded by Opposer, including responses to interrogatories and requests for admission as well as supplemental responses, for both opposition proceedings; copies of printed publications involving Opposer and its business; Internet printouts involving Opposer and its promotion of its goods;

³² 48 TTABVUE.

³³ 1 TTABVUE (notice of opposition) and 33 TTABVUE (first notice of reliance). Printouts obtained from the USPTO's TSDR and TESS electronic databases.

³⁴ 33 TTABVUE.

Internet printouts from various Facebook pages, including one purportedly belonging to Applicant; printouts from the various websites, including: www.monsterfishkeepers.com, www.monsterarmy.com, and www.monsterenergy.com; and copies of Opposer's various annual reports with the U.S. Securities and Exchange Commission and obtained from www.sec.gov. Under a second notice of reliance, filed during its rebuttal period, Opposer submitted printouts from websites identified by Applicant in one of his notices of reliance.³⁵

For his part, Applicant submitted the following materials under notices of reliance:³⁶ a copy of his Registration No. 3321091 for the mark  for services in International Class 38; Internet printouts from various websites containing images of fish or the term "monster fish" or the term "monster"; dictionary definition for "monster" from online Oxford English Dictionary (www.oed.com);³⁷ printouts from different Facebook pages, including for "Monster Professional Services" and "Monster Energy"; third-party registrations with the term MONSTER or a separate, stylized letter M in the mark for goods in International Class 25; and printouts of online

³⁵ 56 TTABVUE.



³⁶ 39-42 and 55 TTABVUE. Pursuant to the Board's March 5, 2015 order (54 TTABVUE), certain pages (39 TTABVUE 11-15 and 32-33) from Applicant's first notice of reliance are not considered.

³⁷ The definition contains a mixture of British and U.S. meanings indicating the term may have slightly different meanings depending on where it is used; thus, we have chosen to take notice of a *Merriam-Webster* dictionary definition (see footnote 72, *infra.*). *Cf., In re Heatcon, Inc.*, 1374 n.19 (TTAB 2015); *see also, In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1313 n.18 (TTAB 2014).

articles involving Opposer and its products, beverage brands in general, the dispute between Opposer and Applicant, and a printout from the website www.change.org, including a purported online petition involving the instant proceeding.

III. Opposer's Standing

On the record before us, it is clear that Opposer is more than a mere intermeddler and has a personal interest in opposing the involved applications for the marks MONSTERFISHKEEPERS and a stylized letter M, both for use on clothing. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

In particular, Opposer is the owner of registrations for the marks  and the stylized letter M mark, , both for clothing. In addition, Opposer's CEO has testified that Opposer is in the business of selling energy drinks as well as clothing. Accordingly, Opposer has shown it has standing in this matter.

IV. Priority

a. Opposer's Pleaded Registrations

With respect to Opposer's pleaded registered marks, they were properly introduced and have not been challenged by Applicant. Thus priority is not an issue with respect to these registered marks, vis-à-vis Applicant's applied-for marks, and the goods identified in the applications and registrations. *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). However, for

purposes of our likelihood of confusion analysis, we do not discuss all of Opposer's marks but focus on the two registered marks:



(Reg. No. 3908601) and



(Reg. No. 4051650).

These are the only two pleaded registrations of record for clothing and Opposer's likelihood of confusion claim is based solely on its use of its marks on apparel.

b. Applicant's Priority Date

With respect to Opposer's claim that it acquired common law rights in both a "Family of MONSTER Marks" and the mark MONSTER for clothing, priority is an issue.

For purposes of establishing priority, Applicant may at the very least rely on the filing dates of its applications. *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010); *see also, J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). As already mentioned (see footnotes 1-2, *infra*), the filing dates for the underlying applications are January 4, 2012 (Serial No. 85508374) and January 17, 2012 (Serial No. 85518033). Applicant did not submit any testimony or otherwise attempt to prove an earlier date of first use for its applied-for marks in connection with the identified goods. *See* Trademark Rule 2.222(b)(1) ("The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.")

Nevertheless, in its brief, Opposer concedes that Applicant began using his marks in commerce in 2010, citing to Applicant's responses to interrogatories that Opposer introduced into evidence.³⁸ Thus, in order for Opposer to prove priority with regard to any common law marks, including a family of marks, it must establish it acquired common law rights in the marks prior to 2010.

c. Opposer's Common Law Rights in a Family of MONSTER Marks

As previously noted, Opposer pleaded a family of MONSTER marks in its notice of opposition.

The Federal Circuit has defined a 'family of marks' as:

[a] group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

³⁸ See 58 TTABVUE 32-33 (Opposer's Brief), citing to 35 TTABVUE 36-37 and 87-88 (Applicant's interrogatory responses). We further note that Opposer introduced Applicant's responses to Opposer's requests for admission, including Applicant's admission that he "first used Applicant's Mark on Applicant's Goods in interstate commerce on May 15, 2005." However, Applicant cannot, himself, rely on this admission for purposes of proving this earlier date of first use. See 8A Charles A. Wright, Arthur R. Miller & Richard L. Marcus, *Federal Practice and Procedure* § 2264 at 580 (1994) ("[A]n admission does not bind the party who requested it. Even though it introduced the response in evidence it is free to produce other evidence contradicting the facts contained in the response.").

Opposer's brief falls short of arguing the required elements for establishing a family of marks. Rather, Opposer repeatedly asserts that it is the owner of various marks with the term MONSTER in them, referring to them collectively as its "Monster Marks," but does not argue that it has used these marks together in a manner whereby the consuming public would come to associate the pleaded family surname, MONSTER, with Opposer. Based thereon, we find that Opposer waived its claim of ownership of a family of MONSTER marks by failing to argue this point in its brief.

Furthermore, even if Opposer did not waive its claim of ownership of a family of marks, the record does not show that a family of MONSTER marks exists, let alone existed prior to Applicant's priority date of 2010. Although Mr. Sacks, Opposer's Chairman and CEO, testified at one point that one of its brands, JAVA MONSTER, is "part of the Monster family,"³⁹ he did not elaborate or explain how Opposer has used this mark in conjunction with its various other marks that include the term MONSTER. As the Federal Circuit pointed out in *J & J Snack Foods*, the mere existence of similar marks, containing the same term, does not necessarily create or establish the existence of a family. *See also 4 McCarthy on Trademarks and Unfair Competition* § 23:61 (4th ed.); and TMEP 1207.01(d)(xi) (October 2015).

³⁹ 45 TTABVue (designated "Confidential"); Sacks dep. 26:5.

d. Opposer's Common Law Rights in the Term MONSTER

Although Opposer did not argue or establish that it is the owner of a family of MONSTER marks, Opposer does assert in its trial brief that it has established common law rights in the term MONSTER, by itself, for clothing. And, while Opposer did not specifically plead common law rights in the single-term mark, MONSTER, it is clear that this issue was tried by implicit consent. Fed. R. Civ. 15.

In his deposition, Mr. Sacks averred:

MEC began using its Monster, the Monster Energy, the "M" Monster Energy, the claw icon, as we call it, and its "Unleash the Beast" trademarks in April 2002 when it launched Monster -- the Monster line of drinks, both -- as I said, both on beverages as well as clothing, which were manufactured right at that early time to support the launch of the brand. We've continually used our Monster marks -- the claw icon, the "Unleash the Beast" mark -- since that time and continue to do so today.

[45 TTABVUE, Sacks dep. 11:3-12].

On cross-examination, Applicant's counsel delved into Opposer's rights in the single-term mark MONSTER, *i.e.*, without any accompanying design or wording, and Mr. Sacks responded that they do possess these rights:⁴⁰

Q. Okay. Do you believe that [Opposer] owns exclusive rights to the word "monster"?

⁴⁰ *Id.* at 200:6-11.

A. I believe we have rights to the word “monster,” and I believe we have exclusive rights in, I think, you know, things that are very close to that we are doing and where there is a likelihood of confusion.

Indeed, based on the testimony of Mr. Sacks and the accompanying exhibits, Opposer has established that it has continuously used its stylized M and MONSTER marks, separately, on a variety of clothing, including caps, shirts, pants and jackets, since 2002, a date that clearly precedes Applicant’s priority date of 2010.⁴¹ While Opposer’s marks sometimes appear on cobranded articles of clothing, they also appear by themselves on tags or, more commonly, on the clothing itself in a variety of locations and manners. For example:



42

As illustrated by the image above, Opposer uses the term MONSTER in a fairly ordinary font in addition to the stylized lettering shown in the registration for the

⁴¹ See, e.g., *Id.* at 25:6 (“t-shirts”), 11 (“caps”), 15-16 (“hoodies ... sweaters”), 19-20 (“polo shirts, regular shirts ... extensive list of clothing”), referencing Exhibit 4. See also, *Id.* 41:15-17 (“we sell t-shirts, sweatshirts, jackets, pants, bandanas, sweatpants, gloves and headgear.”).

⁴² Sacks Ex. 7 (45 TTABVUE 514).

mark comprising a stylized M and the term MONSTER ENERGY. Again, under cross-examination, Mr. Sacks explained:

Q. And when you say display that word “Monster” as a trademark, are there particular fonts or styles that you use?

A. On the cans we use a single font. On clothing we change the font because it is more of a fashionable item people are wearing. So we actually change the font quite a bit on different clothing. Every year we come up with different types of styles and designs for the word – as to how to use the word “monster.” But on the cans we keep them consistent.

Thus, Opposer’s rights in the mark MONSTER for clothing are not limited to a specific font.

Mr. Sacks further testified that Opposer’s clothing is sold on Opposer’s website, at trailers set up for large supercross or motocross events,⁴³ and “motorcycle specialty stores.”⁴⁴

e. Summary

Priority is not an issue with respect to Opposer’s registered marks, including the following two that, as noted, cover apparel:



⁴³ 45 TTABVUE; Sacks dep. 76:11-77:8.

⁴⁴ *Id.* at 42:11-15.

In addition, Opposer has established that it has prior, common law rights in the mark MONSTER (appearing in various fonts) for various clothing items.

V. Likelihood of Confusion

We now turn our attention to likelihood of confusion. Our determination under Trademark Act Section 2(d) is based on an analysis of all probative 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); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. Similarity of the Goods, Channels of Trade and Purchaser Care

The involved goods are, in part, identical inasmuch as the identifications of goods for the involved applications and relevant pleaded registrations for the marks:



and (Reg. Nos. 4051650 and 3908601, respectively) list some of the same articles of clothing, *e.g.*, hats, t-shirts, hooded sweatshirts, etc. Likewise, Opposer's common law mark, MONSTER, has been used on these same apparel items. The parties' goods include other articles of clothing that, even if they are not identical, are closely related – such as pants and shirts.

With respect to the trade channels, there are no restrictions as to channels of trade or classes of consumers in the identifications of goods for the involved applications or the pleaded registrations. Thus, we must assume that the apparel described in the

applications and registrations is sold in all of the normal channels of trade to all of the normal purchasers for such goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Thus, although Applicant argues that sales of his clothing are directed to the “fish hobbyist community,” there is no restriction in the description of his clothing goods in the involved applications in this manner and we must presume that parties’ legally identical clothing will be sold to the same classes of consumers and will be found in the same trade channels. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods in the applications and/or registrations, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

However, with respect to the trade channels for Opposer’s common law mark MONSTER-branded clothing, there is no such presumption as that accorded to its registered marks. Rather, Opposer must prove that MONSTER clothing is sold in the same or similar type of distribution channels as encompassed by applicant’s description of goods, namely, any of the normal trade channels for clothing. As discussed in the priority section, Mr. Sacks testified that Opposer’s MONSTER-brand clothing is sold on its website, at “specialty motorcycle stores,” and from trailers at supercross or motocross events. Opposer has not shown that any of these venues constitute an ordinary trade channel for clothing.

Accordingly, the second *du Pont* factor, involving similarity of the goods, strongly support a finding of likely confusion. As to the third *du Pont* factor, involving the trade channels in which the goods travel, the legal presumptions support a finding of likely confusion with respect to Opposer's registered marks, but not with respect to its common law MONSTER mark clothing.

The fourth *du Pont* factor, involving the conditions under which and buyers to whom sales are made (i.e., "impulse" vs. careful, sophisticated purchasing), this slightly favors a likelihood of confusion because many of the apparel items identified could include relatively inexpensive items, *e.g.*, t-shirts.



B. Fame of Opposer's Marks

We now turn to the likelihood of confusion factor involving the alleged fame of Opposer's marks. When a prior user's mark is found to be famous, this plays a significant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises as long as a "significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed Cir. 2005). This type of fame may be measured indirectly by the volume of sales

and advertising expenditures of the goods or services marketed 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 products identified by the marks; and the general reputation of the products and services. *Bose Corp.*, 63 USPQ2d at 1308.

The fact that a mark is famous for likelihood of confusion purposes in one field of goods or services does not mean that the fame extends to all other markets. *See, e.g., Inter IKEA Systems B.V. v. AKEA, LLC*, 110 USPQ 2d1734 (TTAB 2014) (opposer's IKEA mark was famous for purposes of likelihood of confusion for its "retail store services in the field of furniture, housewares, and home furnishings," but not for other goods or restaurant services) and *Harley-Davidson Motor Company v. Pierce Foods Corp.*, 231 USPQ 859 (TTAB 1986) (HARLEY-DAVIDSON and HARLEY deemed famous marks in field of motorcycles and accessories but not necessarily for other collateral goods sold largely through Harley-Davidson's licensees); *see also, Tuxedo Monopoly v. General Mills Fun Group*, 209 USPQ 986 (CCPA 1981) (MONOPOLY mark is famous but "[w]hen a famous mark, as applied to certain goods or services, is not a coined term but has other common meanings, the strength of that mark is diluted in relation to other goods or services, citing to *American Can Co. v. Dixie Wax Paper Co.*, 160 USPQ 721 (1969) (fact that "DIXIE" was famous for paper cups did not support cancellation of and opposition to registration of "DIXIE" as part of a composite mark for waxed paper).

On the record before us in these consolidated proceedings, we find that Opposer's


marks,  or  or MONSTER have received significant public exposure, mainly in connection with energy drinks, and it has sold a substantial number of articles of clothing in the last ten years, but none of these marks is famous for clothing. Although Opposer has presented very impressive evidence regarding its sales, advertising, and market share for its energy drink products and its placement of these marks on the energy drink products, the record is either lacking or ambiguous when it comes to Opposer's promotion of its marks as a source for apparel.

Opposer's witness, Mr. Sacks, testified that Opposer has sold many articles of clothing since 2002, with over 675,000 "items of clothing sold and distributed to consumers in the US" for the years 2011-2013.⁴⁵ In addition, Opposer licenses use of its marks on apparel and has entered into numerous co-branding arrangements with various other companies, including clothing manufacturers.

It remains unclear what advertising expenditures Opposer has incurred in its promotion of its apparel. Although Mr. Sacks testified that since 2002 Opposer spent "over \$2.7 billion in promoting our Monster brand and the Monster and claw icon and 'Unleash the Beast' marks" and that "in 2011 alone we spent over \$200 million in advertising and promoting the Monster brand;" he does not delineate what portion,

⁴⁵ 45 TTABVUE (designated "Confidential," however, Opposer quoted from the same deposition in its trial brief which was not designated "confidential"); Sacks dep. 115:17-18.

if any, of these expenses were allocated to promoting its apparel. Based on other information, it is evident that the emphasis of Opposer's business is on its energy drinks. As Applicant pointed out in its brief, Mr. Sacks was unable to state why the sale of clothing is not mentioned in Opposer's company's annual reports for the years 2004-2014. Mr. Sacks acknowledged that clothing is not Opposer's "primary focus" and that energy drinks represented approximately 91-92% of Opposer's net sales.⁴⁶ Indeed, the articles and other materials that make reference to Opposer reveal that Opposer is generally known to be in the energy drink business with little, if any, mention of Opposer as a source for apparel.


Further, we are not persuaded by Opposer's attempts to parlay its success in the field of energy drinks to demonstrate that its marks are famous in the apparel field. Opposer states that it "sells more than one billion cans [of the energy drink] annually in the U.S., each of which prominently displays the MONSTER and  Marks, and reference Opposer's website monsterenergy.com where Opposer's clothing items are promoted and/or sold."⁴⁷ However, this connection is too tangential for purposes of showing that the marks, even if famous for energy drinks, are famous for clothing. *Cf. In re Paramount Pictures Corporation*, 213 USPQ 1111, 1112 (TTAB 1982) (appearance of marks on t-shirts "tells the purchasing public ... not the source of

⁴⁶ *Id.* at 160:17 and 159:17.

⁴⁷ 58 TTABVUE 20, Opposer's brief at p. 19.

manufacture but the secondary source” of the goods). Simply put, it has not been shown how the largescale sale of energy drinks correlates to increased consumer exposure to Opposer’s apparel.⁴⁸ While it is certainly possible for marks to be famous for more than one type of goods and/or services, this is not the case here.

In sum, there is insufficient evidence showing the amount of sales, advertising and publicity of Opposer’s marks *in connection with apparel* necessary for us to conclude that these marks have become famous for clothing. While there is no question that we could find on this record that Opposer’s marks are famous in the field of energy drinks for purposes of a likelihood of confusion and Opposer has been successful in the sale of its clothing products, the fame of Opposer’s marks for energy

⁴⁸ Opposer also references a survey in its brief that purportedly “establishes that two out of three consumers shown a t-shirt bearing the  Mark associate the t-shirt with Opposer or an anonymous single source.” *Id.* Opposer references Sacks dep. Ex. 27 (designated “confidential”) comprising a declaration of Gerald L. Ford identified as a partner in a marketing research and consulting firm. The declaration has a caption identifying a Federal district court proceeding involving Opposer and a third, unrelated party. A declaration cannot be submitted in lieu of a testimony deposition absent a stipulation of the parties. *See* TBMP § 703.01(b); *Tri-Star Marketing LLC v. Nino Franco Spumanti SRL*, 84 USPQ2d 1912, 1914 (TTAB 2007). Opposer and Applicant did not stipulate to the introduction of this declaration as a substitute for testimony; indeed, in an interlocutory order, the Board informed the parties that Opposer was precluded from providing any expert witness testimony, including that from Mr. Ford. *See* 32 TTABVUE. While the attached survey itself remains part of the record, all statements and conclusions therein are hearsay inasmuch as Mr. Sacks did not testify that he had personal knowledge of the manner in which the survey was conducted or its conclusions. Rather, Mr. Sacks testified that Opposer commissioned the survey and merely repeated conclusions made in the survey. Applicant objected to the extent that Mr. Sacks “trying to testify as to the truth of the matter.” [something is missing in prior sentence] 48 TTABVUE, Sacks dep. 117:9. To be clear, Applicant’s objection is sustained and statements, including any conclusions, made in the survey constitute impermissible hearsay and cannot be relied upon for their truth.

drinks does not transfer to clothing. Of course, the fame for the energy drinks provides Opposer with a wide scope of protection and the question remains whether Applicant's marks used in connection with clothing fall within that zone of protection.

C. Alleged Weakness of the Term MONSTER and the Letter M for Clothing

We now address Applicant's argument that there are "thousands of similar marks in use on similar goods" and that Opposer's marks should thus not be given such a broad scope of protection to prohibit registration of the applied-for marks.⁴⁹ In essence, Applicant raises the sixth *du Pont* factor which contemplates weakness in terms based on consumers having been exposed to a significant amount of third-party use of the same or similar term for the same or similar goods.

In support of his argument, Applicant introduced copies of approximately seventy (70) third-party registrations for marks containing the term MONSTER and one hundred and four (104) third-party registrations for marks featuring the letter M.⁵⁰

Of the 70 registrations in the record containing the term MONSTER, we note the following:

MONSTER (Reg. No. 2627042) for "clothing, namely, sweatshirts, T-shirts, jackets, and caps" in International Class 25;⁵¹

MONSTER (Reg. No. 2454334) for "leather jackets, pants, shirts, clothing belts, blouses, sweaters and scarves, all for motorcyclists" in International Class 25;⁵²

⁴⁹ 60 TTABVUE 24, Applicant's Brief p. 23.

⁵⁰ 40 TTABVUE, Applicant's Second Notice of Reliance.

⁵¹ Issued on October 1, 2002, renewed.

⁵² Issued on May 29, 2001, renewed.

MONSTER HIGH (Reg. No. 4523454) for “ponchos, bandanas, mittens and gloves, fitted decorative covers for boots, shrugs, leg warmers, arm warmers, tops, bottoms, headwear and footwear” in International Class 25;⁵³

MONSTERWOOD (Reg. No. 4318807) for “clothing, namely, t-shirts” in International Class 25;⁵⁴

MONSTER CAMO (Reg. No. 4280202) for “clothing products, namely, shirts, shorts, coats, pants, footwear, hats, caps, gloves, coats, jackets; sportswear, namely, shirts, shorts, coats, pants, footwear, hats, caps, gloves, coats, jackets; motorsports related clothing, namely, shirts, shorts, coats, pants, footwear, hats, caps, gloves, coats, jackets” in International Class 25;⁵⁵

NATURAL MONSTER (stylized with design) (Reg. No. 4050563) for “clothing, namely, natural athletic sportswear, namely, t-shirts, tank tops, shirts, hats, caps, beanies, pants, sweatpants, shorts, jerseys, and underwear” in International Class 25;⁵⁶

MONSTER SHARK (Reg. No. 3087798) for “baseball caps, t-shirts” in International Class 25;⁵⁷

GREEN MONSTER (Reg. No. 3620971) for “clothing, namely, caps, hats, shirts, T-shirts, sweatshirts” in International Class 25;⁵⁸

MONSTER REPUBLIC (Reg. No. 3357957) for “children’s pants; children’s shirts” in International Class 25;⁵⁹ and

MONSTER ATTITUDE (Reg. 2812869) for “clothing, namely, t-shirts” in International Class 25.⁶⁰

⁵³ Issued on April 29, 2014.

⁵⁴ Issued on April 9, 2013.

⁵⁵ Issued on January 22, 2013.

⁵⁶ Issued on November 1, 2011.

⁵⁷ Issued on May 2, 2006.

⁵⁸ Issued on May 12, 2009.

⁵⁹ Issued on December 18, 2007.

⁶⁰ Issued on February 10, 2004, renewed.

Applicant also submitted Internet printouts advertising twenty-three (23) various articles of clothing for sale, each showing the term MONSTER being used on or in connection with the apparel. These include:



and

61

⁶¹ 55 TTABVue 112 (Opposer's Revised First Notice of Reliance). We note that this same mark, GREEN MONSTER, is the subject of Reg. No. 3620971, listed above, and owned by the Boston Red Sox Baseball Club, LP.



62

As discussed below, there are some limitations to the evidence submitted by Applicant to show that MONSTER and the letter M have been used by third parties in marks for clothing. As Opposer pointed out in its brief and the Board has long held, third-party registrations are not evidence that the registered marks are actually being used by the registrants or that consumers have even been exposed to these marks. *See, e.g., Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 n.10 (TTAB 2014) (“As we have often stated, because third-party registrations of marks are not evidence that the registered marks are in use, they are of limited probative value for demonstrating weakness of the marks.”). With respect to the Internet printouts showing use of the term MONSTER on or in connection with apparel, this type of evidence does not indicate or allow the Board to gauge their

⁶² *Id.* at 136.

exposure to the consuming public or how many sales, if any, have been made for the advertised apparel.

Nevertheless, third-party registrations may play a role in determining weakness when combined with evidence of third-party use. Our primary reviewing court, the Court of Appeals for the Federal Circuit has recently held, on two separate occasions, that “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015) (cert. denied January 25, 2016) citing to its earlier decision in *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).



The record created in these consolidated proceedings is unlike the records in *Juice Generation* and *Jack Wolfskin*. The Internet evidence showing actual third-party use of marks containing the term MONSTER on clothing can hardly be characterized as “extensive,” and there is none for the letter M on clothing. Rather, as described above, we have a very significant number of third-party registrations for both marks containing the term MONSTER, as well as marks featuring the letter M, and a fair amount of Internet evidence showing the term MONSTER being used on or in connection with the apparel, some of which may be solely ornamental in nature.



With the above in mind and in the context of the sixth *du Pont* factor, we find the term MONSTER is somewhat weak for clothing. However, we do not find the letter M is weak for marks used in the field of clothing. Accordingly, with respect to the

shared term MONSTER, the factor weighs slightly against finding a likelihood of confusion With respect to the letter M, the factor is neutral.

D. Similarity of the Marks

We now consider the similarity or dissimilarity of the marks at issue in terms of appearance, sound, meaning, and overall commercial impression. *Palm Bay Imports Inc.*, 73 USPQ2d at 1692.

Here, we make two comparisons. First, we focus on Opposer's  vis-à-vis Applicant's  mark. Second, we compare Opposer's common law mark, MONSTER, with Applicant's MONSTERFISHKEEPERS. Although Opposer has rights in other marks, we have chosen these two because they are the most similar to Applicant's marks. If we find that there is a likelihood of confusion with these pleaded marks, there is no need for us to consider a likelihood of confusion with the other pleaded marks. Conversely, if we find there is no likelihood of confusion with these pleaded marks, we would find no likelihood of confusion with the other pleaded marks as they incorporate matter that makes them less similar. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

(i) Opposer's  mark v. Applicant's  mark

With regard to these two stylized letter M marks, Opposer argues there is a strong similarity in appearance because the letter M in both marks is “rounded with pointed

edges and the middle line of [the letter] is longer than the first and last line.”⁶³ In addition, Opposer asserts both marks have “an aggressive, edgy appearance” and that consumers are likely to believe that Applicant’s mark is a “slightly revised way” of presenting Opposer’s mark or that Opposer is “engaged in co-branding with Applicant.”⁶⁴ Opposer also argues that the two marks share a similar “monster-like creatures/supernatural beasts” commercial impression based on Opposer’s “claw-like scratch marks” and Applicant’s “devil-like horns” design elements.⁶⁵

Applicant, on the other hand, contends that his mark has a “smooth and rounded” appearance whereas Opposer’s mark is “sharp and jagged.”⁶⁶ Applicant further argues that the “forked devil tail” and “devil horns” in its mark distinguishes it from Opposer’s “three claw marks” design.⁶⁷

Here, we find the two marks are overall quite similar. In essence, both are stylized versions of the same letter, M, a factor that contributes largely to their commercial impressions. We cannot assume that the parties’ use of their marks will necessarily be used in connection with other terms; however, to the extent that consumers understand this letter as an abbreviation, that perceived meaning could be the same, *e.g.*, if consumers believe the M is short for “monster.” Even if consumers believe the

⁶³ 58 TTABVUE 42, Opposer’s brief p. 33.



⁶⁴ *Id.*

⁶⁵ 58 TTABVUE 45-46, Opposer’s brief p. 36-37,

⁶⁶ 60 TTABVUE 16, Applicant’s brief p. 15.

⁶⁷ *Id.*

letter M is being used arbitrarily or as an unknown abbreviation, the similarity in the marks' commercial impressions remains.

The marks are visually similar as well inasmuch the middle line of the letter, in both Opposer's  and Applicant's  is extended or longer than the other two lines. The jagged points at the top of Opposer's mark also bear some similarity to the "devil horns" in Applicant's mark. We cannot and do not ignore the differences in the marks. We do not ignore the design elements in the marks unique to each mark, particularly Applicant's use of devil horns and tail and Opposer's mark appearing to be a three-pronged claw mark. However, we must further keep in mind that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Association of the United States Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

In sum, we find the marks are similar visually and in terms of their overall commercial impression, and this factor weighs in favor of finding a likelihood of confusion with respect to these marks.

(ii) *Opposer's MONSTER (in various fonts) mark v. Applicant's MONSTERFISHKEEPERS mark*

We now consider Opposer's MONSTER mark with Applicant's MONSTERFISHKEEPERS mark, in standard character form.

Here, the obvious similarity is that Applicant's mark comprises, in part, Opposer's MONSTER mark and we frequently have held that the mere addition of a term(s) to a previously-adopted trademark may not be sufficient to obviate a likelihood of consumer confusion. *See, e.g., In re Chatam Int-'l Inc., 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER); Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY and LILLI ANN).*

On the other hand, the additional matter in Applicant's mark plays a significant role in helping to create a commercial impression that is quite different from Opposer's mark, MONSTER. That is, consumers encountering Applicant's mark will quickly discern the three recognizable words, MONSTER and FISH and KEEPERS. Applicant introduced evidence showing that the first two terms or "monster fish" may be used to describe an extremely large fish kept as a pet or a gigantic fish that might be described fantastically as a "monster." This evidence includes the following excerpts from Internet printouts of articles, advertisements for a television program titled "Monster Fish" advertisements, etc.:



Keeping Monster Fish

Online Aquarium Fish Magazine | Keeping Monster Fish



The aim of this article is to discuss the basic setup and maintenance of Monster fish, those that get over a foot in length (often, much more than two feet) and usually have a high protein diet, requiring more filtration and care than a normal freshwater tank setup.

68

and

Go Fishin' for the Summer with a New Season of 'Monster Fish' Premiering July 7 on Nat Geo WILD

Categories Network TV Press Releases

Written By Amanda Kondolojy
June 17th, 2014

1 4
Like



via press release

NAT GEO WILD'S GONE FISHIN' FOR THE SUMMER WITH A NEW SEASON

OF MONSTER FISH

69

⁶⁸ 55 TTABVUE 7 (Opposer's Revised First Notice of Reliance); printout from website www.fishlore.com;

⁶⁹ *Id.* at 13 (Opposer's Revised First Notice of Reliance); printout from website www.tvbythenumbers.zap2it.com.

Another excerpt from the same “Monster Fish” television program printout (above) reveals that “monster fish” is a term that can be used to describe an extremely large fish:⁷⁰

For the past four seasons, fish biologist and National Geographic Fellow Dr. Zeb Hogan has traveled the globe in search of the planet’s largest, weirdest and most dangerous freshwater fish. He’s reeled in cow-sized goldfish and wrestled a car-sized stingray. Now in the fifth season of Monster Fish ... he’ll “tackle” a whole new mission traveling ... in search of elusive freshwater megafish. ... Zeb is on the hunt for monster fish so obscure they’ve seldom been seen in the wild.

Another printout from a different website advertises the “monster fish” that may be found at certain fishing resorts:

The Most Sought-After Monster Fish In The World.



The top six take monsters are

- Arapaima (500 lb)
- Chao Phraya catfish (130lb)
- Giant Freshwater stingray (200lb)
- Mekong catfish (300lb)
- Siamese carp (160lb)
- Wallago leeri (110lb)

With many other big fish species from around the world several of which are rapidly approaching 100lb

making Gillhams Fishing Resorts the number one freshwater fishing destination in the world

71.

This evidence, as well as other printouts, shows the term “monster” being used in connection with either large or dangerous fish, and we find consumers will understand Applicant’s mark, MONSTERFISHKEEPERS, as being suggestive of

⁷⁰ *Id.*

⁷¹ *Id.* at 18.

people who keep “monster-sized” fish. In the context of clothing, this meaning may be understood as arbitrary or clothing for large fish enthusiasts.

The word “monster” is defined in the dictionary as “a strange or horrible imaginary creature” or “something that is extremely or unusually large.”⁷² Thus, with respect to Opposer’s mark, the term MONSTER, by itself, will likely be understood based on the former meaning, *i.e.*, involving a creature, or even if one viewing Applicant’s mark believes it is referencing an “unusually large” object, that object remains unknown. In contrast and as the evidence bears out, because MONSTER precedes FISH and KEEPERS in Applicant’s mark, the entire mark will be understood as referencing an extremely large fish that is being kept. Moreover, the evidence shows consumers exposed to the term “Monster Fish” referencing a type of fish, which is quite distinct from the connotation or commercial impression of Opposer’s Monster mark.

With respect to the marks’ appearance and sound, they obviously bear some similarity due to the shared term MONSTER. However, they can be distinguished both visually and aurally based on the additional recognizable elements in Applicant’s mark, FISH and KEEPERS.

⁷² "Monster." *Merriam-Webster.com*. Merriam-Webster, n.d. Web. 12 Jan. 2016. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

In sum, we find the marks are different in appearance and sound and, most importantly, in their meanings. The similarity of the marks based on Applicant's incorporation of Opposer's mark is outweighed by the differences, especially the connotation of MONSTERFISHKEEPERS versus that of MONSTER. Accordingly, this factor weighs against finding a likelihood of confusion.

E. *du Pont* Factors Involving Instances of Actual Confusion and Bad Faith

In its brief, Opposer raises the *du Pont* factors involving instances of actual confusion and bad faith adoption of a mark. Specifically, Opposer argues that "despite little opportunity for actual confusion, such instances have occurred"⁷³ and that Applicant "intended to trade off Opposer's goodwill."⁷⁴ However, the evidence that Opposer relies upon in support of both claims is not persuasive.

The instances of "actual confusion" that Opposer references consist of Internet printouts from a Facebook page⁷⁵ and a forum website,⁷⁶ both associated with Applicant – the first printout containing a comment that Opposer actually "stole" its stylized M design from Applicant and the second containing a comment that "looking at the logo I have to agree it's infringing." These printouts, however, do not constitute evidence of actual consumer confusion. Rather, and putting aside their hearsay content, the comments made in the printouts are merely opinions regarding the origin

⁷³ 58 TTABVUE 50, Brief p. 41.

⁷⁴ *Id.* at 51, Brief p. 42.

⁷⁵ 37 TTABVUE 146.

⁷⁶ *Id.* at 158.

of Opposer's mark and whether Applicant's mark is "infringing." We do not view this as evidence that a consumer has confused the two marks based on their use in the marketplace. To the contrary, the evidence establishes that consumers do know the difference between the two marks.

As to Applicant's purported bad faith adoption of his marks, Opposer relies on Applicant's admissions he made, namely, that he conducted a search for previously registered marks covering goods only in International Class 38, and not Class 25 (the class for clothing), and that he was aware of Opposer's marks before he adopted his marks. Opposer also references Applicant's use of phrases such as "Unleash your inner monster" and "Monster unleashed" and that this is similar to Opposer's use of "Unleash the Beast" in connection with its marks. According to Opposer, "[i]t is simply not plausible that Applicant 'accidentally' used Opposer's famous 'M' mark, and Opposer's famous 'MONSTER' mark and Opposer's famous 'UNLEASH ...' mark" and that the only reason for doing so "would be to further solidify a misleading association with Opposer."⁷⁷

Although Applicant's use of a slogan that is arguably similar to Opposer's use of "Unleash the Beast" does give us pause, Opposer's evidence falls short of establishing that Applicant acted in bad faith in adopting his marks. *Cf. L.C. Licensing Inc. v. Berman*, 86 USPQ2d 183, 1891 (TTAB 2008). In particular, it is not disputed that



⁷⁷ 58 TTABVUE 52-53, Brief pp. 43-44.

Applicant is involved with an organization catering to fish hobbyists and, as previously discussed, large fish may be referred to as “monster fish.” It does not seem extraordinary or implausible that a person involved in this type of business would seek to register marks containing the term MONSTER. Finally, Applicant’s failure to search the mark in the class for clothing goods prior to filing his application does not establish bad faith.

Accordingly, the factors involving any instances of actual confusion and bad faith adoption remain neutral.

F. Likelihood of Confusion -- Conclusion

Considering all of the evidence of record as it pertains to the *du Pont* factors, we make the following conclusions.


We find that there is a likelihood of confusion between Opposer’s  mark and Applicant’s  mark, given that the marks are similar, both in appearance and commercial impressions, and both being used on some of the same clothing goods, and being sold in the same trade channels. We further note that, on this record, we cannot find that there is any commercial weakness in the use of a stylized letter M on clothing.


We do not, however, find that there is a likelihood of confusion between Opposer’s MONSTER mark and Applicant’s MONSTERFISHKEEPERS mark. We make this finding keeping in mind that Applicant’s mark incorporates Opposer’s mark and they are being used on the same clothing goods and sold in the same trade channels. The

term “monster” has a demonstrated weakness in connection with clothing and, ultimately, Applicant’s mark, viewed and understood in its entirety, engenders such a different commercial impression from Opposer’s mark that confusion is not likely. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).


As previously mentioned, we do not discuss or make additional conclusions as to Opposer’s other marks because, in our view, the aforementioned marks were closest to Applicant’s marks and stood the best chance as serving as a basis for finding a likelihood of confusion. Moreover, even if we considered the MONSTER marks for energy drinks to be famous, the scope of protection engendered by the fame of these marks does not extend to Applicant’s mark MONSTERFISHKEEPERS for use on clothing.

VI. Dilution By Blurring

We now consider Opposer’s assertion that its “MONSTER and  Marks” marks are famous for purposes of protection against dilution by blurring, under 15 U.S.C. § 1125(c), and that Applicant’s mark MONSTERFISHKEEPERS should be barred from registration because it blurs the distinctiveness of Opposer’s marks.⁷⁸

⁷⁸ In view of our decision finding a likelihood of confusion with respect Applicant’s  mark, it is not necessary for us to consider Opposer’s dilution claim against this mark. Rather, our consideration of the dilution claim is limited to Applicant’s MONSTERFISHKEEPERS mark.

As an initial matter with respect to Opposer's dilution claim, we point out that Opposer, in its brief, vaguely and repeatedly refers to the marks it believes are

famous as the "MONSTER and  Marks." This same reference is used by Opposer in its brief to mean all of its pleaded marks. In other words, Opposer does not assert any one specific mark as the basis for the dilution claim. In view of this blanket assertion and because we are only considering the dilution claim only with respect to Applicant's MONSTERFISHKEEPERS mark, we have narrowed our consideration of the dilution claim to Opposer's marks that we believe stand the best chance of serving as a basis for its dilution claim. Specifically, we can disregard Opposer's stylized M-formative marks and focus our attention on Opposer's MONSTER-formative marks, particularly its common law MONSTER mark and registered MONSTER ENERGY Mark. In other words, if we do not find that MONSTERFISHKEEPERS dilutes either of these two marks, we would not find that it dilutes the other marks owned by Opposer.

The Trademark Act provides a cause of action for the dilution of famous marks. *See* Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063 and 1125(c). Section 43(c) provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name

in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Dilution by blurring is further described as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” Section 43(c)(2)(B).

Our primary reviewing court, the Court of Appeals for the Federal Circuit, has set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring:

- (1) the plaintiff owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
- (3) the defendant's use of its mark began after the plaintiff's mark became famous; and
- (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

Coach Servs. Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012).

A. The Alleged Fame of Opposer's Marks Prior to 2010


Applying the first and third *Coach* elements to this proceeding, Opposer must show that the marks MONSTER and MONSTER ENERGY became famous before 2010, the date that Opposer concedes Applicant began use of MONSTERFISHKEEPERS.

Although we have already discussed the purported fame of Opposer's marks in the context of a likelihood of confusion factor, it is well-established that dilution fame is different and the burden of proof is significantly more difficult. *Coach Services, Inc.*, 101 USPQ2d 1713 ("Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing.") Indeed, "[i]t is well-established that dilution fame is difficult to prove." *Id.* at 1724. Also, in contrast to likelihood of confusion fame, dilution fame is not determined in the context of a certain field of goods or services; rather, the party asserting dilution fame of its mark "must show that, when the general public encounters the mark 'in almost any context, it associates the term, at least initially, with the mark's owner." *Id.* at 1725. In other words, a famous mark is one that has become a "household name." *Id.*

The statute sets forth the following four factors for determining whether a mark is famous for dilution purposes:

- i. The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- ii. The amount, volume, and geographic extent of sales of goods or services offered under the mark;
- iii. The extent of actual recognition of the mark; and
- iv. Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A). *See also, New York Yankees Partnership v. IET Products and Services, Inc.*, 114 USPQ2d 1497, 1502 (TTAB 2015); *McDonald's Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1286 (TTAB 2014).

With respect to the first factor, Opposer has first used the MONSTER and MONSTER ENERGY marks in 2002. These marks have received considerable public exposure through Opposer's advertising and mentions in national media. Opposer has spent \$2.7 billion on advertising since then, including the placement of the marks MONSTER, , and UNLEASH THE BEAST on the "Monster Monorail Train" (a train providing service to casinos in Las Vegas), sponsoring famous athletes and sports events, co-branding with other entities such as Kawasaki, and promoting music events.⁷⁹ In addition, Opposer has been recognized for its success in national media, including: listed in Forbes Magazine's "100 fastest growing companies" for years 2005-2008 (listed second for 2006-2007);⁸⁰ Beverage World's Company of the Year (2004);⁸¹ and 2006 Newsweek, online and in print, article about Opposer and Mr. Sacks' business partner.⁸² Opposer's website and Facebook page have also attracted considerable attention -- the former had 1.7 million unique visitors in 2008⁸³ and the latter had 24 million "fans" in July 2014.⁸⁴

With respect to factor two, Opposer's gross sales were \$ 6 million in 2002, grew to \$35 million in 2003, grew to nearly \$ 1 billion in 2008, grew to over \$ 1 billion in 2009

⁷⁹ 45 TTABVUE, Sacks 79:3-10.

⁸⁰ 45 TTABVUE, Sacks 119:12-15.

⁸¹ Sacks dep., Ex. 16.

⁸² *Id.* 97:5-9.

⁸³ *Id.* 103:2-5.

⁸⁴ *Id.* 106:3-6.

and to over \$ 2 billion in 2013.⁸⁵ Opposer is now the leader in sales and units sold for energy drinks, holding nearly 35% of the market, with the products being sold in all major trade channels, including “grocery, drugstores, mass merchandisers, dollar stores and ... Wal-Mart.”⁸⁶ For each dollar sale, Mr. Sacks testified that this roughly translates to a can of energy drink being sold.

As to the third factor, Opposer did not introduce any direct evidence regarding actual recognition of the mark.

Finally, with respect to the fourth factor and as discussed *infra*, Opposer is the owner of several registrations on the Principal Register, including several for the mark MONSTER ENERGY; however, Opposer does not own a registration for the mark MONSTER.

Upon consideration of the four factors and the record before us, we do not find that MONSTER or MONSTER ENERGY became a famous mark for dilution purposes prior to 2010. The evidence certainly shows that Opposer’s business grew significantly during the eight years 2002-2010 and Opposer’s advertisement of the marks on the monorail train in Las Vegas certainly created a great deal of publicity for Opposer, however, we do not believe that this made either of the two marks ‘household names’ by 2010. Rather, as Opposer’s principal seems to acknowledge, Opposer is attempting to branch out but the traditional primary market for its energy

⁸⁵ Id. 29:14-22, Ex. 5.

⁸⁶ Id. 32:5-11.

drinks is male “18- to 34-year-olds.”⁸⁷ Thus, even if Opposer sold an extensive number of energy drinks and advertised heavily for the years 2002 to 2010, the sales and marketing were primarily made with this demographic in mind and not the general population. As a result, and without strong direct evidence showing actual recognition of the mark in the general public, we do not find that a person who encountered either MONSTER or MONSTER ENERGY in 2010 in ‘almost any context’ would normally have associated either term, ‘at least initially,’ with the Opposer. *Coach*, 101 USPQ2d at 1725.

B. Likelihood of Applicant’s Mark MONSTERFISHKEEPERS to Cause Dilution by Blurring

Even if we were to find that Opposer’s marks, MONSTER and MONSTER ENERGY, were famous prior to 2010, Opposer’s dilution claim would fail because the fourth element has not been satisfied. Specifically, it has not been shown that Applicant’s mark, MONSTERFISHKEEPERS is likely to dilute either of Opposer’s two marks.

The Trademark Act enumerates six non-exhaustive factors a tribunal may consider in determining whether a mark is likely to cause dilution by blurring:

- i. The degree of similarity between the mark or trade name and the famous mark.
- ii. The degree of inherent or acquired distinctiveness of the famous mark.

⁸⁷ *Id.* 155:22-156:6.

- iii. The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- iv. The degree of recognition of the famous mark.
- v. Whether the user of the mark or trade name intended to create an association with the famous mark.
- vi. Any actual association between the mark or trade name and the famous mark.

Section 43(c)(B)(i)-(vi).

In applying and weighing these factors, it is unlikely that Applicant's MONSTERFISHKEEPERS will cause dilution by blurring of Opposer's marks. With regard to the first factor, there is little similarity between the mark MONSTER ENERGY and MONSTERFISHKEEPERS. While both marks share and begin with the term MONSTER, the addition of the term ENERGY, albeit a descriptive term, creates a mark that, as a whole, evokes a superhuman strength or "monster level energy." In contrast and as previously described in the likelihood of confusion section, Applicant's mark suggests a person that keeps a large "monster-size" fish or a fish that is large and is a "keeper."

Moreover, with respect to Opposer's rights in MONSTER, by itself, and taking into account the third factor above, the record shows that Opposer is not engaging in 'substantially exclusive' use of this term. Indeed, Opposer's own principal, Mr. Sacks, acknowledged that there is third-party use of the term MONSTER:⁸⁸

⁸⁸ *Id.* 201:10-12.

Q. Are you aware of other companies that use the word “monster” in their name?

A. Most – many cases, yes.

As described in the likelihood of confusion section, the record includes examples of other entities using the term MONSTER in various manners, including use on the apparel. Finally, the existence of 70 registrations for marks that contain the term MONSTER, at the very least, shows that many different third-party entities have sought to adopt marks with this same term. This is not surprising given that it is not an uncommon word and may be used in various contexts.

With respect to the fourth factor, we have no direct evidence, *e.g.*, a survey, showing a level of recognition of Opposer’s MONSTER or MONSTER ENERGY marks.⁸⁹ Opposer’s advertising and marketing efforts, while impressive, do not substitute nor do we make the presumption that they have resulted in a significant degree of recognition by the general public of these marks as uniquely pointing to Opposer in contexts other than the fields of goods for which Opposer’s marks are being used, primarily energy drinks.

With regard to the fifth factor involving an intention to create an association with the Opposer’s marks, there is little evidence to suggest that Applicant is intentionally attempting to associate his marks with Opposer’s marks. Although Applicant has


⁸⁹ Again, the survey introduced by Opposer as an exhibit to Mr. Sacks’ deposition cannot be relied upon for any of the survey’s statements or conclusions inasmuch as the Mr. Sacks did not conduct the survey nor did he have personal knowledge of the manner in which it was conducted.

acknowledged that he was aware of Opposer's marks and we appreciate the similarity of Applicant's use of a slogan "Unleash Your Inner Monster" with its marks to Opposer's use of "Unleash The Beast," this is not enough to prove intent.

Finally, as to the sixth factor and as already discussed, Opposer's assertion that there have been "instances of actual confusion," are not supported by the record.⁹⁰

C. Dilution by Blurring -- Conclusion

Opposer has not demonstrated, as a threshold matter, that either of its marks, MONSTER or MONSTER ENERGY, acquired the degree of fame needed for dilution purposes prior to 2010. Moreover, even if we were to find that one of these marks became famous by that date, Applicant's mark, MONSTERFISHKEEPERS, is not likely to cause dilution by blurring to either of the two marks.

Decision: Opposition No. 91205924, involving Applicant's  mark, is sustained on the likelihood of confusion ground. Application Serial No. 85508374 will be abandoned in due course.

Opposition No. 91205893, involving Applicant's MONSTERFISHKEEPERS mark, is dismissed on both the likelihood of confusion and dilution by blurring grounds. Application Serial No. 85518033 will be forwarded to registration.

⁹⁰ In its brief, Opposer only references that that "there have been instances of actual confusion," in arguing this factor. We assume Opposer is referencing the same instances that it argued in support of the likelihood of confusion ground and have been discussed *infra*.