



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2010 TMOB 212
Date of Decision: 2010-12-02

**IN THE MATTER OF AN OPPOSITION
by Monster Cable Products, Inc. to
application No. 1,349,306 for the trade-
mark MONSTER in the name of Monster
Daddy, LLC.**

The Pleadings

[1] On May 29, 2007 Monster Daddy, LLC (the Applicant) filed application number 1,349,306 to register the trade-mark MONSTER (the Mark), based on proposed use in association with the following wares:

Adhesives for general industrial and commercial use; chemicals for use in the manufacture of cleaning solutions; all purpose cleaners and wipes for multi-purpose uses; cleansing products, namely, laundry soaps and disposable wipes for household, commercial and industrial use; vehicle waxes; automotive lubricants and oils; all purpose disinfecting and sanitizing preparations (the Wares).

[2] The application was advertised on December 19, 2007 in the *Trade-marks Journal* for opposition purposes.

[3] Monster Cable Products, Inc (the Opponent) filed a statement of opposition on April 2, 2008. The Applicant filed a counter statement on June 25, 2008 in which it denied all grounds of opposition listed below.

[4] The Opponent filed the affidavit of David Tognotti and certificates of authenticity for each of the registrations identified in its statement of opposition while the Applicant filed the affidavit of Sara Ann Layfield as well as a certified copy of the file history of Canadian application 1,386,992 for the registration of the trade-mark MONSTER, owned by the Opponent. There was no cross-examination of the deponents. No reply evidence was filed in the record.

[5] Both parties filed written arguments and only the Opponent was represented at an oral hearing.

The Grounds of Opposition

[6] The grounds of opposition pleaded are:

1. The application does not comply with the provisions of s. 30(i) the *Trade-marks Act*, R.C.S. 1985, c. T-13 (the Act) in that the Applicant could not have been satisfied that it was entitled to the use the Mark in Canada in association with the Wares in view of the prior adoption, use and registration by the Opponent of its trade-marks as set out hereinafter;
2. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the Opponent's previously registered trade-marks MONSTER, registration number TMA463392; MONSTER, registration number TMA655938; MONSTER, registration number TMA666620; MONSTER POWER, registration number TMA611734; MONSTER POWER registration number TMA455217; MONSTER CABLE registration number TMA444635; MONSTER CABLE registration number 664281; and MONSTER COMPUTER, registration number TMA530302;
3. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act because at all material times, the Mark was confusing with the Opponent's previously used trade-marks MONSTER, MONSTER POWER, MONSTER CABLE and MONSTER COMPUTER in association with wares enumerated under the registrations identified above;
4. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act because at all material times, the Mark was confusing with the Opponent's previously used trade-marks MONSTER and MONSTER COMPUTER in association with cleaning products; cleaning preparations, namely, solutions for cleaning electronic equipment and displays; cleaning wipes; and cleaning cloths;

5. The Mark is not distinctive of the Applicant's Wares, nor is it adapted to distinguish the Applicant's Wares from the wares of the Opponent for the reasons set out above.

Onus and Burden of Proof in Trade-marks Opposition Proceedings

[7] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325; *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

Relevant dates

[8] The relevant date for the analysis of each ground of opposition varies depending on the ground of opposition to be assessed:

- Non-compliance with the requirements of s. 30 of the Act: The filing date of the application (May 29, 2007);
- The registrability of the Mark under s. 12(1)(d) of the Act: The date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)];
- Entitlement to the registration of the Mark, where the application is based on proposed use: The filing date of the application (May 29, 2007) [see s. 16(3) of the Act];
- Distinctiveness of the Mark: The filing date of the statement of opposition (April 2, 2008) is generally accepted to be the relevant date [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Ground of Opposition based on s.30(i) of the Act

[9] The Applicant has provided the statement required by s. 30(i) of the Act that it is satisfied that it is entitled to use the Mark in Canada in association with the Wares. The mere fact that the Opponent adopted, use and registered its trade-marks prior to the filing date of the Applicant's application does not mean that the Applicant could not have been satisfied that it was entitled to register the Mark in Canada in association with the Wares. The Applicant could still state, in good faith, that it was entitled to register the Mark in Canada in association with the Wares.

[10] Normally, this ground of opposition will succeed if exceptional circumstances had been proven, such as evidence of the Applicant's bad faith [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. There is no evidence on file of that nature. Consequently, the first ground of opposition is dismissed.

The Fourth Ground of Opposition

[11] The Opponent is alleging that the Applicant is not entitled to the registration of the Mark because at all material times, the Mark was confusing with the Opponent's previously used trade-marks MONSTER and MONSTER COMPUTER in association with cleaning products; cleaning preparations, namely, solutions for cleaning electronic equipment and displays; cleaning wipes and cleaning cloths.

[12] The Opponent must show that it had previously used its trade-marks and had not abandoned such use at the advertisement date of the application (December 19, 2007) [see s.16(5) of the Act].

[13] Mr. Tognotti has been the General Counsel and Vice-President of Administration for the Opponent. He alleges that the Opponent is the world's leading manufacturer of high performance cables that connect audio/video components for home, car and professional use as well as computers and computer games. I shall first describe the evidence of use of the Opponent's trade-marks MONSTER and MONSTER COMPUTER in association with cleaning products and cleaning preparations.

[14] He alleges that the MONSTER trade-marks (a defined term in Mr. Tognotti's affidavit that refers to all of the Opponent's registered trade-marks listed above) have been used in Canada by the Opponent and its predecessors in title for more than 20 years in association with cleaning products; cleaning preparations, namely, solutions for electronic equipment and displays; cleaning wipes; and cleaning cloths (referred to in his affidavit as the MONSTER cleaning products).

[15] He filed as Exhibit 2 to his affidavit copies of excerpts from the Opponent's 2006 Canadian Price Book showing some cleaning products for television screens being offered for sale in association with the trade-mark MONSTER. Exhibit 4 are invoices predating the relevant date evidencing the sale in Canada of products in association with the trade-mark MONSTER, including cleaning products.

[16] Mr. Tognotti also provides the annual sales figures in units sold in Canada of cleaning products bearing the trade-mark MONSTER. They vary from close to 14,000 units in 2003 to more than 200,000 units in 2007. He alleges that the cleaning products bearing the trade-mark MONSTER are available at Best Buy, Future Shop, The Source by Circuit City and London Drugs to name a few. Finally he filed extracts of the Opponent's website to illustrate the cleaning products bearing the trade-mark MONSTER on their packaging.

[17] From this evidence I conclude that the Opponent has met its initial burden under s. 16 of the Act to prove that it has used in Canada the trade-mark MONSTER in association with cleaning products. However there has been no evidence of prior use of its trade-mark MONSTER COMPUTER. Consequently the Applicant must demonstrate, on a balance of convenience, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark MONSTER.

[18] The test to determine this issue is set out in s. 6(2) of the Act wherein it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares are of the same general class. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the

trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[19] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]. I also refer to the decisions of the Supreme Court of Canada in *Mattel, Inc. supra* and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under s. 6(5) of the Act to determine if there is a likelihood of confusion between two trade-marks.

[20] The Mark and the Opponent's trade-mark MONSTER are inherently distinctive when used in association with the Wares and cleaning products respectively, as they are not descriptive of any of those products. The distinctiveness of a trade-mark may be enhanced through use or promotion in Canada.

[21] I already described the Opponent's evidence of use of its trade-mark MONSTER in association with cleaning products. It is known to some extent in Canada. A lot of the Opponent's evidence deals with the use of the trade-mark MONSTER and other trade-marks of the Opponent in association with cables and connectors and electric power equipment. However the use of the Opponent's trade-mark MONSTER in association with those wares is less pertinent for the analysis of this ground of opposition limited in the statement of opposition to cleaning products.

[22] The Applicant's evidence does not include any evidence of use or promotion of the Mark in Canada in association with any of the Wares. Consequently the first factor listed under s. 6(5) of the Act favours the Opponent.

[23] There is no evidence of use of the Mark in Canada while there is evidence of use of the trade-mark MONSTER in Canada in association with cleaning products since at least 2003. The second relevant criteria listed under s. 6(5) of the Act does favour the Opponent.

[24] As for the nature of the parties' respective wares, there is clearly an overlap between the Opponent's cleaning products and Applicant's wares described as "all purpose cleaners and wipes for multi-purpose uses; cleansing products, namely, laundry soaps and disposable wipes for household, commercial and industrial use" (hereinafter referred to as the Applicant's cleaning products). The Applicant, in its written argument, argues that the purpose of the parties' respective cleaning products is different. I have no evidence as to the purpose of the Applicant's cleaning products except that it is for household, commercial and industrial use. There is no indication in the description of the Wares that they could not be used to clean television screens and other electronic equipment that may be found in a house or in a commercial or industrial environment. As for the other wares covered by the application, I do not see any overlap with the Opponent's cleaning products.

[25] In general, when considering the nature of the trade of the parties, it is the statement of the wares in the application that governs. [See *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)] Evidence of the actual trades of the parties could be useful in reading the statement of wares with a view of determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. [See *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.)].

[26] Ms. Layfield has been an executive assistant with the Applicant since 2007. She does not describe the Applicant's activities in her affidavit. In the absence of a description of the Applicant's business, I must rely on the description of the wares in the application. As I have already determined that there exists an overlap between the Opponent's cleaning products and the Applicant's cleaning products, I assume that they could be sold through the same channels of trade.

[27] Consequently the third and fourth criteria defined in s. 6(5) of the Act favour the Opponent in part in so far as the Applicant's cleaning products are concerned. As for the other Applicant's wares those criteria favour the Applicant.

[28] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery*

Co. v. Regal Bedding & Upholstering Ltd. (1980), 47 C.P.R. (2d) 145]. The Mark is identical to the Opponent's trade-mark MONSTER. This criteria also favours the Opponent.

[29] The Registrar may also consider other relevant circumstances put in evidence by the parties. Most of the evidence contained in the affidavit of Ms. Layfield relates to the state of the register in the United States. The Applicant is trying to demonstrate that in the United States the parties' respective trade-marks have been able to co-exist on the register. However, co-existence on foreign trade-mark registers is to be accorded little weight [see for example, *Quantum Instruments, Inc. v. Elinca S.A.*, 60 C.P.R. (3d) 264 at 268-9 (T.M.O.B.)]. This is because there may be other factors that justify the co-registration of marks in a foreign jurisdiction that do not exist in Canada (*e.g.* differences in the law or a different state of the register).

[30] The Applicant produced a certified copy of the file history for application 1,386,992 for the trade-mark MONSTER filed by the Opponent on March 5, 2008 in association with cleaning preparations, cloths and cleaning wipes and canned pressurized gases for dusting and cleaning purposes. The application was filed on the basis of registration and use in the United States and proposed use in Canada. In such application the Opponent is claiming a priority date of September 7, 2007 which would be after the filing date of the present application. In its written argument the Applicant claims that there is a contradiction between the content of Mr. Tognotti's affidavit where he alleges that the Opponent has used in Canada its trade-mark MONSTER in association with cleaning products for 20 years while application 1,386,992 is based on proposed use in Canada.

[31] Without determining if the content of an application filed by an opponent can be held against it, the application was filed subsequent to the relevant date associated with this ground of opposition. Therefore it does not constitute relevant evidence with respect to this ground of opposition. In any event, it is the Applicant's application that is the subject of this opposition. The statements made by Mr. Tognotti are contained in an affidavit and supported by actual evidence of use of the Opponent's trade-mark MONSTER. Finally there are no ambiguities in Mr. Tognotti's affidavit with respect to the use of the Opponent's trade-mark MONSTER in Canada prior to the Applicant's filing date of its application.

[32] In its written argument the Opponent argues that it owns a family of trade-marks wherein the word “monster” is part of those trade-marks. The fact that the Opponent is the registered owner of many trade-marks in Canada incorporating such word is not sufficient to benefit from a wider protection associated with the existence of a family of trade-marks. There must be evidence of actual prior use of those trade-marks [see *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101].

[33] The Opponent has established prior use of the trade-mark MONSTER CABLE in association with cables. I refer to the packaging filed as exhibit 1 and the invoices filed as exhibit 4 to Mr. Tognotti’s affidavit. There is no evidence of use of the trade-marks MONSTER COMPUTER and MONSTER POWER. There are illustrations of packaging bearing those trade-marks as part of exhibit 1 to Mr. Tognotti’s affidavit but there are no invoices or other evidence establishing sales in Canada of products bearing those trade-marks.

[34] I wish to point out that, as evidence of use of its trade-mark MONSTER, the Opponent is relying on the catalogue filed as Exhibit 2 to Mr. Tognotti’s affidavit. That catalogue by itself does not establish prior use of the trade-mark MONSTER in Canada in association with any of the Opponent’s products, including cleaning products. Despite the fact that there might be a copyright notice on the catalogue, which predates the filing date of the present application, this notice does not prove that there has been any transfer of property of any goods, illustrated in such catalogue, in Canada.

[35] The Opponent has not shown use of a family of MONSTER trade-marks and therefore I do not consider such argument to be a relevant surrounding circumstance.

[36] From this analysis I conclude that the Applicant failed to discharge its burden to prove, on a balance of probabilities, that there was no likelihood of confusion at the relevant date between the Mark and the Opponent’s trade-mark MONSTER, when used in association with all purpose cleaners and wipes for multi-purpose uses; cleansing products, namely, laundry soaps and disposable wipes for household, commercial and industrial use. The Mark is identical to the Opponent’s trade-mark MONSTER and there is a similarity between the Applicant’s cleaning products and those of the Opponent. However, I consider that there is no likelihood of confusion between the parties’ trade-marks when the Mark is used in association with adhesives for general

industrial and commercial use; chemicals for use in the manufacture of cleaning solutions; vehicle waxes; automotive lubricants and oils; all purpose disinfecting and sanitizing preparations as there is no connection between those wares and the cleaning products of the Opponent.

[37] Consequently the fourth ground of opposition is partially maintained.

Registrability of the Mark under s. 12(1)(d) of the Act

[38] The Opponent has met its initial burden by filing certificates of authenticity for each of the registered trade-marks identified under that ground of opposition. I checked the register and they are all extant. The most relevant registrations are those for the trade-mark MONSTER, namely: TMA463,392; TMA655,938; TMA666,620. However none of those as well as the other registrations owned by the Opponent covers cleaning products. They include the following wares:

Cables and connectors for various types of cable, including power cables, audio cables and video cables;
Electric power equipment, such as fuse blocks, surge protectors and capacitors;
Video games, video game machines for use with a television, and accessories for video game machines;
Audio stereo equipment;
Mobile phone equipment, such as cell phone battery chargers;
Batteries; and
Newsletters and magazines, regarding industry news.

[39] There is evidence of use of the trade-mark MONSTER in Canada in association with some of these wares. However the difference between the nature of those wares and the Wares leads me to conclude that, even though the Mark is identical to the trade-marks covered by those 3 cited registrations, there is no likelihood of confusion between the trade-marks of the respective parties. Consequently, the second ground of opposition is dismissed.

Ground of Opposition based on Lack of Distinctiveness of the Mark

[40] To meet its initial onus the Opponent had to prove that its trade-marks had become sufficiently known on April 2, 2008, the filing date of the statement of opposition, to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58]. I

shall limit my analysis to the Opponent's use of the trade-mark MONSTER in association with the Opponent's cleaning products as it provides the best opportunity for the Opponent to be successful under this ground of opposition.

[41] The Opponent's evidence of use of the trade-mark MONSTER in association with its cleaning products has already been described. It does establish that the Opponent's trade-mark MONSTER, used in association with such wares, was sufficiently known in Canada at the relevant date and thus the Opponent has met its initial evidential burden. The Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the Opponent's aforesaid trade-mark such that it was adapted to distinguish or actually distinguished throughout Canada the Wares from the Opponent's wares [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272].

[42] The issue to be decided remains the likelihood of confusion between the Mark and the Opponent's aforesaid trade-mark. The difference in the relevant dates between this ground of opposition and the fourth ground of opposition would not influence my analysis of the various relevant factors considered. My conclusion is that the Mark was not distinctive and was not apt to distinguish, at the relevant date, the Applicant's cleaning products from the Opponent's cleaning products bearing the trade-mark MONSTER. Consequently this ground of opposition is also maintained in part.

The Third Ground of Opposition

[43] This ground is similar to the fourth ground of opposition except that it is based on prior use of the Opponent's trade-marks MONSTER and MONSTER COMPUTER in association with the wares covered by the registrations of these trade-marks. The Opponent is not relying under this ground of opposition on prior use of its trade-mark MONSTER in association with cleaning products.

[44] The difference between the nature of the Opponent's wares, as described in paragraph 37 above, and the Wares is sufficient to conclude that there is no likelihood of confusion between the trade-marks of the respective parties. Consequently, this ground of opposition is dismissed.

Disposition

[45] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to:

All purpose cleaners and wipes for multi-purpose uses; cleansing products, namely, laundry soaps and disposable wipes for household, commercial and industrial use;

and reject the opposition with respect to:

Adhesives for general industrial and commercial use; chemicals for use in the manufacture of cleaning solutions; vehicle waxes; automotive lubricants and oils; all purpose disinfecting and sanitizing preparations;

pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office