

This Opinion Is Not a
Precedent of the TTAB

Mailed: October 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Monster Energy Company
v.
Cavaliers Hockey Holdings, LLC
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Opposition No. 91240680
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Clayton R. Henson, Hans L. Mayer, Baraa Kahf, and Steven J. Nataupsky of Knobbe, Martens, Olsen & Bear, LLP for Monster Energy Company.

Thomas M. Williams of Barack Ferrazzano Kirschbaum and Nagelberg LLP for Cavaliers Hockey Holdings, LLC.

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Before Bergsman, Greenbaum and Hudis, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Cavaliers Hockey Holdings, LLC (Applicant) filed eight intent-to-use applications under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), seeking registration on the Principal Register of the mark CLEVELAND MONSTERS and design, reproduced below:



The description of the mark in each application reads as follows:

Color is not claimed as a feature of the mark. The mark consists of the stylized word “CLEVELAND” above the stylized word “MONSTERS”. A stylized design of a monster consisting of the head of a monster and its eyes surrounded by ripples of water appears above and to the left of the word “CLEVELAND”.

Applicant disclaims the exclusive right to use the name “Cleveland.”

Applicant seeks to register its mark for the goods and services listed below:

1. “Costume jewelry; earrings; jewelry and imitation jewelry; pendants; rings; watches,” in International Class 14;¹
2. “Athletic pants; caps being headwear; coats; gloves; gym pants; hats; jackets; jogging pants; pants; polo shirts; scarves; shirts; sports pants; sports shirts; sweat pants; sweat shirts; t-shirts; tops as clothing; warm-up suits; wind resistant jackets,” in International Class 25;²
3. “Publications and printed matter, namely, stickers, decals, memo pads, note pads, ballpoint pens, pencils, paper banners and flags, stationery folders, wire-bound notebooks, portfolio notebooks, unmounted and mounted photographs, calendars, bumper stickers, statistical books, guide books, and reference books in the field of hockey; magazines in the field of hockey; catalogs featuring hockey; commemorative game and souvenir programs in the field of hockey; paper pennants, stationery and printed certificates in the field of hockey; entertainment printed certificates for fans; statistical information sheets for

¹ Serial No. 87546801 filed July 28, 2017.

² Serial No. 87547147 filed July 28, 2017.

hockey topics; newsletters, brochures, pamphlets and game schedules in the field of hockey; bank checks; credit cards not magnetically coded,” in International Class 16;³

4. “Toys, games and sporting goods, namely, hockey pucks and hockey sticks; hockey kits comprised of hockey pucks, hockey sticks and hockey goalie pads; bobblehead action figures; stuffed toys,” in International Class 28;⁴
5. “Computer programs for viewing statistics or trivia about hockey; computer software, namely, screen savers featuring hockey themes, computer software to access and view computer wallpaper, computer browsers, computer skins and computer cursors; computer game software; magnets; credit cards magnetically encoded; downloadable video-stream recordings in the field of hockey provided over the Internet; downloadable computer software for viewing databases of information, statistical information, trivia, polling information, and interactive polling in the field of hockey provided over the Internet; downloadable computer game software; downloadable interactive video games and trivia game software provided over the Internet; downloadable computer software for use as screensavers, wallpaper, browsers, skins and cursors over the Internet; downloadable electronic publications in

³ Serial No. 87547252 filed July 28, 2017.

⁴ Serial No. 87548887 filed July 31, 2017.

the nature of magazines, newsletters and game schedules all in the field of hockey provided over the Internet,” in International Class 9;⁵

6. “Computerized on-line retail store, ordering, retail store services, electronic retail store services and mail-order catalog services featuring an array of hockey-themed merchandise; promoting the goods and services of others by allowing sponsors to affiliate these goods and services with a hockey program; promoting the sale of goods and services of others through the distribution of promotional contests provided over the Internet; conducting public opinion poll surveys and public opinion poll surveys in the field of hockey for business and non-business and marketing and non-marketing purposes over the Internet; conducting interactive public opinion polls in the field of hockey,” in International Class 35;⁶

7. “Audio broadcasting; cable television broadcasting; radio broadcasting; subscription television broadcasting; television broadcasting; video broadcasting; webcasting services in the nature of providing on-line chat rooms and on-line interactive chat rooms with guests for transmission of messages among computer users concerning the field of hockey; broadcasting programs over the Internet; providing on-line electronic bulletin boards for transmission of messages among computer users concerning the field of hockey; providing

⁵ Serial No. 87548893 filed July 31, 2017.

⁶ Serial No. 87548901 filed July 31, 2017.

access to databases featuring interactive polling in the field of hockey,” in International Class 38;⁷ and

8. “Entertainment services, namely, sporting activities involving the performance by a hockey team in the nature of live performances by a hockey team; entertainment and educational services in the nature of on-going television and radio programs in the field of hockey and rendering live hockey games and hockey exhibitions; the production and distribution of radio and television broadcasts of hockey games, hockey events and programs in the field of hockey; conducting and arranging hockey clinics and coaches’ clinics and hockey events; entertainment services in the nature of personal appearances by a costumed mascot at hockey games and exhibitions, clinics, promotions, and other hockey-related events, special events and parties; fan-club services; entertainment services, namely, providing a website featuring the following content - non-downloadable videos in the field of television highlights, interactive television highlights, radio programs, radio highlights, and audio recordings in the field of hockey, and hockey news in the nature of information, statistics and trivia about hockey; on-line computer games; providing non-downloadable on-line magazines, newsletters, and game schedules in the field of hockey over the Internet,” in International Class 41.⁸

⁷ Serial No. 87548912 filed July 31, 2017.

⁸ Serial No. 87548930 filed July 31, 2017.

Monster Energy Company (Opposer) opposes registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles Opposer's MONSTER marks and MONSTER family of marks for, inter alia, energy drinks and clothing as to be likely to cause confusion, mistake or deception. Opposer pleaded its ownership of 23 registrations for MONSTER formative marks including, but not limited to, the registrations listed below:

1. MONSTER ENERGY, in standard character form, for the goods and services listed below:

- “Non-alcoholic beverages, namely, energy drinks, excluding perishable beverage products that contain fruit juice or soy,” in International Class 32;⁹
- “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;¹⁰ and

⁹ Registration No. 4036681 registered October 11, 2011; Sections 8 and 15 declarations accepted and acknowledged. Opposer disclaimed the exclusive right to use the word “Energy.”

¹⁰ Registration No. 3057061 registered February 7, 2006; renewed. Opposer disclaimed the exclusive right to use the word “Energy.”

The drawing of the mark in this registration is in typed drawing form. Effective November 2, 2003, the USPTO amended Trademark Rule 2.52, 37 C.F.R. § 2.52, to replace the term “typed” drawing with “standard character” drawing. A typed mark is the legal equivalent of a standard character mark. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”).

- “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,” in International Class 35;¹¹

2. M MONSTER ENERGY and design, reproduced below:



The description of the mark provides that “the mark consists of the stylized letter ‘M’ and stylized words ‘MONSTER ENERGY.’”

Opposer registered the mark for the goods listed below:

- “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;¹²

¹¹ Registration No. 4721433 registered April 14, 2015; Sections 8 and 15 declarations accepted and acknowledged.

¹² Registration No. 3134841 registered August 20, 2006; renewed. Opposer disclaimed the exclusive right to use the word “Energy.”

- “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;¹³

- “Stickers; sticker kits comprising stickers and decals; decals,” in International Class 16;¹⁴ and

- “Sports helmets,” in International Class 9;¹⁵ and

3. M MONSTER ENERGY and design reproduced below, for “silicone wrist bands; silicone bracelets; jewelry, namely, bracelets and wristbands,” in International Class 14.¹⁶



The description of the mark reads as follows:

Color is not claimed as a feature of the mark. The mark consists of a stylized letter “M” to the left of the stylized words “MONSTER ENERGY”.

¹³ Registration No. 3908601 registered January 18, 2011; renewed.


¹⁴ Registration No. 3908600 registered January 18, 2011; Sections 8 and 15 declarations accepted and acknowledged. Opposer filed a Section 9 renewal application on February 10, 2020.

¹⁵ Registration No. 3914828 registered February 1, 2011; renewed.

¹⁶ Registration No. 4332062 registered May 7, 2013; Sections 8 and 15 declarations accepted and acknowledged.

Opposer also pleaded it “uses or licenses the use of its MONSTER™ mark in connection with sports bags, sports helmets, gloves, sports equipment, stickers, decals, lanyard, and wristbands, among many other products.”¹⁷

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition. As its first affirmative defense, Applicant pleaded the prior registration defense based on its ownership of registrations for the marks listed below:¹⁸

Mark:	Reg. No.	Reg. Date	Goods/Services	Int'l Class
CLEVELAND MONSTERS	5,482,815	May 29, 2018	toys, games and sporting goods, namely, hockey pucks and hockey sticks; bobblehead action figures; stuffed toys	28
CLEVELAND MONSTERS	5,482,814	May 29, 2018	paper banners and flags, unmounted photographs, paper pennants, game schedules in the field of hockey	16
CLEVELAND MONSTERS	5,482,813	May 29, 2018	computerized on-line retail store, ordering, retail store services, electronic retail store services and mail-order catalog services featuring an array of hockey-themed merchandise	35
CLEVELAND MONSTERS	5,460,834	May 1, 2018	earrings; jewelry; jewelry and imitation jewelry; costume jewelry; rings	14
	3,890,431	Dec. 14, 2010	paper pennants	16
			T-shirts, shirts, polo shirts, sweatshirts, jerseys, hats, caps, jackets.	25
LAKE ERIE MONSTERS	3,897,555	Dec. 28, 2010	T-shirts, shirts, jerseys, hats, caps	25

¹⁷ Notice of Opposition ¶ 2 (1 TTABVUE 21).

¹⁸ Amended Answer to Opposer’s Notice of Opposition ¶¶39 (11 TTABVUE 27-28).

As its second affirmative defense, Applicant pleaded laches, estoppel, acquiescence, and waiver based on a “co-existence and cross-promotion of goods and services sold in connection with Applicant’s LAKE ERIE MONSTERS mark and Opposer’s MONSTER mark.”¹⁹

I. Evidentiary objections

Applicant lodged numerous objections to Opposer’s testimony and evidence. Administrative Trademark Judges preside over Board proceedings, not lay jurors who might be easily misled, confused, or prejudiced by flawed evidence. *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) (“In bench trials, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions.”). “Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this case, including any inherent limitations, which precludes the need to strike the challenged testimony and evidence if the objection is well-taken.” *Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017).

None of the evidence Applicant seeks to exclude is outcome determinative. Given this fact, coupled with the number of objections, we see no compelling reason to discuss any one or more of them specifically. Suffice it to say, we have considered all of the testimony and exhibits submitted. In doing so, we have kept in mind the various objections raised by Applicant and we have accorded whatever probative value the subject testimony and evidence merit. *See Luxco, Inc. v. Consejo Regulador*

¹⁹ Amended Answer to Opposer’s Notice of Opposition ¶¶40-42 (11 TTABVUE 28-29).

del Tequila, A.C., 121 USPQ2d 1477, 1479 (TTAB 2017). As necessary and appropriate, we address any limitations to the evidentiary material to our decision.

Id.

II. 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 subject applications. In addition, the parties introduced the evidence listed below:²⁰

A. Opposer's testimony and evidence.

1. Notice of reliance on Opposer's pleaded registrations printed from the USPTO Trademark Status and Document Retrieval (TSDR) system showing the current status to and title of the registrations;²¹
2. Notice of reliance on Applicant's responses to Opposer's first set of interrogatories;²²
3. Notice of reliance on Applicant's admissions to Opposer's first set of requests for admission;²³

²⁰ Citations to the record or briefs in this opinion also include citations to the publicly available documents on TTABVUE, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry.

²¹ 19 TTABVUE 16-145. Opposer did not introduce a copy of its pleaded registration No. 4721432 for the stylized letter "M" alone for "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," in International Class 35. Because this mark does not include the word "Monster," it is not relevant.

²² 19 TTABVUE 147-163.

²³ 19 TTABVUE 166-176. A party may introduce only an admission to a request for admission through a notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i). A denial or statement that the responding party cannot respond to the request does not establish the truth or falsity of the assertion, but rather leaves the matter for proof at trial. *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008) (denials to requests for admission inadmissible because "unlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth

4. Notice of reliance on Applicant's responses to Opposer's first set of requests for production of documents;²⁴
5. Notice of reliance on Applicant's initial disclosures;²⁵
6. Notice of reliance on Applicant's responses to Opposer's second set of interrogatories;²⁶
7. Notice of reliance on copies of Opposer's 10-K reports from 2002-printed from the website of the U.S. Securities and Exchange Commission;²⁷
8. Notice of reliance on copies of printed publications available to the general public in libraries and in general circulation among members of the public;²⁸
9. Notice of reliance on copies of documents available on the Internet;²⁹
10. Notice of reliance on portions of the discovery deposition of Mike Ostrowski, Applicant's President and designated Rule 30(b)(6) witness;³⁰

nor the falsity of the assertion, but rather leaves the matter for proof at trial.”). As such, we have considered only the admissions to the requests for admission.

²⁴ 19 TTABVUE 178-197. Responses to a request for production of documents introduced through a notice of reliance are admissible solely for purposes of showing that a party has stated that there are no responsive documents; documents produced in response to the requests are generally not admissible by notice of reliance alone. Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. § 2.120(j)(3)(ii); *see also City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance).

²⁵ 19 TTABVUE 199-202.

²⁶ 19 TTABVUE 204-210.

²⁷ 19 TTABVUE 212-466 and 20-22 TTABVUE.

²⁸ 23-24 TTABVUE.

²⁹ 25-32 TTABVUE.

³⁰ 33-41 TTABVUE. Opposer posted the portions of the Ostrowski discovery deposition designated confidential at 38-41 TTABVUE.

11. Testimony declaration of Rodney Sacks, Opposer's Chairman and Chief Executive Officer;³¹
12. Rebuttal notice of reliance on documents available on the Internet;³² and
13. Rebuttal testimony declaration of Rodney Sacks.³³

B. Applicant's testimony and evidence.

1. Testimony declaration of Mike Ostrowski;³⁴
2. Notice of reliance on copies of registrations consisting in part of the word "Monster" owned by Applicant;³⁵
3. Notice of reliance on copies of third-party registrations for marks consisting of the word "Monster";³⁶
4. Notice of reliance on official records consisting of the notices of opposition in two Board proceedings and the complaint in a civil action;³⁷
5. Notice of reliance on printed publications purportedly reporting on Opposer's overreach in asserting trademark rights in Opposer's MONSTER trademarks;³⁸
6. Notice of reliance on Opposer's admissions to Applicant's requests for admission;³⁹

³¹ 42-47 TTABVUE. Opposer posted the portions of the Sacks testimony declaration designated confidential at 48-54 TTABVUE.

³² 60-61 TTABVUE.

³³ 62 TTABVUE.

³⁴ 55 TTABVUE. Applicant posted the portions of the Ostrowski testimony declaration designated confidential as 56 TTABVUE.

³⁵ 57 TTABVUE 88-150.

³⁶ 57 TTABVUE 152-911 and 58 TTABVUE.

³⁷ 59 TTABVUE 3-409.

³⁸ 59 TTABVUE 411-442.

³⁹ 59 TTABVUE 444-453.

7. Notice of reliance on Opposer's supplemental response to Applicant's requests for admission Nos. 1-3;⁴⁰ and
8. Notice of reliance on Opposer's responses to Applicant's interrogatory Nos. 3, 9 and 10.⁴¹

III. Entitlement to a Statutory Cause of Action⁴²

To establish entitlement to a statutory cause of action under Sections 13 or 14 of the Trademark Act, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Opposer established its entitlement to a statutory cause of action by properly introducing into evidence its pleaded registrations showing the status of the registrations and their title in Opposer. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (plaintiff's two prior registrations suffice to establish plaintiff's direct commercial interest and its

⁴⁰ 59 TTABVUE 455-459.

⁴¹ 59 TTABVUE 461-468.

⁴² Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable.

standing); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant, in its brief, did not challenge Opposer's standing.

IV. Priority

Because Opposer's pleaded registrations are of record, and Applicant did not file a counterclaim to cancel the pleaded registrations, priority in the opposition proceeding is not at issue with respect to the marks and goods or services identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

Even though Opposer did not plead ownership of a registration for the mark MONSTER, Opposer alleged, "[s]ince at least 2002, long before the filing date of the Applications, Opposer has been, and still is, engaged in the development, marketing, and/or sale of energy drinks and clothing under the MONSTER™ mark" and promoting goods and services in the sports and music industries since 2003.⁴³ In its brief, Opposer argues that it has used MONSTER to identify its beverage product line and a wide range of other products and services, including sporting events.⁴⁴ However, in its brief, Opposer does not refer to any testimony or evidence regarding Opposer's use of MONSTER as a stand-alone mark for beverages, clothing, or sports promotion. Nevertheless, Rodney Sacks testified Opposer began using its MONSTER mark to identify beverages and apparel in 2002.⁴⁵

⁴³ Notice of Opposition ¶2 (1 TTABVUE 21).

⁴⁴ Opposer's Brief, p. 6 (64 TTABVUE 13).

⁴⁵ Sacks Testimony Decl. ¶3 (19 TTABVUE 3).

Sacks Exhibit 2 are copies of representative samples of Opposer's beverage products.⁴⁶ The word "Monster" always appears in the stylized format, reproduced below, in close connection with Opposer's "M" logo or the word "Energy." The display reproduced below is representative of the use of the mark displayed in Sacks' Exhibit 2.



Mr. Sacks testified,

9. Monster does not use the word "energy" immediately following MONSTER on all of its products. For example, the JAVA MONSTER®, CAFFE MONSTER®, ESPRESSO MONSTER®, MONSTER MAXX®, and MONSTER REHAB® products bear the MONSTER mark without the term "energy" immediately following "MONSTER."⁴⁷

⁴⁶ Sacks Testimony Decl. ¶8 and Exhibit 2 (42 TTABVUE 6 and 144-153).

⁴⁷ Sacks Testimony Decl. ¶10 (42 TTABVUE 6).

We cannot find any other evidence of MONSTER used as a stand-alone mark for any goods or services other than beverages. Accordingly, we find that Opposer has proved its use of MONSTER in a stylized form in connection with beverages since 2002.

The filing dates of Applicant's applications are July 28 and 31, 2017, respectively. Mike Ostrowski, Applicant's President, testified that Applicant first used its CLEVELAND MONSTERS and design mark on the goods in Classes 9, 14, 16, 25, and 28 and the services in Classes 35, 38, and 41 as of July 31, 2016.⁴⁸ Applicant first used the LAKE ERIE MONSTERS mark in Classes 16 and 25 as of January 25, 2007.⁴⁹

We find that Opposer has proven priority with respect to the marks and goods for Opposer's registrations introduced into the record and for the stand alone stylized MONSTER word mark for beverages.

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65

⁴⁸ Ostrowski Testimony Decl. ¶9 (55 TTABVUE 5-7).

⁴⁹ *Id.* at ¶9 (55 TTABVUE 7). Applicant's original name for the CLEVELAND MONSTERS hockey team was the LAKE ERIE MONSTERS. The team began playing in the American Hockey League (AHL) during the 2007-08 season. *Id.* at ¶14 (55 TTABVUE 8).

USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019), quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997), quoting *DuPont*, 177 USPQ at 567. “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018), quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). See also *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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 services] and differences in the marks.”). See also *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, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

- A. The strength of Opposer’s MONSTER marks, including the fame of Opposer’s mark and the number and nature of similar marks in use on similar goods and services.

Opposer alleges that its MONSTER marks have become famous⁵⁰ and argues, in its brief, that its marks are famous.⁵¹ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. 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 Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame, the fifth *DuPont* factor, enables Opposer to expand the scope of protection afforded its pleaded marks by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use).” Under the fifth factor, likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Fed. Cir. 2017). It “varies along a spectrum from very strong to very weak.” *Palm Bay Imps.*,

⁵⁰ Notice of Opposition ¶9 (1 TTABVUE 27).

⁵¹ Applicant’s Brief, p. 33 (64 TTABVUE 40).

Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

To determine a mark's place on the spectrum of from very strong to very weak, we consider its inherent or conceptual strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. 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."); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. 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); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. 2020) ("The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.").

We may measure commercial strength (or fame) indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified

by the mark, and general reputation of the goods or services. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

1. The inherent or conceptual strength of Opposer's MONSTER marks.

The RANDOM HOUSE UNABRIDGED DICTIONARY (2020) defines the word "Monster" as, inter alia,

noun

1. a legendary animal combining features of animal and human form or having the forms of various animals in combination, as a centaur, griffin, or sphinx.
2. any creature so ugly or monstrous as to frighten people.
3. any animal or human grotesquely deviating from the normal shape, behavior, or character.
4. a person who excites horror by wickedness, cruelty, etc.
5. any animal or thing huge in size.

adjective

8. huge; enormous; monstrous: a monster tree.⁵²

Based on the dictionary definitions alone, the word "Monster" appears to be an arbitrary term when used in connection with beverages, apparel, promoting goods and services in the sports, motorsports, electronic sports, and music industries, stickers, sticker kits comprising stickers and decals, decals, sports helmets, and

⁵² Dictionary.com accessed on August 31, 2020. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

jewelry.⁵³ However, the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567.

Although Applicant did not proffer evidence of third-party use of other MONSTER marks, it introduced copies of its own registrations for “Monster” marks and third-party registrations consisting of the word MONSTER. “[E]xtensive 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 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). Third-party registrations, in particular, are relevant to prove that some segment of a mark that both parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the segment is relatively weak. *Juice Generation*, 115 USPQ2d at 1675. *See also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”).⁵⁴

⁵³ *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as “a known word used in an unexpected or uncommon way” and observing that such marks are typically strong because they naturally serve to identify a particular source of a product or service).

⁵⁴ We do not consider Applicant’s registrations, nor the third-party registrations, to determine the commercial strength of Opposer’s MONSTER marks. Opposer’s Brief, p. 47 (64 TTABVUE 54) (arguing third-party registrations cannot establish commercial weakness).

We turn first to the 15 CLEVELAND MONSTER or LAKE ERIE MONSTER registrations owned by Applicant that are not subject to any petitions to cancel by Opposer or any other entity.⁵⁵

Class 9

Registration No. 5515631 for the mark CLEVELAND MONSTERS, in standard character form, for computer software, namely, screen savers featuring hockey themes; magnets; downloadable computer software for use as screensavers, wallpaper; downloadable electronic publications in the nature of game schedules in the field of hockey provided over the Internet.⁵⁶

Class 14

Registration No. 5460834 for the mark CLEVELAND MONSTERS, in standard character form, for earrings, jewelry, jewelry and imitation jewelry, costume jewelry, and rings.⁵⁷

Class 16

Registration No. 3890431 LAKE ERIE MONSTERS and design, reproduced below, for paper pennants;⁵⁸

⁵⁵ 57 TTABVUE 88-150.

⁵⁶ The description of goods covers the same goods as in Applicant's application Serial No. 87548893 involved in this opposition.

⁵⁷ The description of goods covers the same goods as in Applicant's application Serial No. 87546801 involved in this opposition.

⁵⁸ Paper pennants are part of the description of goods in Applicant's application Serial No. 87547252 involved in this opposition.



Registration No. 5482814 for the mark CLEVELAND MONSTERS, in standard character form, for paper banners and flags, unmounted photographs, paper pennants, game schedules in the field of hockey;⁵⁹ and

Registration No. 5795803 for the mark CLEVELAND MONSTERS, in standard character form, for publications and printed matter, namely, stickers, decals and bumper stickers in the field of hockey and paper pennants in the field of hockey.⁶⁰

Class 25⁶¹

Registration No. 3897555 LAKE ERIE MONSTERS, in standard character form, for t-shirts, shirts, jerseys, hats, and caps;

Registration No. 3890431 LAKE ERIE MONSTERS and Design, reproduced above, for t-shirts, shirts, polo shirts, sweatshirts, jerseys, hats, caps, and jackets;

Registration No. 5795810 for the mark CLEVELAND MONSTERS, in standard character form, for coats, wind-resistant jackets and wind jackets; and

⁵⁹ Paper banners and flags, unmounted photographs, paper pennants, game schedules in the field of hockey are part of the description of goods in Applicant's application Serial No. 87547252 involved in this opposition.

⁶⁰ Publications and printed matter, namely, stickers, decals and bumper stickers in the field of hockey and paper pennants in the field of hockey are part of the description of goods in Applicant's application Serial No. 87547252 involved in this opposition.

⁶¹ The description of goods in these registrations encompass the description of goods in Applicant's application Serial No. 87547147 involved in this opposition.

Registration No. 5950480 for the mark CLEVELAND MONSTERS, in standard character form, for gloves and scarves.

Class 28

Registration No. 5482815 for the mark CLEVELAND MONSTERS, in standard character form, for toys, games and sporting goods, namely, hockey pucks and hockey sticks; bobblehead action figures; stuffed toys.⁶²

Class 35⁶³

Registration No. 5482813 for the mark CLEVELAND MONSTERS, in standard character form, for computerized on-line retail store, ordering, retail store services, electronic retail store services and mail-order catalog services featuring an array of hockey-themed merchandise; and

Registration No. 5950481 for the mark CLEVELAND MONSTERS, in standard character form, for promoting the goods and services of others by allowing sponsors to affiliate these goods and services with a hockey program; promoting the sale of goods and services of others through the distribution of promotional contests provided over the Internet; conducting public opinion poll surveys and public opinion poll surveys in the field of hockey for business and non-business and marketing and non-marketing purposes over the Internet; conducting interactive public opinion polls in the field of hockey.

⁶² This description of goods is the same as the description of goods in Applicant's application Serial No. 87548887 involved in this opposition.

⁶³ The description of goods in these registrations encompass the description of goods in Applicant's application Serial No. 87548901 involved in this opposition.

Class 38

Registration No. 5944445 for the mark CLEVELAND MONSTERS, in standard character form, for webcasting services in the nature of providing on-line chat rooms and on-line interactive chat rooms with guests for transmission of messages among computer users concerning the field of hockey; broadcasting programs over the Internet; providing on-line electronic bulletin boards for transmission of messages among computer users concerning the field of hockey; providing access to databases featuring interactive polling in the field of hockey.⁶⁴

Class 41⁶⁵

Registration No. 5515632 for the mark CLEVELAND MONSTERS, in standard character form, for entertainment services, namely, sporting activities involving the performance by a hockey team in the nature of live performances by a hockey team; entertainment and educational services in the nature of on-going television and radio programs in the field of hockey and rendering live hockey games and hockey exhibitions; the production and distribution of radio and television broadcasts of hockey games, hockey events and programs in the field of hockey; conducting and arranging hockey clinics and coaches' clinics and hockey events; fan-club services; entertainment services, namely, providing a website featuring the following content - non-downloadable videos in the field of television highlights, interactive television

⁶⁴ The description of services in Applicant's application Serial No. 87548912 involved in this opposition encompasses the description of services in this registration.

⁶⁵ The description of goods in these registrations encompass the description of goods in Applicant's application Serial No. 87548930 involved in this opposition.

highlights, radio programs, radio highlights, and audio recordings in the field of hockey, and hockey news in the nature of information, statistics and trivia about hockey; providing non-downloadable on-line game schedules in the field of hockey over the Internet; and

Registration No. 5950479 for the mark CLEVELAND MONSTERS, in standard character form, for entertainment services in the nature of personal appearances by a costumed mascot at hockey games and exhibitions, clinics, promotions, and other hockey-related events, special events and parties; providing non-downloadable on-line magazines and newsletters in the field of hockey over the Internet.

We turn now to third-party registrations. Applicant introduced copies of the following third-party registrations:

- 39 third-party MONSTER registrations in Class 9 (Applicant's Exhibits 16-65).⁶⁶

The following registrations are illustrative:

- Registration No. 5324782 for the mark ATOMIC MONSTER for, inter alia, digital downloadable video files for delivery to mobile telephone and personal digital devices featuring adventure, drama and action;⁶⁷
- Registration No. 5738624 for the mark BOSS MONSTER for computer game software for use on mobile and cellular phones;⁶⁸ and

⁶⁶ 57 TTABVUE 152-356. We did not consider Registration Nos. 4636890, 5713125 or 5029695 because they do not include the word "monster." (57 TTABVUE 358-367).

⁶⁷ 57 TTABVUE 152.

⁶⁸ 57 TTABVUE 156.

- Registration No. 5246319 for the mark CAP MONSTERS for, inter alia, computer game software;⁶⁹
- five third-party MONSTER registrations in Class 14 (Applicant's Exhibits 69-76).⁷⁰
- 32 third-party MONSTER registrations in Class 16 (Applicant's Exhibits 77-109).⁷¹ The following registrations are illustrative:
 - Registration No. 3289638 for the mark BUFF MONSTER for stickers;⁷²
 - Registration No. 4943918 for the mark FAMOUS MONSTERS for, inter alia, posters;⁷³ and
 - Registration No. 3655951 for the mark GREEN MONSTER for, inter alia, posters and mounted and unmounted photographs;⁷⁴
- 35 third-party MONSTER registrations in Class 25 (Applicant's Exhibits 116-151);⁷⁵

⁶⁹ 57 TTABVUE 160.

⁷⁰ 57 TTABVUE 368-394. All five registrations are for some form of jewelry or jewelry making kits.

We did not consider Registration Nos. 5521379 or 4533853 because they do not include the word "monster." (57 TTABVUE 396-402).

⁷¹ 57 TTABVUE 404-538. We did not consider Registration Nos. 4955963, 4999914, 4636890, 3771431, 4354158, or 4396609 because they do not include the word "monster." (57 TTABVUE 540-562).

⁷² 57 TTABVUE 404.

⁷³ 57 TTABVUE 408.

⁷⁴ 57 TTABVUE 412.

⁷⁵ 57 TTABVUE 564-734. All 35 registrations are for some form of apparel.

We did not consider Registration Nos. 4824047, 4746450, 4755341, 4955963, 5517917, 5682053, 4999914, 4636890, 3771431, 3533870, 5669226, 5860109, 4389572, 4497252,

• 80 third-party MONSTER registrations in Class 28 (Applicant's Exhibits 169-249).⁷⁶ The following registrations are illustrative:

• Registration No. 3586236 for the mark BLUE MONSTER for, inter alia, stuffed toy animals;⁷⁷

• Registration No. 5142951 for the mark BREAKFAST MONSTERS! for, inter alia, plush toys;⁷⁸ and

• Registration No. 5890552 for the mark BUTTON JAR MONSTERS for stuffed and plush toys;⁷⁹

• 20 third-party MONSTER registrations in Class 35 (Applicant's Exhibits 252-272).⁸⁰ The following registrations are illustrative:

• Registration No. 5858083 for the mark 3 HEADED MONSTER for, inter alia, advertising, marketing and promotion services;⁸¹

5586900, 4396609, or 5670992 because they do not include the word "monster." (57 TTABVUE 736-797).

⁷⁶ 57 TTABVUE 799-911 and 58 TTABVUE 6-237. We did not consider Registration Nos. 3771431 or 4396609 because they do not include the word "monster." (58 TTABVUE 239-245).

⁷⁷ 57 TTABVUE 802.

⁷⁸ 57 TTABVUE 810.

⁷⁹ 57 TTABVUE 813.

⁸⁰ 58 TTABVUE 247-331. We did not consider Registration Nos. 3781552, 4076006, or 5284363 because they do not include the word "monster." (58 TTABVUE 333-346).

⁸¹ 58 TTABVUE 247.

- Registration No. 3989509 for the mark ADMONSTERS for, inter alia, providing an online interactive website featuring advertising and advertisement services;⁸² and
- Registration No. 5313295 for the mark BEADSMONSTER for, inter alia, on-line retail gift shops;⁸³
- five third-party MONSTER registrations in Class 38 (Applicant's Exhibits 276-281);⁸⁴
- 85 third-party MONSTER registrations in Class 41 (Applicant's Exhibits 282-367).⁸⁵ The following registrations are illustrative:
 - Registration No. 3607649 for the mark GREEN MONSTER for, inter alia, providing information in the field of sports, entertainment and related topics, and providing for informational messages relating thereto;⁸⁶
 - Registration No. 4580772 for the mark HENRY HUGGLEMONSTER for, inter alia, presentation and distribution of television programs, provision of entertainment news and entertainment information via communication and computer networks and presentation sound and visual recordings;⁸⁷ and

⁸² 58 TTABVUE 254.

⁸³ 58 TTABVUE 259.

⁸⁴ 58 TTABVUE 348-369. Four of the registrations are for related services. The description of goods in Registration No. 5118877 for the mark MONSTERCLOUD, voice over internet protocol (VOIP) services, is too far afield to be relevant. (58 TTABVUE 360).

⁸⁵ 58 TTABVUE 371-746. We did not consider Registration Nos. 3771432, 4375738, 4179507, 4929082, or 5586900 because they do not include the word "monster." (58 TTABVUE 748-764).

⁸⁶ 58 TTABVUE 432.

⁸⁷ 58 TTABVUE 446.

•Registration No. 4101431 for the mark MICHIGAN ICE MONSTER for performing in motor sports events.⁸⁸

In *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979), which involved an opposition to the registration of NATURE'S PLUS for vitamins by the owner of the mark PLUS, also for vitamins, the applicant made of record eight third-party registrations that issued prior to opposer's registration and seven registrations that issued after, all for marks containing the word PLUS and all for goods that are the same or closely related to vitamins. The Board drew the following inferences from the co-existence of these registrations:

1. Opposer was satisfied to register PLUS side-by-side with eight existing registrations.
2. The USPTO has historically registered PLUS marks for vitamins to different parties so long as there has been some difference, not necessarily created by a distinctive word, between the marks as a whole, e.g., VITAMINS PLUS and IRON PLUS.
3. A number of different trademark owners have believed, over a long interval of time that various PLUS marks can be used and registered side by side without causing confusion provided there are minimal differences between the marks.

Id. at 779. See also *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153 (TTAB 2012) (applying the same inferences); *Jerrold Elec. Corp. v. The Magnavox Co.*,

⁸⁸ 58 TTABVUE 464.

199 USPQ 751, 758 (TTAB 1978) (third-party registrations “reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can coexist provided that there is a difference.”); *In re Sien Equip. Co.*, 189 USPQ 586, 588 (TTAB 1975) (the suggestive meaning of the word “Brute” explains the numerous third-party registrations incorporating that word with other wording or material no matter how little additional significance they may add to the word “Brute” per se).

We find that Applicant’s “Monster” registrations and the third-party “Monster” registrations show that the word “Monster” is highly suggestive for all identified goods and services other than beverages and, therefore, it falls on the inherently or conceptually weaker side of the spectrum for those goods and services. Opposer argues to the contrary. Opposer contends that because “Applicant provides no evidence that these third party marks are registered for goods or services which overlap with Opposer’s or Applicant’s goods or services,”⁸⁹ Opposer’s MONSTER marks are not weak. While we acknowledge that not every third-party registration is relevant, the preceding review of Applicant’s other registrations and third-party registrations disprove Opposer’s argument. In this regard, Opposer simply argued that the goods or services are not related but did not identify even one irrelevant registration as an example. Accordingly, Opposer fails to persuade us that its MONSTER marks are anything other than inherently/conceptually highly suggestive with respect to the goods and services in Classes 9, 14, 16, 25, 28, 35, 38, and 41.

⁸⁹ Opposer’s Reply Brief, p. 8 (67 TTABVUE 14).

On the other hand, with respect with beverages, because there are no third-party MONSTER marks, we find that Opposer's MONSTER mark is arbitrary and, therefore, an inherently or conceptually strong mark.

2. The commercial strength of Opposer's MONSTER marks.

We find that Opposer's MONSTER mark for beverages is commercially strong, if not famous. There is no need to recount the evidence of the commercial strength of Opposer's MONSTER mark in connection with beverages inasmuch as the evidence is persuasive and Applicant does not contest the commercial strength of Opposer's marks for beverages.

Applicant, in its brief, argues that "fame in one category of goods or services does not necessarily extend to other categories," implying that because Opposer's MONSTER marks are famous for beverages does not mean that Opposer's MONSTER marks are famous for apparel, promoting sporting events for others, etc.⁹⁰ Applicant continues asserting "[w]hile Opposer has built a successful energy drink business under its MONSTER ENERGY and MONSTER-formative marks, these rights do not preclude Applicant from registering its Team Logo in connection with professional hockey services and related team merchandise."⁹¹

Consequently, although Opposer's MONSTER-formative marks may be well-known for energy drinks, they are not "famous" for the goods and services covered by Applicant's pending Team Logo applications.⁹²

⁹⁰ Applicant's Brief, p. 23 (66 TTABVUE 30).

⁹¹ *Id.*

⁹² *Id.* at p. 24 (66 TTABVUE 31).

It is common knowledge that owners of famous marks frequently use those marks on collateral or merchandising products such as clothing, mugs and other consumer goods.

We agree with the board that appellee's evidence establishes that appellee has built up an enormous goodwill in the mark MONOPOLY, which has been used since 1935 for a board game and that MONOPOLY may properly be termed a "famous" mark. We also find no error in the board's conclusion that it is a matter of common knowledge that famous marks are frequently used on items such as clothing, glassware, and trash cans and that appellee's licensing of its mark for use on certain novelty items supports this conclusion.

Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., 648 F.2d 1335, 200 USPQ 986, 988 (CCPA 1981).

Likewise, as the Board found in *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 863 (TTAB 1986):

That the mark HARLEY-HOG used on pork products is likely to be associated as to source with opposer is also corroborated by the fact that opposer's uses of HARLEY and HOG in relation to its collateral goods frequently have been whimsical in character (e.g., HOG piggy banks, T-shirts bearing the phrase, "I LOVE MY HOG HARLEY," "the HOG Tales" publication, etc.). Because of these uses, a person having knowledge of them would not be surprised to see HARLEY-HOG used in connection with hot dogs or similar products, and the association with opposer of the mark so used would also be not at all surprising.

We find that Opposer's MONSTER marks are inherently or conceptually strong, as well as commercially very strong, if not famous, in connection with beverages, and, therefore, entitled to a broad scope of protection in connection with these goods.

However, because Opposer's MONSTER marks are highly suggestive, they are entitled to a more narrow scope of protection with respect to other goods and services.

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Sure-Fit Prods. Co. v. Saltzson Drapery Co., 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958). *See also Hartz Hotel Servs.*, 102 USPQ2d at 1154. Under these circumstances, we will accord Opposer's marks comprising the term "Monster" for goods or services other than beverages a narrow scope of protection.

B. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Neither Opposer, nor Applicant, is aware of any reported instances of actual confusion.⁹³ The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by the parties of their marks for a significant length of time in the same markets. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there

⁹³ Applicant's response to Opposer's interrogatory Nos. 36 and 38 (19 TTABVUE 158-59); Ostrowski Testimony Decl. ¶27 (55 TTABVUE 11-12); Opposer's admission to Applicant's request for admission Nos. 14-16 (59 TTABVUE 450-52); Opposer's response to Applicant's interrogatory No. 10 (59 TTABVUE 465-66).

must have been a reasonable opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

According to Opposer’s witness, Rodney Sacks, in April 2002, Opposer launched its MONSTER ENERGY drink.⁹⁴ Since its launch, Opposer’s MONSTER ENERGY drink has grown into an industry leader.⁹⁵

By 2003, [Opposer’s] beverages were being sold in all 50 states in gas stations, convenience stores, gyms, health food stores, independent stores, grocery stores, mass merchandisers such as Costco, Wal-Mart, and Target, and drug stores such as CVS and Walgreens. Monster’s MONSTER™ line of drinks are now sold by well over 300,000 retail stores all over the country. Monster’s MONSTER™ line of drinks are also sold by on-premise retailers such as bars, restaurants, coffees shops, sports venues, theme parks and cinemas, including, but not limited to Anaheim’s Angel Stadium and the Honda Center, New Jersey’s Devil’s Arena, Boston’s TD Garden, Carl’s Jr., Hardee’s, Dunkin Donuts, Disney theme parks, and Cinemark theaters. Monster’s MONSTER™ line of drinks are also sold online, including on amazon.com, walmart.com, and monsterarmy.com.⁹⁶

⁹⁴ Sacks Testimony Decl. ¶7 (42 TTABVUE 5).

⁹⁵ Sacks Testimony Decl. ¶¶4 and 13 (42 TTABVUE 3 and 7); 23-24 TTABVUE (printed publications reporting, inter alia, on Opposer’s growth).

⁹⁶ Sacks Testimony Decl. ¶11 (42 TTABVUE 6).

Since the launch of its MONSTER ENERGY drink in 2002, Opposer “has allocated a significant portion of its marketing, advertising, and promotional budget on athlete endorsements and sponsoring athletic competitions and other events,” including hockey.⁹⁷

In addition to the actual contractual amounts paid to sponsor athletes and racing teams, [Opposer] expends substantial amounts in supporting the sponsored athletes, teams, and sports through point of sale materials, sweepstakes and give-a-ways, wrapping/branding the athletes’ vehicles, paying for the athletes travel expenses and by providing them with MONSTER-branded apparel, free products for sampling stations, and action sports gear bearing the MONSTER Marks. Further, Monster hires employees and outside companies to attend events to support and monitor the sponsored athletes and teams at every event and to provide hospitality and sampling of products to consumers.⁹⁸

“The sponsored athletes, teams, and musicians create enormous public exposure and awareness of the MONSTER Marks.”⁹⁹

Monster-sponsored athletes have been the focus of hundreds of action sports magazines and articles, which feature the athletes’ gear and accessories that prominently display the MONSTER Marks. Monster-sponsored athletes are routinely featured promoting the MONSTER Marks through their clothing, accessories and/or equipment in national magazines such as *People*, *Men’s Fitness*, *Cycle News*, *Dirt Rider*, *Racer X Illustrated*, *Transworld Motocross*, *Dirt*, and *Modified Mag*.¹⁰⁰

⁹⁷ Sacks Testimony Decl. ¶¶14 and 18 (42 TTABVUE 7-9). *See also* Sacks Testimony Decl. ¶¶24-31 (42 TTABVUE 11-13) (providing detailed testimony regarding Opposer’s hockey sponsorships).

⁹⁸ Sacks Testimony Decl. ¶14 (42 TTABVUE 8).

⁹⁹ Sacks Testimony Decl. ¶19 (42 TTABVUE 10).

¹⁰⁰ Sacks Testimony Decl. ¶115 (42 TTABVUE 42).

Rodney Sacks testified about Opposer's extensive social media presence consisting of its MONSTER ENERGY website (monsterenergy.com) and MONSTER ARMY website (monsterarmy.com), Facebook, Twitter, Instagram, and YouTube.¹⁰¹

98. ... The www.monsterenergy.com website hosted over 1.7 million unique visitors in 2008 alone. In May 2011, the website was viewed over 479,000 times. ...

99. [Opposer's] Facebook page is among the most "liked" Facebook pages. [Opposer's] Facebook page currently has more than 26 million "likes." The page features Monster sponsored athletes, sports, and events, from all over the world and prominently displays the MONSTER Marks. Attached hereto as Exhibit 42 are true and correct copies from [Opposer's] Facebook page dated April 1, 2014. At that time, [Opposer] had over 24 million "likes.

100. ... Monster was the 14th most followed brand on Facebook in 2010. At that time, Monster had over 7 million followers. As of August 2019, Monster had become the 8th most popular brand on Facebook according to Socialbakers.¹⁰²

101. [Opposer's] Twitter account ... has over 3.1 million followers. ...

102. [Opposer's] Instagram account ... has approximately 5.7 million followers ...

103. ... [Opposer's] YouTube channel had over 1.6 million subscribers [as of July 25, 2018].¹⁰³

In addition to selling beverages, Opposer uses and licenses its MONSTER marks on a wide range of other products, including, but not limited, to clothing, protective

¹⁰¹ Sacks Testimony Decl. ¶¶89-93 and 97-105 (42 TTABVUE 34-36 and 37-39).

¹⁰² Socialbakers tracks brand popularity on Facebook. Sacks Testimony Decl. ¶100 (42 TTABVUE 37).

¹⁰³ Sacks Testimony Decl. ¶¶98-103 (42 TTABVUE 37-38).

gear, helmets, stickers, and jewelry.¹⁰⁴ Opposer’s “accessories, clothing, and beverage products bearing its MONSTER Marks are sold and given away at sporting events, music festivals, concerts, and other events or public locations”¹⁰⁵ “to consumers in all 50 states.”¹⁰⁶

In 2003, Opposer sponsored the MONSTER train, the first multi-car train on the Las Vegas monorail. The train prominently features the MONSTER marks and exposes the MONSTER marks “to a large number of consumers.”¹⁰⁷

Opposer and video game publishers have entered partnerships to have MONSTER branding appear in video games. “These cross promotions create exposure for the MONSTER marks and maintain [Opposer’s] connection with the video game community.”¹⁰⁸

According to Applicant’s witness, Mike Ostrowski, the CLEVELAND MONSTERS is a professional hockey team playing in the American Hockey League (AHL).¹⁰⁹ The CLEVELAND MONSTERS play its home games in Rocket Mortgage Fieldhouse in Cleveland, Ohio, and its road games in 31 cities throughout the country with AHL teams, including Syracuse, New York, Chicago, Illinois, Grand Rapids, Michigan, and Milwaukee, Wisconsin.¹¹⁰

¹⁰⁴ Sacks Testimony Decl. ¶106 (42 TTABVUE 39-40).

¹⁰⁵ Sacks Testimony Decl. ¶111 (42 TTAVUE 41).

¹⁰⁶ Sacks Testimony Decl. ¶113 (42 TTABVUE 41).

¹⁰⁷ Sacks Testimony Decl. ¶117 (42 TABVUE 43-42).

¹⁰⁸ Sacks Testimony Decl. ¶121 (42 TTABVUE 45).

¹⁰⁹ Ostrowski Testimony Decl. ¶5 (55 TTABVUE 4).

¹¹⁰ Ostrowski Testimony Decl. ¶6 (55 TTABVUE 4-5).

The original name of the CLEVELAND MONSTERS was the LAKE ERIE MONSTERS. The LAKE ERIE MONSTERS began playing in the AHL in the 2007-08 hockey season. The LAKE ERIE MONSTERS used the logo reproduced below:¹¹¹



In 2016, the team announced the name change to the CLEVELAND MONSTERS as part of plan to identify the team with the city of Cleveland, Ohio, where it plays its home games.¹¹²

As noted above, Applicant used the CLEVELAND MONSTERS and design mark at issue for the goods and services at issue since July 31, 2016. Applicant has used the LAKE ERIE MONSTERS and design mark in connection with paper pennants and clothing since January 2007 and continues to use the mark in connection with those goods.¹¹³

¹¹¹ Ostrowski Testimony Decl. ¶14 (TTABVUE 8); Ostrowski Discovery Dep., p. 43 (33 TTABVUE 41).

¹¹² Ostrowski Testimony Decl. ¶¶15-17 (55 TTABVUE 9); Ostrowski Discovery Dep., pp. 43, 45, and 50 (33 TTABVUE 41, 43, and 48); Applicant's response to Opposer's interrogatory No. 3 (19 TTABVUE 149-150).

¹¹³ Ostrowski Testimony Decl. ¶¶9 and 10 (55 TTABVUE 5-7); Applicant's response to Opposer's interrogatory Nos. 10 and 11 (19 TTABVUE 151).

Applicant promotes its CLEVELAND MONSTERS hockey game services and the related goods and services through its website and social media platforms (i.e., Facebook, Twitter, and Instagram).¹¹⁴

We also have a Monsters members, like our season tickets members' page on Facebook. Our dance teams and mascots, I know they have Twitter accounts. I believe Facebook, too.¹¹⁵

Applicant sells its CLEVELAND MONSTERS and design brand merchandise at the arena where it plays its home games, at away arenas, online team store, through a mobile trailer at team events, through licensing agreements managed by the AHL.¹¹⁶ Applicant does not sell CLEVELAND MONSTERS merchandise through big box retailers such as Costco or Wal-Mart or through local convenience stores.¹¹⁷

The goods and services Applicant offers its CLEVELAND MONSTERS and design brand goods and services to the general consuming public, including but not limited to hockey fans.¹¹⁸ Mike Ostrowski provided additional details about Applicant's goods and services:

Q. So let's talk about the target market for Cleveland Monsters. Is there a typical Cleveland Monsters fan?

¹¹⁴ Ostrowski Testimony Decl. ¶12 (55 TTABVUE 8); Ostrowski Discovery Dep., p. 142 (33 TTABVUE 103); Applicant's response to Opposer's interrogatory No. 26 (19 TTABVUE 155-156).

¹¹⁵ Ostrowski Discovery Dep., p. 142 (33 TTABVUE 103).

¹¹⁶ Ostrowski Testimony Decl. ¶11 (55 TTABVUE 8); Ostrowski Discovery Dep., pp. 115-116 (33 TTABVUE 79-80); Applicant's response to Opposer's interrogatory No. 20 (19 TTABVUE 154).

¹¹⁷ Ostrowski Discovery Dep., pp. 119-120 (33 TTABVUE 83-84).

¹¹⁸ Applicant's response to Opposer's interrogatory No. 24 (19 TTABVUE 155).

A. So, you know, kids are a big target of ours, families. Kids and families are very, you know, central to the product that we put on. Each game, hockey fans, we're targeting them, but we're also targeting people that like to have a good time. So you don't have to be, you know, a hockey fan to come to our games to have fun. We know we'll have hockey fans so we do target them and provide them pieces of information, but definitely more kid and family focused would be what you'll see at our games generally.

Q. And do Cleveland Monsters fans typically reside locally here in Cleveland or is there a wider reach?

A. Typically in northeast Ohio, within probably a seven to 10 county radius, but you could have some fans coming from a little further out, but generally it's northeast Ohio.¹¹⁹

Applicant targets businesses and higher net worth individuals for premium season ticket programs, as well as casual buyers who would not be interested in multiple games.¹²⁰

In 2008, Opposer's predecessor-in-interest, and Applicant's parent company entered into a marketing and promotional sponsorship agreement with Walgreens. "Opposer's MONSTER ENERGY drinks were featured in co-branded displays at certain Walgreen's [sic] stores in Ohio. The co-branded displays promoted MONSTER ENERGY, the LAKE ERIE MONSTERS, and the affiliated CLEVELAND CAVALIERS NBA franchise."¹²¹

¹¹⁹ Ostrowski Discovery Dep., p. 150-151 (33 TTABVUE 107-108).

¹²⁰ Ostrowski Discovery Dep., pp. 154-155 (33 TTABVUE 111-112).

¹²¹ Ostrowski Testimony Decl. ¶22 (56 TTABVUE 10-11) (confidential). "The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party." Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g).

The Walgreens Agreement provided customers opportunities to win tickets to Cleveland Cavaliers professional NBA basketball games, Lake Erie Monsters minor league hockey games, or Quicken Loans Arena concert events by purchasing Monster products from the aforementioned newly acquired shelf space.¹²²

Mr. Sacks testified that there were no reported instances of confusion during the co-promotion event (2008-2014).¹²³

Finally, both parties agree that they offer their goods and services in the same channels of trade to the same classes of consumers.¹²⁴ Applicant admits that the same classes of consumers may encounter both Applicant's mark and Opposer's marks.¹²⁵ Likewise, Opposer contends the facts listed below prove the parties offer their goods and services to the same classes of consumers:¹²⁶

- Both parties promote entertainment services related to sporting activities, including hockey;¹²⁷

- Both parties sell their products at sporting events, including hockey and on the Internet;¹²⁸

¹²² Sacks Rebuttal Testimony Decl. ¶3 (62 TTABVUE 3). Despite the opportunity for MONSTER ENERGY drink consumers to win tickets to LAKE ERIE MONSTERS hockey games, Mr. Sacks contends that consumers did not see the two marks together. *Id.* at ¶5 (62 TTABVUE 3-4).

¹²³ Ostrowski Testimony Decl. ¶27 (56 TTABVUE 12) (confidential).

¹²⁴ We discuss established, likely-to-continue channels of trade in a separate section below.

¹²⁵ Applicant's admission to Opposer's request for admission No. 3 (19 TTABVUE 169).

¹²⁶ Opposer's Brief, pp. 39-40 (64 TTABVUE 46-47).

¹²⁷ Sacks Decl. ¶¶24-35, 110-113 (42 TTABVUE 11-14 and 41-42); Applicant's response to Opposer's interrogatory No. 20 (19 TTABVUE 154).

¹²⁸ *Id.*

- Both parties market and promote their products and services on the Internet, including through their social media accounts;¹²⁹

- Both parties have televised and broadcast their sporting events over the radio and internet;¹³⁰

- Both parties have promoted their products through giveaways, such as product giveaways;¹³¹ and

- Applicant's target market comprising "the general consuming public, including but not limited to fans of professional hockey" overlaps with Opposer's primary target market comprising adult males, ages 18 to 34.¹³²

In view of the simultaneous use of Opposer's MONSTER marks in connection with beverages and associated collateral merchandising products and promoting and sponsoring of sporting events, including hockey, and Applicant's LAKE ERIE MONSTERS and design mark since 2007 and Applicant's CLEVELAND MONSTERS and design mark since 2016 in connection with hockey and associated collateral merchandise, there has been a reasonable opportunity for actual confusion. This is especially persuasive inasmuch as the parties agree that they have offered their goods and services in the same channels of trade and to the same classes of consumers.

¹²⁹ Sacks Decl. ¶¶97-105 (43 TTABVUE 37-39); Ostrowski Discovery Dep., pp. 141-43 (33 TTABVUE 102-104); Applicant's responses to Opposer's interrogatory Nos. 20 and 26 (19 TTABVUE 154-56); Applicant's admissions to Opposer's requests for admission Nos. 20-24 (19 TTABVUE 174-75).

¹³⁰ Sacks Decl. ¶¶16, 18, 37-40, and 45 (42 TTABVUE 8-10, 15-18).

¹³¹ Sacks Decl. ¶¶21 and 72 (42 TTABVUE 10 and 27-28); Ostrowski Discovery Dep., pp. 132-133 (33 TTABVUE 98-99).

¹³² Applicant's responses to Opposer's interrogatory Nos. 24 and 25 (19 TTABVUE 155); Sacks Decl. ¶15 (42 TTABVUE 8).

While LAKE ERIE MONSTERS and design and CLEVELAND MONSTERS and design are not identical, they differ only in the geographic designations “Lake Erie” and “Cleveland.” Notably, it is Applicant’s use and registration of the word “Monsters” to which Opposer objects. In view of the similarity of Applicant’s marks, reproduced below, Opposer’s argument that the lack of confusion between LAKE ERIE MONSTERS and design and Opposer’s MONSTER marks is irrelevant lacks credulity.¹³³



Furthermore, Opposer’s renown extends nationwide across almost all channels of trade and classes of consumers. In fact, the evidence shows that Opposer’s MONSTER marks have been commercially strong, if not famous, since prior to Applicant’s first use of LAKE ERIE MONSTERS and design. Opposer contends that because Applicant’s promotion and use of its marks has been geographically limited to northeastern Ohio, the lack of any reported instances of confusion is neutral.¹³⁴ There are several problems with Opposer’s contention. First, as noted above, Opposer’s renown is nationwide and extends into Applicant’s primary marketing area. Second, although Applicant is located in Cleveland, Ohio, it is part of the AHL and plays throughout the country. Finally, Applicant and Opposer were involved in a co-

¹³³ Opposer’s Reply Brief, p. 8 (67 TTABVUE 12).

¹³⁴ Opposer’s Brief, p. 46 (64 TTABVUE 53).

branding promotional program from 2008 through 2014 that generated no reported instances of confusion because of the use of Opposer's MONSTER marks and Applicant's LAKE ERIE MONSTERS mark.

Based on this evidence, we find there has been a reasonable opportunity for confusion to occur and that the lack of any reported instances of confusion weighs against finding that there is a likelihood of confusion. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 98 USPQ2d at 1259-61 (finding substantial evidence supports there was a reasonable opportunity for confusion to occur with no reported instances of actual confusion, thus, favoring finding no likelihood of confusion).

C. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. Sept. 13, 2019)); *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.") (citation omitted).

In comparing the marks, we are mindful that "[t]he 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.” *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721).

The marks are similar to the extent that Opposer’s marks consist of the word “Monster” and Applicant’s mark includes the word “Monsters.” In contrast, the marks have different meanings and engender different commercial impressions. In Opposer’s case, the word “Monster” means and engenders the commercial impression of enormous or huge energy. On the other hand, Applicant’s CLEVELAND MONSTERS and design, reproduced below, engenders the commercial impression of a huge animal representing a powerful hockey team from Cleveland.¹³⁵



Mike Ostrowski testified that Applicant originally adopted and used LAKE ERIE MONSTERS as a play on a mythical monster in Lake Erie.

The original team name, LAKE ERIE MONSTERS, was a humorous play on local folklore claiming that a serpent akin to the Loch Ness Monster lived in Lake Erie off the shores of Cleveland, Ohio, where the team is based. As part of its marketing efforts, the team has always sought to develop and convey a family-friendly and welcoming image. Consequently, Applicant was attracted to an interesting

¹³⁵ While the commercial impression of the parties marks are of an aggressive and intense demeanor, as noted by Opposer, the commercial impressions are different when applied to the primary goods and services of the parties. Opposer’s Brief, p. 39 (64 TTABVue 46).

and humorous play on the local legend surrounding the mythical monster.¹³⁶

Opposer asserts that because its MONSTER marks are famous, “even a minimal level of similarity would cause a likelihood of confusion.”¹³⁷ Fame alone is not sufficient to prove likelihood of confusion. If that were the case, having a famous mark would entitle the owner to a right in gross, and that is against the principles of trademark law. *See Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imp. Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983):

The fame of the [plaintiff’s] name is insufficient in itself to establish likelihood of confusion under 2(d). “Likely * * * to cause confusion” means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 USC 1052(d).

See also Recot, 54 USPQ2d at 1898 (Fed. Cir. 2000) (“fame alone cannot overwhelm the other *du Pont* factors as a matter of law”).

In this case, we find the different commercial impressions engendered by the parties’ respective marks, the highly suggestive inherent or conceptual nature of the word “Monster” in connection with goods and services in Classes 9, 14, 16, 25, 28, 35,

¹³⁶ Ostrowski Testimony Decl. ¶16 (55 TTABVUE 9). *See also* Bessie (lake monster), Wikipedia.org (60 TTABVUE 10) (“In Michigan folklore, Bessie is a name given to a lake monster in Lake Erie, also known as South Bay Bessie.”); Legend of Lake Erie Monster Rises Again, Los Angeles Times (September 30, 1990) (60 TTABVUE 16).

¹³⁷ Opposer’s Brief, p. 36 (64 TTABVUE 43).

38, and 41, and the lack of any reported instances of confusion, even though the identified goods and services move through the same channels of trade and are offered to the same classes of customers, are significant countervailing factors in determining whether the marks are similar. *See Blue Man Prods. Inc. v. Tarmann*, 75 USPQ2d 1811, 1819-1820 (TTAB 2005), *rev'd on other grounds*, Civil Action No. 05-2037 (D.D.C. April 3, 2008); *Burns Philp Food Inc. v. Modern Prods. Inc.*, 24 USPQ2d 1157, 1160 (TTAB 1992), *aff'd mem.*, 1 F.3d 1252, 28 USPQ2d 1687 (Fed. Cir. 1983) (“while we recognize that the fame of a mark is entitled to substantial weight in our deliberation (internal citation omitted), the differences in connotation and in trade dress on the labels are significant countervailing factors.”).

Opposer contends that the word “Monster” is the dominant part of Applicant’s mark and, therefore, Applicant’s mark is similar to Opposer’s MONSTER marks.¹³⁸ As noted above, Applicant’s mark CLEVELAND MONSTERS and design and Opposer’s MONSTER marks are similar because they share the root word “Monster.” However, the other elements in Applicant’s mark, particularly the inclusion of the geographic location Cleveland, distinguish the marks by engendering different commercial impressions. *See Coach Servs.*, 96 USPQ2d at 1609 (applicant’s mark COACH for educational materials for preparing for standardized tests engenders a different commercial impression than Opposer’s mark COACH for fashion accessories such as handbags and leather goods); *Viacom Int’l Inc. v. Komm*, 46 USPQ2d 1233,

¹³⁸ Opposer’s Brief, pp. 37-38 (64 TTABVUE 44-45).

1238 (TTAB 1998) (the word “mouse” has different meanings when applied to a computer peripheral and a cartoon superhero).

Opposer further contends that Applicant’s fans refer to the CLEVELAND MONSTERS as “the Monsters,” thus, emphasizing the similarity of the marks.¹³⁹ We acknowledge again that the marks are similar because they share the root word “Monster.” However, because Applicant’s mark identifies a sports team, consumers encountering both marks will distinguish Applicant’s mark from Opposer’s marks despite some fans referring to the CLEVELAND MONSTERS as “The Monsters.” This situation is analogous to sports fans distinguishing teams with the same name (e.g., Auburn Tigers, Missouri Tigers, Princeton Tigers, Clemson Tigers, Detroit Tigers, etc.).

We find that the marks are more dissimilar than they are similar, and that this *DuPont* factor weighs against finding a likelihood of confusion.

D. The similarity or dissimilarity and nature of the goods and services.

1. International Class 9

Applicant seeks to register its CLEVELAND MONSTERS and design mark for the goods set forth below in International Class 9:

Computer programs for viewing statistics or trivia about hockey; computer software, namely, screen savers featuring hockey themes, computer software to access and view computer wallpaper, computer browsers, computer skins and computer cursors; **computer game software**; magnets; credit cards magnetically encoded; downloadable video-stream recordings in the field of hockey provided over

¹³⁹ Opposer’s Brief, p. 37 (64 TTABVUE 44). Mike Ostrowski testified that fans refer to the team as “The Monsters.” Ostrowski Discovery Dep., pp. 62 and 64 (33 TTABVUE 60-61).

the Internet; downloadable computer software for viewing databases of information, statistical information, trivia, polling information, and interactive polling in the field of hockey provided over the Internet; downloadable computer game software; downloadable interactive video games and trivia game software provided over the Internet; downloadable computer software for use as screensavers, wallpaper, browsers, skins and cursors over the Internet; downloadable electronic publications in the nature of magazines, newsletters and game schedules all in the field of hockey provided over the Internet. (Emphasis added).

Opposer has licensed its marks for use in connection with video games, partners with video game publishers to promote the release of new video games, and sponsors several competitive video gaming events.¹⁴⁰ Specifically, Opposer agreed “to have MONSTER™ branding appear in video games.”¹⁴¹ For example, MONSTER sponsored characters appear in the SKATE, SKATE 3, DIRT 2, DIRT 3, and DIRT SHOWDOWN video games.¹⁴² In addition, Opposer collaborated with the publisher of the CALL OF DUTY video game to have the CALL OF DUTY trademark appear on Opposer’s MONSTER ENERGY beverages.¹⁴³

As best we understand Opposer’s position, CLEVELAND MONSTERS and design computer game software is related to Opposer’s famous MONSTER ENERGY

¹⁴⁰ Sacks Testimony Decl. ¶¶70 and 121-131.

Opposer registered M MONSTER ENERGY and design for “sports helmets,” in International Class 9 (Registration No. 3914828). Opposer did not argue that any of the products Applicant identified in its Class 9 description of goods are related to sports helmets.

¹⁴¹ *Id.* at ¶121.

¹⁴² *Id.* at ¶¶122-124.

¹⁴³ *Id.* at ¶125.

beverages because Opposer sponsors and promotes video games.¹⁴⁴ There is a twofold problem with Opposer's contention. First, there is no evidence that video games and beverages emanate from the same source or that consumers perceive beverages and video games as related products despite Opposer's sponsorship of video games and video game events. Second, if sponsoring products and events makes the goods or services of the sponsor related to the goods or services of the sponsored product, then virtually all goods and services are related. For example, if through a sponsorship agreement COCA-COLA becomes of the official soft drink of the U.S. Olympic team, according to Opposer, soft drinks are related to Olympic competitions for purposes of analyzing likelihood of confusion.

Opposer failed to prove that beverages are related to computer game software or any of the other products listed in Applicant's application in International Class 9.

2. International Class 14

Applicant seeks to register its CLEVELAND MONSTERS and design mark for "costume jewelry; earrings; jewelry and imitation jewelry; pendants; rings; watches," in International Class 14.

Opposer has registered M MONSTER ENERGY and design reproduced below, for "silicone wrist bands; silicone bracelets; jewelry, namely, bracelets and wristbands," in International Class 14.¹⁴⁵

¹⁴⁴ If our understanding is incorrect, then Opposer failed to clearly articulate how and why its MONSTER ENERGY beverages are related to computer game software. *See* Opposer's Brief, p. 42 (64 TTABVUE 49).

¹⁴⁵ Registration No. 4332062.



We must consider Opposer’s and Applicant’s descriptions of goods to include all goods of the type identified. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). Applicant’s broadly worded identifications of “costume jewelry” and “jewelry and imitation jewelry” are broad enough to encompass Opposer’s silicone wrist bands and bracelets and “jewelry, namely bracelets and wristbands.” *See Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the services in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein), *quoted in In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 4 (TTAB 2019) and *cited in In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, *11-12 (TTAB 2020).

The Class 14 products include legally identical items.

3. International Class 16

Applicant seeks to register its CLEVELAND MONSTERS and design mark for the products set forth below in International Class 16:

Publications and printed matter, namely, **stickers**, **decals**, memo pads, note pads, ballpoint pens, pencils, paper banners and flags, stationery folders, wire-bound notebooks, portfolio notebooks, unmounted and mounted photographs, calendars, bumper stickers, statistical books, guide books, and reference books in the field of hockey;

magazines in the field of hockey; catalogs featuring hockey; commemorative game and souvenir programs in the field of hockey; paper pennants, stationery and printed certificates in the field of hockey; entertainment printed certificates for fans; statistical information sheets for hockey topics; newsletters, brochures, pamphlets and game schedules in the field of hockey; bank checks; credit cards not magnetically coded. (Emphasis added).

Opposer has registered M MONSTER ENERGY and design reproduced below, for “stickers; sticker kits comprising stickers and decals; decals,” in International Class 16.¹⁴⁶



Because the International Class 16 descriptions of goods in Opposer’s pleaded registration and Applicant’s application both include stickers and decals, the description of goods are in part identical. Under this *DuPont* factor, Opposer need not prove, and we need not find, similarity as to each product listed in the description of goods. It is sufficient to find the products related if we find any item encompassed by the description of goods in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d*

¹⁴⁶ Registration No. 3908600.

866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

4. International Class 25

Applicant seeks to register its CLEVELAND MONSTERS and design mark for “athletic pants; caps being headwear; coats; gloves; gym pants; hats; jackets; jogging pants; pants; polo shirts; scarves; shirts; sports pants; sports shirts; sweat pants; sweat shirts; t-shirts; tops as clothing; warm-up suits; wind resistant jackets,” in International Class 25.

Opposer has registered MMONSTER ENERGY and design, reproduced below, 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 25.¹⁴⁷



Because Applicant’s description of goods and Opposer’s description of goods include t-shirts, sweatshirts, jackets, pants, and hats, the description of goods are in

¹⁴⁷ Registration No. 3908601.

part identical. *See Tuxedo Monopoly*, 209 USPQ at 988; *In re i.am.symbolic, llc*, 116 USPQ2d at 1409; *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d at 1745.

5. International Class 28

Applicant seeks to register its CLEVELAND MONSTERS and design mark for “toys, games and sporting goods, namely, hockey pucks and hockey sticks; hockey kits comprised of hockey pucks, hockey sticks and hockey goalie pads; bobblehead action figures; stuffed toys,” in International Class 28.

As noted above, Opposer has registered its M MONSTER ENERGY and design mark, reproduced below, for “sports helmets,” in International Class 9.¹⁴⁸



Opposer also licenses its MONSTER marks on headgear and protective gear.¹⁴⁹

Opposer, in its brief, did not explain how any of the goods or services in connection with which it registered or uses its MONSTER marks are related to the goods in Applicant’s International Class 28 description of goods.¹⁵⁰ Because Opposer’s use in connection with protective gear is based on common law use and it is not registered,

¹⁴⁸ Registration No. 3914828.

¹⁴⁹ Sacks Testimony Decl. ¶106 (42 TTABVUE 39).

¹⁵⁰ Opposer’s Brief, pp. 40-45 (42 TTABVUE 47-52).

there are no presumptions accorded to Opposer's use of its MONSTER marks in connection with protective gear. *See Asplundh Tree Expert Co. v. Defibrator Fiberboard Aktiebolag*, 208 USPQ 954, 959 (TTAB 1980) (when relying upon common law use, likelihood of confusion analysis is confined to specific goods on which mark has been used as well as specific trade channels and actual purchasers or potential purchasers, as disclosed by evidence, without benefit of those presumptions ordinarily allowed registration).

Opposer, as plaintiff in the opposition, bears the burden of proving by a preponderance of evidence its asserted ground of likelihood of confusion. *See Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (“[t]he burden of proof rests with the opposer ... to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion”); *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) (“[i]n opposition proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark”); *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) (petitioner bears the burden of proof).

Inasmuch as Opposer did not introduce any evidence to prove, or make any arguments that, Applicant's products in International Class 28 are related to any of Opposer's goods or services, Opposer did not meet its burden of proof with respect to proving that Applicant's products in International Class 28 are related to any of Opposer's goods or services.

6. International Class 35

Applicant seeks to register its CLEVELAND MONSTERS and design mark for the activities listed below in International Class 35:

Computerized on-line retail store, ordering, retail store services, electronic retail store services and mail-order catalog services featuring an array of hockey-themed merchandise; **promoting the goods and services of others by allowing sponsors to affiliate these goods and services with a hockey program; promoting the sale of goods and services of others through the distribution of promotional contests provided over the Internet**; conducting public opinion poll surveys and public opinion poll surveys in the field of hockey for business and non-business and marketing and non-marketing purposes over the Internet; conducting interactive public opinion polls in the field of hockey. (Emphasis added).

Opposer registered MONSTER ENERGY, in standard character form, for the activities listed below in International Class 35.

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.

In analyzing the Class 35 activities, we must consider the activities as the parties describe them in the descriptions of services in their respective application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“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 the sales of goods are directed."); *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

We also do not read limitations into the identification of services based upon actual marketplace use. *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods.").

Where, as here, the parties broadly identify their services, "we must presume that the services encompass all services of the type identified." *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d at 1025 (where the services in an application or registration are broadly described, they are deemed to encompass all the activities of the nature and type described therein). *See also In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413-14 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture'

necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007).

We must presume that Opposer’s “promoting sports and music events and competitions for others” includes all types of promotional activities, including the distribution of promotional contests over the Internet. Likewise, Applicant’s “promoting the sale of goods and services of others through the distribution of promotional contests over the Internet” includes all types of goods and services, including sports and music events and competitions for others.

We find that the descriptions of services in International Class 35 are in part legally identical. *See Tuxedo Monopoly*, 209 USPQ at 988; *In re i.am.symbolic, llc*, 116 USPQ2d at 1409; *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d at 1745.

7. International Class 38

Applicant seeks to register its CLEVELAND MONSTERS and design mark for the activities listed below in International Class 38.

Audio broadcasting; cable television broadcasting; radio broadcasting; subscription television broadcasting; television broadcasting; video broadcasting; webcasting services in the nature of providing on-line chat rooms and on-line interactive chat rooms with guests for transmission of messages among computer users concerning the field of hockey; broadcasting programs over the Internet; providing on-line electronic bulletin boards for transmission of messages among computer users concerning the field of hockey; providing access to databases featuring interactive polling in the field of hockey.

Opposer does not have a registration for services in International Class 38, nor does Opposer assert common law use of a MONSTER mark for services in International Class 38. Instead, Opposer argues that because it Opposer sponsors events displaying its MONSTER marks broadcast on radio, television and the Internet, consumers will perceive the broadcast services and the event as emanating from the same source.

The MONSTER Marks have been widely used in the promotion of the many MONSTER-sponsored events which have been regularly broadcast over TV, radio, and the internet, including TV networks such as ABC, NBC, CBS, ESPN, the SPEED network. For example, the Monster Energy Supercross has been broadcasted in 181 countries. In 2014, Monster became the presenting sponsor of the Winter and Summer X Games, where a commercial free portion of the events were brought to viewers by Monster, and the MONSTER Marks were integrated throughout the event's TV and internet broadcasts. The 2014 X Games were televised in more than 215 countries and territories and viewed in more than 410 million homes. Additionally, as described above with respect to Class 9, Monster is involved with the sponsorship and promotion of video games which integrate and are highly-related to online chat rooms and bulletin boards.¹⁵¹ (Internal citations omitted).

Applying Opposer's argument to an analogous situation, because the National Football League sponsors professional football games aired on CBS and Fox television, consumers believe that football games and broadcasting services emanate from the same albeit anonymous source.

¹⁵¹ Opposer's Brief, pp. 43 (64 TTABVue 50).

There is no evidence supporting Opposer's contention that consumers perceive sponsors of events and communication services as emanating from the same source. We find, therefore, that Opposer failed to meet its burden of showing that Applicant's activities in International Class 38 are related to any of Opposer's goods or services.

8. International Class 41

Applicant seeks to register its CLEVELAND MONSTERS and design mark for the following activities listed below in International Class 41:

Entertainment services, namely, sporting activities involving the performance by a hockey team in the nature of live performances by a hockey team; entertainment and educational services in the nature of on-going television and radio programs in the field of hockey and rendering live hockey games and hockey exhibitions; the production and distribution of radio and television broadcasts of hockey games, hockey events and programs in the field of hockey; conducting and arranging hockey clinics and coaches' clinics and hockey events; entertainment services in the nature of personal appearances by a costumed mascot at hockey games and exhibitions, clinics, promotions, and other hockey-related events, special events and parties; fan-club services; entertainment services, namely, providing a website featuring the following content - non-downloadable videos in the field of television highlights, interactive television highlights, radio programs, radio highlights, and audio recordings in the field of hockey, and hockey news in the nature of information, statistics and trivia about hockey; on-line computer games; providing non-downloadable on-line magazines, newsletters, and game schedules in the field of hockey over the Internet.

Opposer contends that Applicant's Class 41 services overlap with the services set forth in Opposer's Registration No. 4721433 for the mark MONSTER ENERGY, in standard character form, for "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,” in International Class 35.¹⁵² Specifically, Opposer argues, “promoting the goods and services in the sports [hockey] ... through the distribution of printed, audio and visual promotional materials; promoting sports [hockey] ... for others” encompasses “the performance by a hockey team.”¹⁵³

The following criteria have evolved for determining what constitutes a service: (1) a service must be a real activity; (2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and (3) the activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant’s goods or the performance of another service. *In re Canadian Pac. Ltd.*, 754 F.2d 992, 224 USPQ 971, 973 (Fed. Cir. 1985) (approving the definition of a service as the performance of labor for the benefit another). *See also In re Adver. & Mktg. Dev., Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2014) (Fed. Cir. 1987) (same).

Applying the above-noted criteria, we construe Opposer’s registered services as “promoting goods and services [of others] in [hockey] ... through the distribution of printed, audio and visual promotional materials.” Opposer must be distributing materials in hockey games to promote the goods and services of others. Consumers

¹⁵² Opposer’s Brief, p. 41 (64 TTABVUE 48). Opposer also refers to Registration No. 4721432 for the stylized letter “M,” reproduced below, for the same services.



¹⁵³ *Id.*

may perceive “the performance by a hockey team in the nature of live performances by a hockey team” and distributing materials in hockey games to promote the goods and services of others as emanating from the same source. An advertiser would expect a sports team to advertise the goods and services of others at its sporting event to generate revenues. Accordingly, we find Applicant’s services in Class 41 are related in part to Opposer’s services in Class 35.

9. Summary

- Opposer failed to prove that beverages are related to computer game software or any of the other products listed in Applicant’s application in International Class 9.
- Applicant’s Class 14 products are legally identical to Opposer’s Class 14 products.
- Applicant’s Class 16 products and Opposer’s Class 16 products are in part identical.
- Applicant’s Class 25 products and Opposer’s Class 25 products are in part identical.
- Opposer did not prove that Applicant’s Class 28 products are related to any of Opposer’s goods or services.
- Applicant’s Class 35 services and Opposer’s Class 35 services are in part legally identical.
- Opposer failed to prove that Applicant’s Class 38 services are related to any of Opposer’s goods or services.

- Applicant's services in Class 41 are related in part to and Opposer's services in Class 35.

E. Established, likely-to-continue channels of trade and classes of consumers.

Because Applicant's goods in Classes 14, 16 and 25 and services in Class 35 are identical in whole or in part with Opposer's goods and services in those classes, we presume that the channels of trade and classes of purchasers are the same. *See Viterra*, 101 USPQ2d at 1908 (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai*, 127 USPQ2d at 1801 ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....")); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

With respect to the remaining goods and services in Classes 9, 28, 38 and 41 Opposer does not specifically address the description of goods or services for which Applicant seeks to register its mark. Rather, Opposer merely proffers that Applicant offers its goods and services in the same channels of trade and to the same classes of consumers as Opposer's goods and services as noted in the discussion regarding the

lack of any reported instances of confusion. In addition, Applicant admits that the same classes of consumers may encounter both Applicant's mark and Opposer's marks.¹⁵⁴ In view of the foregoing and on our review of the record, we find that the parties offer their goods and services in Classes 9, 28, 38 and 41 in some of the channels of trade to some of the same classes of consumers.

F. The variety of goods and services on which a mark is or is not used.

Opposer contends that because it uses its MONSTER marks on a wide range of products, consumers are more likely to be confused by Applicant's "similar mark," citing *Uncle Ben's, Inc. v. Stubenberg Int'l, Inc.*, 47 USPQ2d 1310, 1313 (TTAB 1998).¹⁵⁵ In *Uncle Ben's*, unlike here, the fact that Opposer applied its mark to a wide variety of products was significant, in part, because there was no evidence regarding the opportunity for confusion to occur, the products at issue were inexpensive food products meaning the average purchaser exercised less care in the purchasing decision, and the marks were similar. Because, in this proceeding, there have been no reported instances of actual confusion despite the opportunity for confusion to occur, especially considering the variety of goods on which and services in connection with Opposer uses its MONSTER marks and the overlapping channels of trade, as discussed above, we find this *DuPont* factor to be neutral.

G. Any other established fact probative of the effect of use – Applicant's bad faith intent in seeking to register CLEVELAND MONSTERS and design.

Opposer argues that Applicant intends to create a likelihood of confusion with

¹⁵⁴ Applicant's admission to Opposer's request for admission No. 3 (19 TTABVUE 169).

¹⁵⁵ Opposer's Brief, p. 45 (64 TTABVUE 52).

Opposer's MONSTER marks pointing to Applicant's admissions listed below:

- Applicant admitted that it was familiar with Opposer and its MONSTER marks before it selected and began using Applicant's CLEVELAND MONSTERS and design mark;

- Applicant admitted that, before Applicant began using the CLEVELAND MONSTERS Mark, it was aware of Opposer's use of the MONSTER marks in connection with sporting, music, and entertainment events; and

- Applicant admitted it was aware Opposer displayed its MONSTER marks at sporting events, and on clothing, stickers, decals, and sporting goods.¹⁵⁶

We do not infer that Applicant intended to create a likelihood of confusion with Opposer's MONSTER marks simply because Applicant was aware of Opposer's MONSTER marks. The facts listed below dispel any inference that Applicant acted in bad faith when it filed its applications at issue in this proceeding:

- Walgreen's co-sponsorship agreement between the parties discussed above in the lack of any reported instances of actual confusion section;

- The number of Applicant's registrations and third-party registrations incorporating the word MONSTER or MONSTERS;

- Applicant's prior registrations for LAKE ERIE MONSTER and design and CLEVELAND MONSTER marks to which Opposer did not object;¹⁵⁷ and

- The overall dissimilarity of the marks.

¹⁵⁶ Opposer's Brief, pp. 45-46 (64 TTABVUE 52-53).

¹⁵⁷ See the analysis of the prior registration defense below.

Accordingly, Applicant's intentions in filing the subject applications are not a significant factor in our likelihood of confusion analysis.


H. Conclusion

The factors that favor finding a likelihood of confusion include the commercial strength of Opposer's MONSTER marks in connection with beverages, the relatedness of the goods and services in International Classes 14, 16, 25, 35 and 41, and the similarity in the channels of trade and classes of consumers. The countervailing factors that weigh against finding a likelihood of confusion are the conceptual or inherent weakness of Opposer's MONSTER marks, the lack of any reported instances of actual confusion despite the opportunity for confusion to occur and the dissimilarity of the marks. The lack of any reported instances of confusion and the dissimilarity of the marks carry greater weight in our analysis. *See Citigroup*, 98 USPQ2d at 1261 (varying weights may be assigned to each *DuPont* factor depending on the evidence presented); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). We find, therefore, that Applicant's mark CLEVELAND MONSTERS and design for the applied for goods and services is not likely to cause confusion with Opposer's MONSTER, MONSTER ENERGY, and M MONSTER ENERGY and design marks for the goods and services in connection which Opposer has registered and uses those marks.

In the event Opposer appeals this decision and a reviewing court reverses our finding that there is no likelihood of confusion, we turn to Applicant’s affirmative defenses. The affirmative defenses assume a finding of likelihood of confusion.

VI. Prior Registration Defense

As its first affirmative defense, Applicant pleaded the prior registration defense based on its ownership of the registrations listed below:¹⁵⁸

Mark:	Reg. No.	Reg. Date	Goods/Services	Int’l Class
CLEVELAND MONSTERS	5,482,815	May 29, 2018	toys, games and sporting goods, namely, hockey pucks and hockey sticks; bobblehead action figures; stuffed toys	28
CLEVELAND MONSTERS	5,482,814	May 29, 2018	paper banners and flags, unmounted photographs, paper pennants, game schedules in the field of hockey	16
CLEVELAND MONSTERS	5,482,813	May 29, 2018	computerized on-line retail store, ordering, retail store services, electronic retail store services and mail-order catalog services featuring an array of hockey-themed merchandise	35
CLEVELAND MONSTERS	5,460,834	May 1, 2018	earrings; jewelry; jewelry and imitation jewelry; costume jewelry; rings	14
	3,890,431	Dec. 14, 2010	paper pennants	16
			T-shirts, shirts, polo shirts, sweatshirts, jerseys, hats, caps, jackets.	25
LAKE ERIE MONSTERS	3,897,555	Dec. 28, 2010	T-shirts, shirts, jerseys, hats, caps	25

The prior registration or *Morehouse* defense is an equitable defense, to the effect that if the opposer cannot be further injured because there already exists an injurious

¹⁵⁸ Amended Answer to Opposer’s Notice of Opposition ¶¶39 (11 TTABVue 27-28).

registration, the opposer cannot object to an additional registration that does not add to the injury. In *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969), the court explained the principle as follows:

[A]s a matter of law, the opposer cannot be damaged, within the meaning of *section 13* of the statute, by the issuance to the applicant of a second registration where applicant already has an existing registration of the same mark for the same goods. Implicit in this are corollaries that if opposer cannot procure the cancellation of the existing registration it cannot prevent the granting of the second registration; that there is no added damage from the second registration of the same mark if the goods named in it are in fact the same, and that if there is no added damage there is no ground for sustaining the opposition.

160 USPQ at 717.

The prior registration defense requires that the prior registered mark and the mark sought to be registered be essentially the same and for the same or substantially identical goods or services. *O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 36 USPQ2d 1041, 1045-46 (Fed. Cir. 1995); *Citigroup*, 94 USPQ2d at 1651-53; *James River Petroleum Inc. v. Petro Stopping Centers L.P.*, 50 USPQ2d 1702, 1703; *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989).

In certain circumstances, the prior registration defense may apply even if there are clear differences in the defendant's marks. See *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 U.S.P.Q. 1022, 1023 (TTAB 1983). In *Place for Vision*, the Board held that, as a matter of law, there could be no likelihood of confusion because, despite the clear differences in the previously registered mark (VISION CENTER) and the contested mark (PEARLE VISON CENTER and design), said differences

were irrelevant to the harm alleged by plaintiff. That is, opposer's claim of damage related solely to the VISION CENTER portion of the mark, not the term PEARLE or the design element.

Likewise, in the case before us, Opposer's claim of damage refers to Applicant's use of the word "Monsters," not the names "Cleveland" or "Lake Erie" or the design element. The differences in Applicant's marks is not a basis for denying the prior registration defense.

We now analyze the descriptions of goods and services.

1. Registration No. 5482815 for the mark CLEVELAND MONSTERS, in standard character form, for "toys, games, and sporting goods, namely, hockey pucks and hockey sticks; bobblehead action figures; stuffed toys," in Class 28. Application Serial No. 87548887 is for "toys, games and sporting goods, namely, hockey pucks and hockey sticks; **hockey kits comprised of hockey pucks, hockey sticks and hockey goalie pads**; bobblehead action figures; stuffed toys," in Class 28. (Emphasis added). Because the goods are different, the prior registration defense does not apply.
2. Registration No. 5482814 for the mark CLEVELAND MONSTERS, in standard character form, for "paper banners and flags, unmounted photographs, paper pennants, game schedules in the field of hockey," in Class 16. Application Serial No. 87547252 is for "publications and printed matter, namely, stickers, decals, memo pads, note pads, ballpoint pens, pencils, paper banners and flags, stationery folders, wire-bound notebooks, portfolio

notebooks, unmounted and mounted photographs, calendars, bumper stickers, statistical books, guide books, and reference books in the field of hockey; magazines in the field of hockey; catalogs featuring hockey; commemorative game and souvenir programs in the field of hockey; paper pennants, stationery and printed certificates in the field of hockey; entertainment printed certificates for fans; statistical information sheets for hockey topics; newsletters, brochures, pamphlets and game schedules in the field of hockey; bank checks; credit cards not magnetically coded,” in International Class 16. Because the goods are different, the prior registration defense does not apply.

3. Registration No. 5482813 for the mark CLEVELAND MONSTERS, in standard character form, for “computerized on-line retail store, ordering, retail store services, electronic retail store services and mail-order catalog services featuring an array of hockey-themed merchandise,” in International Class 35. Application Serial No. 87548901 is for “computerized on-line retail store, ordering, retail store services, electronic retail store services and mail-order catalog services featuring an array of hockey-themed merchandise; promoting the goods and services of others by allowing sponsors to affiliate these goods and services with a hockey program; promoting the sale of goods and services of others through the distribution of promotional contests provided over the Internet; conducting public opinion poll surveys and public opinion poll surveys in the field of hockey for business and non-business and marketing and non-marketing purposes over the Internet; conducting interactive public opinion

polls in the field of hockey,” in International Class 35. Because the services are different, the prior registration defense does not apply.

4. Registration No. 5460834 for the mark CLEVELAND MONSTERS, in standard character form, is “for earrings; jewelry; jewelry and imitation jewelry; costume jewelry; rings,” in International Class 14. Application Serial No. 87546801 is for “costume jewelry; earrings; jewelry and imitation jewelry; pendants; rings; **watches**,” in International Class 14. (Emphasis added). Because the goods are different, the prior registration defense does not apply.
5. Registration No. 3980431 is for the mark LAKE ERIE MONSTERS and design for “paper pennants,” in International Class 16, and “t-shirts, shirts, polo shirts, sweatshirts” and “jerseys,” “hats, caps,” and “jackets,” in International Class 25. Application Serial No. 87547252 for goods in International Class 16, discussed in No. 2, identifies far more than “paper pennants.” Application Serial No. 87547147 is for “**athletic pants**; caps being headwear; **coats**; **gloves**; **gym pants**; hats; jackets; **jogging pants**; **pants**; polo shirts; **scarves**; shirts; **sports pants**; **sports shirts**; **sweat pants**; sweat shirts; t-shirts; **tops as clothing**; **warm-up suits**; wind resistant jackets,” in International Class 25. (Emphasis added). Because the goods are different, the prior registration defense does not apply.
6. Registration No. 3897555 for the mark LAKE ERIE MONSTERS, in standard character form, is for “t-shirts, shirts,” and “jerseys, hats, caps,” in International Class 25. Application Serial No. 87547147 discussed

immediately above identifies far more products than in the prior registration.

Because the goods are different, the prior registration defense does not apply.

In sum, because the goods and services in the applications at issue differ from the goods and services in Applicant's prior registrations, the prior registration defense does not apply.

VII. Laches, estoppel, acquiescence and waiver.

A. Laches

Applicant argues that laches applies because Opposer failed to object to Applicant's above-noted prior registrations for LAKE ERIE MONSTERS and design and CLEVELAND MONSTERS.¹⁵⁹ However, in an opposition, laches cannot begin to run prior to when the mark was published for opposition. *Nat'l Cable Tele. Ass'n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Accordingly, Applicant's laches affirmative defense is inapplicable here.

B. Acquiescence

Acquiescence is a type of estoppel that is based upon the plaintiff's conduct that expressly or by clear implication consents to, encourages, or furthers the activities of the defendant, to which plaintiff has not objected. *Christian Broadcasting Network, Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1573 (TTAB 2007); *Hitachi Metals Int'l v. Yamakyu Chain Kabushiki*, 209 USPQ 1057, 1067 (TTAB 1981); *CBS, Inc. v. Man's Day Publ'g Co., Inc.*, 205 USPQ 470, 473-74 (TTAB 1980). A plaintiff will not be

¹⁵⁹ Applicant's Brief, p. 31 (66 TTABVUE 38).

permitted to stop conduct that it fostered or tolerated, where the result would be prejudicial to the defendant. *Id.*

Applicant argues that Opposer's likelihood of confusion claim is barred by acquiescence based on the 2008 Walgreens promotional agreement discussed in the section of this decision on the lack of any reported instances of actual confusion.¹⁶⁰ Applicant explains that the parties entered into a business agreement whereby the parties' MONSTER marks appeared together in displays promoting the parties goods and services. Opposer's Chairman and Chief Executive Officer testified, "[t]he Walgreens Agreement provided customers opportunities to win tickets to Cleveland Cavaliers professional NBA basketball games, Lake Erie Monsters minor league hockey games, or Quicken Loans Arena concert events by purchasing Monster products from the aforementioned newly acquired shelf space."¹⁶¹

Nevertheless, Opposer argued that it did not acquiesce to Applicant's use of the CLEVELAND MONSTER marks because the "primary purpose of the Walgreens Agreement was to secure and protect shelf space for MONSTER beverages at Walgreens locations,¹⁶² the agreement "had little impact on Opposer's goal of securing desired shelf space,"¹⁶³ Applicant provided no evidence of co-branding,¹⁶⁴ and "the

¹⁶⁰ Applicant's Brief, p. 28 (66 TTABVUE 35).

¹⁶¹ Sacks Rebuttal Testimony Decl. ¶3 (62 TTABVUE 3).

¹⁶² Opposer's Rebuttal Brief, p. 11 (67 TTABVUE 17).

¹⁶³ Opposer's Rebuttal Brief, p. 12 (67 TTABVUE 18).

¹⁶⁴ *Id.*

Walgreens Agreement is not evidence of consent by Monster to use of any trademarks, let alone all “MONSTER-formative” trademarks.”¹⁶⁵

Based on the record in this case, Opposer had full knowledge of Applicant’s activities by virtue of having entered into an agreement with Applicant to provide MONSTER ENERGY beverage customers a chance to win LAKE ERIE MONSTERS hockey tickets. Opposer did not express, at any time, any concern that Applicant was using or had registered the word “Monsters” as part of the name of its hockey team. Under these circumstances, Opposer’s silence as to Applicant’s use and registration of the word “Monsters” as part of the mark LAKE ERIE MONSTERS constitutes acquiescence regarding Applicant’s use and registration of the word “Monsters” as part of its CLEVELAND MONSTERS mark.

C. Confusion is not inevitable

Our finding that Opposer’s silence regarding Applicant’s use and registration of the word “Monsters” as a part of its mark constitutes acquiescence leads to the question of whether the likelihood of confusion arising from the registration of Applicant’s mark is inevitable. In cases where an application has pleaded and proved an equitable defense, it is necessary to decide whether likelihood of confusion is inevitable or reasonably debatable because the equitable defenses of laches and acquiescence are barred if confusion is inevitable. *Ultra-White Co., Inc. v. Johnson Chem. Indus., Inc.*, 465 F.2d 891, 175 USPQ 166, 167 (CCPA 1972); *Christian Broadcasting Network, Inc. v. ABS-CBN Int’l*, 84 USPQ2d at 1573; *Reflange Inc. v.*

¹⁶⁵ *Id.*

R-Con Int'l, 17 USPQ2d 1125, 1141 (TTAB 1990); *Hitachi Metals Int'l v. Yamakyu Chain Kabushiki*, 209 USPQ 1057,1069 (TTAB 1981). This is so because any injury to Applicant caused by Opposer is outweighed by the public's interest in preventing confusion. *Christian Broadcasting Network, Inc. v. ABS-CBN Int'l*, 84 USPQ2d at 1573-74; *Turner v. Hops Grill & Bar, Inc.*, 52 USPQ2d 1310, 1313 (TTAB 1999), *citing* *Coach House Rest. Inc. v. Coach and Six Rests., Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1409 (11th Cir. 1991).

The simultaneous use of Opposer's MONSTER marks in connection with beverages and associated collateral merchandising products and promoting and sponsoring of sporting events, including hockey, and Applicant's LAKE ERIE MONSTERS and design mark since 2007 and Applicant's CLEVELAND MONSTERS and design mark since 2016 in connection with hockey and associated collateral merchandise, proves, not only that there has been a reasonable opportunity for actual confusion, but that confusion is not inevitable.

Decision: The opposition is dismissed.