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Mailed:
February 2, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Monster Cable Products, Inc. and Monster Cable International, Ltd.
v.
Tecmo, Ltd. and Tecmo Kabushiki Kaisha

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Opposition No. 91154125
Opposition No. 91154136
Opposition No. 91158681
Cancellation No. 92041581

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Brent A. Capehart of LaRiviere, Grubman & Payne, LLP for Monster Cable Products, Inc. and Monster Cable International, Ltd.

Paul W. Garrity of Kelley, Drye & Warren LLP for Tecmo, Ltd. and Tecmo Kabushiki Kaisha.

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Before Quinn, Bucher, and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Monster Cable Products, Inc., a California corporation, and Monster Cable International, Ltd., a Bermuda corporation and wholly-owned subsidiary of Monster Cable Products, Inc. (hereinafter "opposers"), filed joint notices of opposition against the registration of the mark MONSTER RANCHER ADVANCE

proposed for use in connection with the following goods and services:[1]

> "Game software for computers or for amusement game machines," in Class 9; and,
>
> "Providing a computer game that may be accessed networkwide by network users," in Class 41.[2]

Monster Cable Products, Inc. (and not Monster Cable International, Ltd.) opposed the registration of the mark MONSTER RANCHER for the following products:[3]

> "Cellular telephone cases, decorative magnets, refrigerator magnets," in Class 9;
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> "Stickers; albums for use with trading cards; trading cards; calendars; paper wall scrolls; posters; clipboards; paper flags; paper banners; printed paper door signs; body decals; photo cards; sticker sheets; paper personal diaries; journals in the fields of animation, TV, games and toys; address books; letter sets consisting of letter files; letter openers and letter racks; temporary tattoos; pencil cases," in Class 16;
>
> "Wallets; purses; school bags; backpacks; tote bags; gym bags; waist packs; children's luggage; kiddie bags, namely, backpacks for children," in Class 18;
>
> "Washcloths and textile wall scrolls," in Class 24;
>
> "Clothing, namely, t-shirts, sweatshirts, knit shirts, shorts, pants, jogging shirts and pants,

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[1] Application Serial No. 76332973, filed October 31, 2001, based on intent to use. The application was filed by Tecmo, Ltd., a Japanese corporation.

[2] Opposers filed separate notices of opposition for each class: Opposition No. 91154125 (Class 41) and Opposition No. 154136 (Class 9). Proceedings were consolidated in the Board's December 31, 2003 Order.

[3] Application Serial No. 76389408, filed March 28, 2002, based on intent to use. The application was filed by Tecmo, Ltd.

> children's masquerade costumes, caps, hats, gloves, tank tops, long sleeve t-shirts, nightshirts, sleepwear, pajamas, nightgowns, house robes, underwear, boxer shorts," in Class 25; and,
>
> "Toy walkie-talkies, dolls, toy action figures, toy vehicles other than motorcycles, motor scooters, or all terrain vehicles, yo yo's, toy sculpture kits comprised of toy molds and modeling compounds sold as a unit, role playing games, jigsaw puzzles, shuffle puzzles, cube puzzles, toy model vehicle kits of vehicles other than motorcycles, motor scooters, or all terrain vehicles, skate boards, snowboards, surfboards, hand puppets, collectible card games, costume masks; playing cards," in Class 28.[4]

Opposers also petitioned to cancel Registration No. 2268436 for the mark MONSTER RANCHER for "video game cartridges."[5]

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[4] The application is the subject of Opposition No. 91158681. This opposition was consolidated with the other proceedings in the Board's December 21, 2004 Order.

[5] Registration No. 2268436, issued August 10, 1999: Section 8 affidavit accepted. Registrant claimed November 17, 1997 as its dates of first use.

Opposers identified Tecmo, Inc. as the registrant. However, when the petition for cancellation was filed, January 21, 2003, the owner was Tecmo Kabushiki Kaisha, a Japanese corporation. The registration was assigned to Tecmo Kabushiki Kaisha from Tecmo, Inc. in an assignment dated September 21, 2001, and recorded in the Assignment Section of the U.S. Patent and Trademark Office on October 9, 2001, at reel 2378, frame 0821.

In their "Certification of Notice of Related Proceedings," applicants explained that Tecmo, Inc. is a wholly owned subsidiary of Tecmo, Ltd. Applicants did not reference the assignment to Tecmo Kabushiki Kaisha. The assignment records and the trademark applications list the same address for Tecmo Kabushiki Kaisha and Tecmo, Ltd. In view of the foregoing, we consider Kabushiki Kaisha and Tecmo, Ltd. to be related companies. Cancellation No. 92041581 was consolidated with the oppositions in the Board's December 31, 2003 Order.

Tecmo, Ltd. and Tecmo Kabushiki Kaisha are hereinafter referred to as "applicants."

The allegations of likelihood of confusion in the oppositions and the cancellation are for all practical purposes the same. As grounds for opposition and cancellation, opposers allege that applicants' marks MONSTER RANCHER ADVANCE and MONSTER RANCHER, if used in connection with applicant's goods and services, so closely resemble opposers' family of famous MONSTER trademarks as to be likely to cause confusion, to cause mistake, and to deceive. As a separate ground for opposition and cancellation, opposers allege that their "MONSTER and family of MONSTER marks are entitled to famous mark protection, and Applicant's use will dilute or tend to dilute said marks." In the oppositions, opposers pleaded ownership of twenty-five (25) U.S. trademark registrations and, in the cancellation, opposers pleaded ownership of twenty-two (22) U.S. trademark registrations.

Applicants denied the salient allegations in the notices of opposition and the petition for cancellation.

The Record

By operation of the rules, the record includes the pleadings and the files of the applications being opposed and registration sought to be canceled. The parties have also made of record the following testimony and evidence:

1. Testimony deposition of Rusty Everett, opposers' Director of Product Development, and the attached exhibits;

2. Testimony deposition of Keith Vena, paralegal for applicants' counsel, and the attached exhibits; and,

3. Applicants' notice of reliance consisting of the following documents:

   A. Third-party trademark registrations printed from the United States Patent and Trademark Office TARR database;

   B. Dictionary definitions of the word "Monster";

   C. Reviews from the November 2005 issue of *Electronic Gaming Monthly;* and,

   D. Review archive from the November, 2005 issue of the *Official PlayStation Magazine*.

Preliminary Issues

1. Opposers' objection to the testimony deposition of Keith Vena.

Opposers object to the entire testimony of applicants' witness, Keith Vena, and all the exhibits introduced in his deposition pursuant to Fed. R. Evid. 403 based on applicants' failure to provide opposers with copies of applicants' exhibits before or during the deposition. Opposers argue that they have been unfairly prejudiced because opposers were unable to completely cross-examine the witness without copies of the exhibits.

The facts surrounding this objection are not in dispute. On Tuesday, September 27, 2005, applicants noticed

the deposition of Keith Vena, a paralegal at the law firm representing applicants. The deposition was noticed for Tuesday, October 4, 2005 at 10:00 a.m. in New York, New York. Opposers' counsel, located in Monterey, California, arranged to attend the deposition via telephone. It was agreed by counsel that applicants would provide opposers with the exhibits to be used in the deposition prior to the deposition.[6]

On Monday, October 3, 2005, applicant sent the deposition exhibits to opposers via overnight courier for early delivery. However, due to the time difference between New York and Monterey, California, the overnight courier package with the exhibits did not arrive until after the deposition concluded.

Prior to the start of the deposition, opposers requested that the deposition be delayed until the exhibits arrived. Applicants declined to postpone the deposition. Applicants have given no reason for their refusal to postpone the deposition. Opposers argue that by not delaying the deposition, applicants prevented opposers from

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[6] Applicants describe the agreement to provide copies of the exhibits as follows: "As a courtesy, Tecmo's counsel agreed to pre-mark the exhibits that would be used at the deposition and, indeed, sent copies of those exhibits by overnight courier to Monster Cable's counsel for early delivery . . . It is because Tecmo agreed to extend the courtesy of both allowing Monster Cable's counsel to make a telephonic appearance and of pre-marking and overnighting the exhibits to Monster Cable's counsel, Monster Cable is seeking to punish Tecmo." (Applicants' Brief, pp. 5-6).

having access to the exhibits introduced and discussed by the witness. Thus, opposers were denied the opportunity to completely cross-examine the witness and, therefore, opposers have been unfairly prejudiced.

Applicants argue that opposers were not unfairly prejudiced because they had the opportunity to raise their objections prior to the briefing stage. Applicants contend that opposers could have availed themselves of the following alternatives:

1. Opposers could have attended the deposition in person;

2. Opposers could have sought a protective order from the Board prior to the start of the deposition; or,

3. Opposers could have filed a motion to strike the deposition immediately after the deposition was filed.[7]

Opposers' objection is sustained. The parties agreed that applicants would provide copies of the exhibits to opposers before the deposition. We interpret that to mean that the parties agreed that opposers would receive copies of the exhibits prior to the start of the deposition. Opposers relied, in part, on that agreement in making their decision to attend the deposition via telephone rather than in person. Despite agreeing to provide the exhibits for the

[7] Also, opposers could have filed a motion for leave to cross-examine applicants' witness immediately after its receipt of the exhibits.

deposition (scheduled for Tuesday, October 4, 2005, at 10:00 a.m. in New York City), applicants did not send the exhibits to opposers until Monday, October 3, 2005.

Prior to the start of the deposition and after being informed that the exhibits had not arrived, applicants, for no apparent reason, refused to postpone the deposition until the exhibits arrived. The witness was an employee at the law firm representing applicants and presumably was available for the deposition at any time. Under these circumstances, applicants' refusal to postpone the deposition was unreasonable.

The evidentiary problem with which we are now faced was created solely by applicants' unreasonable refusal to postpone the deposition. While opposers had alternatives to waiting until their brief to reassert its objection, opposers did, in fact, raise an objection prior to and during the deposition. Once opposers raised an objection to an issue that applicants could have corrected (*i.e.*, applicants' unreasonable refusal to postpone the deposition until the exhibits were delivered), opposers are not thereafter required to correct applicants' error. At that point, applicants proceeded with the deposition at their own risk.

Applicants' failure to postpone the deposition until after the exhibits arrived is far more egregious than

opposers' perceived failure to reassert its objection to the deposition prior to the briefing stage of the proceeding. In fact, this entire situation could have been avoided had applicants simply postponed the deposition until the exhibits had been delivered.

In view of the foregoing, opposers' objection to the testimony deposition of Keith Vena and the exhibits attached thereto is sustained and the deposition and exhibits will not be considered.

2. Opposers' hearsay objection to the exhibits in applicants' notice of reliance.

Opposers object to the exhibits in applicants' notice of reliance on the ground that they are inadmissible hearsay. As described above, the documents in the notice of reliance are copies of third-party trademark registrations, dictionary definitions, and game reviews. Opposers argue that applicants "will introduce these statements to show that the content of these statements are true." (Opposers' Brief, p. 5).

Applicants argue that third-party registrations are admissible as indicated in TBMP §703.03(b)(1)(B). With respect to the dictionary definitions and printed publications, applicants maintain that these documents are available to the general public in libraries and are in

general circulation. Therefore, they are admissible in accordance with 37 CFR §2.122(e) and TBMP § 704.08.

The documents proffered pursuant to the notice of reliance are admissible, not to prove the truth of the matter set forth in each individual document, but rather for what the documents show on their face (*e.g.,* that "Monster" has been registered to numerous third-parties and that applicants' computer games have been reviewed in various publications). *Blue Man Productions Inc. v. Tarmann,* 75 USPQ2d 1811, 1813 (TTAB 2005). To the extent that applicants seek to rely on the documents in the notice of reliance to prove the truth of the statements made therein, opposers' objection is well taken. However, the documents are acceptable to show that the registrations have been issued and that the stories have been published. Thus, we have considered the documents for that purpose.

3. Opposers' motion to amend its petition for cancellation to allege that the MONSTER RANCHER registration is void *ab initio*.

In their brief, opposers moved to amend their petition for cancellation to allege that Registration No. 2,268,436 for the mark MONSTER RANCHER is void *ab initio* because applicants did not use the mark prior to the filing date of their application. Opposers argue that even though applicants filed a use-based application for MONSTER

RANCHER, applicants did not introduce any evidence to show the use of their mark prior to the filing date of that application. Opposers concluded that applicants "failed to have the requisite bona fide use of the mark . . . at the time of the filing of the '069 Application" and, therefore, Registration No. 2,268,436 is void *ab initio*. (Opposers' Brief, pp. 21-22). Applicants argue that they will be unfairly prejudiced by opposers' attempt to raise this argument for the first time in opposers' brief, and that, in essence, except for the issue of likelihood of confusion, applicants were unaware of any other issues affecting the "validity" of the registration in this case.

In pertinent part, Fed. R. Civ. P. 15(b) provides the following:

> **(b) Amendments to Conform to the Evidence.**
>
> When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings. Such amendment of the pleadings as may be necessary to cause them to conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure to so amend does not affect the result of the trial of these issues.

TBMP §507.03(b) provides, in pertinent part, that "[i]mplied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no

objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue."

Opposers' motion to amend is not well taken. Our review of the record convinces us that the issue of whether the MONSTER RANCHER trademark application was void *ab initio* was not tried, either expressly or impliedly, by the parties as contemplated under Fed. R. Civ. P. 15(b). Simply put, because opposers did not plead or other introduce any evidence on that issue, applicants were not on notice that applicants' use of the MONSTER RANCHER mark as of the filing date of their application was an issue. *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984)(nothing in the record alerted defendant that plaintiff intended to use a third-party settlement agreement as a ground for cancellation and denied motion to amend); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998)(applicant was not on notice that descriptiveness was an issue, therefore, the motion to amend was denied). Inasmuch as the only pleaded ground for cancellation was priority of use and likelihood of confusion and opposers did not introduce any evidence regarding applicants' failure to use the MONSTER RANCHER mark prior to the filing of their application, applicants were not on notice that the validity of their use of the MONSTER RANCHER trademark prior to the

filing date of the application was an issue in this case. In view thereof, opposers' motion to amend their petition for cancellation is denied.

4. Applicants' request that the Board cancel Opposers' Registration No. 2,537,106 for the mark MONSTER GAME.

In their brief, applicants request that the Board, *sua sponte,* cancel opposers' Registration No. 2,537,106 for the mark MONSTER GAME on the ground of fraud because opposers have never used the mark in connection with any of the products listed in the description of goods. (Applicants' Brief, p. 14). Opposers argue that the Board should not cancel the MONSTER GAME registration because it is the subject of a separate cancellation proceeding between the parties (Cancellation No. 92043140).

Applicants' request that the Board cancel opposers' registration is not well taken. The validity of opposers' registration is not open to attack in this proceeding because it is not subject to a counterclaim to cancel and applicants' separate petition to cancel was not consolidated with these proceedings. So long as the registration relied on by opposers remains in force and effect, we must treat it as a valid registration. *Contour Chair-Lounge Co., Inc. v.*

The Englander Company, Inc., 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1968).[8]

In view of the foregoing, applicants' request that the Board cancel the MONSTER GAME registration is denied.

5. Applicants' laches defense.

Applicants argue that opposers claim of likelihood of confusion is barred by laches. Applicants contend that opposers solicited an endorsement from applicants to help sell a new audio-visual product that was launched in 2000. This means that opposers had actual knowledge of applicants' MONSTER RANCHER trademark since at least as early as 2000. Applicants conclude that they relied to their detriment on opposers' delay in asserting their purported rights in these proceedings by continuing to develop MONSTER RANCHER video games. (Applicants' Brief, p. 16). In opposition to applicants' laches defense, opposers argue that there is no evidence in the record to support the defense. (Opposers' Reply Brief, p. 5).

Applicants' assertion of laches is not well taken. Laches is an affirmative defense and as such it must be specifically pleaded. Fed. R. Civ. P. 8(c) and 12(b). *See*

[8] There is nothing in the record to indicate that opposers were on notice that applicants were attacking the validity of one of their registrations. Therefore, the validity of the MONSTER GAME registration was not tried by express or implied consent. Fed. R. Civ. P. 15(b).

also, U.S. Olympic Committee v. Bata Shoe Co., Inc., 225 UPSQ 340, 341 (TTAB 1984); *Hershey Foods Corp. v. Cerreta,* 195 USPQ 246, 251 (TTAB 1977). In this case, applicants have not pleaded laches as an affirmative defense, nor have they sought to amend the pleadings to conform to the evidence. Our review of the record does not indicate that laches was tried by the express or implied consent of the parties. In fact, the issue of laches was not raised by applicants until the submission of their brief. Thus, opposers, in prosecuting their likelihood of confusion claims, had no reason to present any evidence regarding laches. Accordingly, applicants may not now be heard to argue laches in their defense.[9]

6. Opposers have not proven that there is a "family" of "Monster" marks.

Opposers argue that since at least as early as 1979, opposers have continuously and extensively used the mark MONSTER in connection with a wide variety of products and that they own numerous federal registrations for MONSTER and marks incorporating the word "Monster." "This extensive use has allowed Monster [opposers] to build up a high degree of good will and recognition of it [sic] house mark, MONSTER and the family of MONSTER marks." (Opposers' Brief, pp. 7-

[9] In any event, opposers are correct that there is no evidence in the record to support a laches defense.

8). On the other hand, applicants argue that there is no evidence of any advertising or promotional activities to prove that there is a "Monster" family of marks, and that the family surname, "Monster," is suggestive, if not descriptive, of opposers' products and, therefore, not sufficiently distinctive to support a family of marks. (Applicants' Brief, pp. 22-23).

The Court of Appeals for the Federal Circuit has defined a family of trademarks as follows:

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

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

In order to create the requisite recognition of the common element of the marks or "family surname," the common element must be so extensively advertised that the public recognizes the "family surname" as a trademark. *Reynolds &*

Reynolds Co. v. I.E. Systems, Inc., 5 UPSQ2d 149, 1751 (TTAB 1987). The Board has made the following requirements:

> In order to establish a "family of marks," it must be demonstrated that the marks asserted to comprise its "family" or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

American Standard Inc. v. Scott & Fetzer Co., 200 USPQ 457, 461 (TTAB 1978). In the absence of direct testimony by purchasers, we must place ourselves in the position of average consumers and attempt to understand their reaction to the marks as they are encountered in the marketplace. *Id.* In this regard, the mere fact that opposers have registered many of the purported "family" members is not sufficient to prove that a family of marks exists. *Consolidated Foods Corp. v. Sherwood Industries, Inc.*, 177 USPQ 279, 282 (1973)("the registrations, per se, are manifestly incompetent to establish the extent of use of the registered marks, whether one or more of the registered marks have been promoted, advertised, used or displayed in any manner likely to cause an association or 'family' of marks, or that, at the least, a good number of the registrations have become known or familiar of frozen confections and the like").

Opposers' evidence supporting its family of "Monster" marks comprises a label for a fiber optic cable for digital surround sound displaying the MONSTER CABLE and MONSTER GAME trademarks (Everett Dep., Ex. 2), a printout from the MONSTER CABLE website displaying different "Monster" marks being promoted together (*e.g.,* "Ultra High Capacity Monster Game® Power Pack™ with 2 Monster PowerCells™ and Monster Digital Charger™.")(Everett Dep. Ex. 5), and testimony that the MONSTER CABLE or MONSTER GAME LINK and MONSTER GAME marks appear together on packaging. (Everett Dep. pp. 62-63). However, the record is silent as to the extent of such advertising and there are simply not enough examples of opposers' "Monster" marks advertised or promoted together. Therefore, the record in this case falls short of presenting the type of evidence necessary to support an allegation of a "family" of "Monster" trademarks. Accordingly, opposers' claim of likelihood of confusion must be based solely on their use of their individual "Monster" trademarks.

Priority

Although opposers pleaded twenty-five (25) registrations in their oppositions and twenty-two (22) registrations in their petition for cancellation, opposers did not submit status and title copies of the registrations with their pleadings or during their testimony period with a

notice of reliance. The copies of the registrations attached to the deposition of Rusty Everett are merely soft copies of the registrations and, more significantly, Mr. Everett did not testify as to the current status or validity of the registrations.[10] *See Alcan Aluminum Corp. v. Alcar Metals Inc.,* 200 USPQ 742, 744 n.5 (TTAB 1978). Therefore, opposers must rely on their common law use of their marks to prove their priority.

For purposes of priority, applicants' may rely on the filing dates of their applications. *Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc.,* 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Intersat Corp. v. Int'l Telecomm Satellite Org.,* 226 USPQ 154, 156 n.5 (TTAB 1985). The filing date of the application for the MONSTER RANCHER registration for video game cartridges is December 19, 1997. The filing date for the MONSTER RANCHER ADVANCE application (Serial No. 76332973) is October 31, 2001. The filing date for the MONSTER RANCHER application (Serial No. 76389408) is March 28, 2002. Thus, in order to establish priority, opposers must show that they first used their marks in connection with their goods prior to December 19, 1997, October 31, 2001, or March 28, 2002, depending upon which of applicants' marks is at issue.

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[10] Mr. Everett testified that the marks were still in use.

The table below summarizes the testimony of opposers' witness Rusty Everett regarding the first use of opposers' marks. The testimony was not supported by any documentary evidence.

Mark	**Goods**	**First Use**	**Dep. Page**
MONSTER	Electrical and musical signal transmitting cables and connectors	Since 1992	25
MONSTER COMPUTER	Computer related products, Ethernet, phone cables, interconnecting cables for computer devices	Early to mid-1990s	26
MONSTER MULTIMEDIA	Cables to connect computer systems, audio-visual connections	Mid-1990s	27
MONSTER NETWORKING	Networking cables, Ethernet cables, phone cables for connecting a computer or gaming systems to a modem or an infrastructure in a building	1995 to 1997 time frame	27-28
MONSTER INTERNET	Networking cables, Ethernet cables, phone cables for connecting a computer or gaming systems to a modem or an infrastructure in a building	1995	29
MONSTER GAME	Cables and accessories for the gaming industry (*i.e.*, PlayStation 2, Game Cube, and XBox platforms); Ethernet cables, audio/video connection cables; carrying cases for game consoles; speaker systems	2000 or 2001	15, 30
MONSTER ATTITUDE	Clothing, namely, t-shirts, sweatshirts, jackets, pants, and caps	July 2, 2001	33

Mark	Goods	First Use	Dep. Page
MONSTER BATTERY	Rechargeable and non-rechargeable power cells	June 29, 2001	33
MONSTER POWER	Electrical power control products, namely, batteries, power strip type electrical outlets, power line conditioners, and electrical power extension cords	February 1, 1992	34
MONSTER SPORT	Clothing, namely, t-shirts, jackets, hats, polo shirts and vests	April 1, 1992	35
MONSTER USB	USB cables and connector devices for computers and components	August 20, 2001	35-36
MONSTER LINKS	An online newsletter to disseminate information to customers	October 10, 1999	36-37
MONSTER GEAR	Clothing and other collateral merchandising products such as license plate frames, gym bags	Since at least 1992	48

During his cross-examination, Mr. Everett testified that MONSTER was not used as a stand-alone trademark in connection with the types of products exemplified by his deposition Exhibit 2 (a fiber optic cable for digital surround sound).

> Q. Is it - - is true that the - - the name or the mark that is on that body of products is Monster Cable, not the mark Monster?
>
> A. Well - - well, the mark is always Monster, as it is on other products, you know, Monster Power Cells. Monster Cable being the fact that these are cable products.

Q. Okay.

A. So it's Monster Cable because they're cables.

Q. Okay, But again - -

A. So yes that's correct.

Q. Oh, yeah, and just to use a specific example, you had already testified to it, would Exhibit 2 fall within what you were identifying broadly as the computer and gaming equipment that Monster Cable sells?

A. Yes.

Q. And that has the mark Monster Cable, not Monster as we previously reviewed.

A. That's correct.

(Everett Dep., pp. 66-67).[11]

Moreover, Mr. Everett's testimony regarding two of the MONSTER trademark registrations was incomplete or not credible. In his testimony regarding Registration No. 2,627,042 for the mark MONSTER for clothing, Mr. Everett did not state when the mark was first used. (Everett Dep., p. 31). With respect to Registration No. 2,575,745 for the mark MONSTER for "video game machines for use with televisions; and electronic game accessories, namely, electrical cables, electrical connectors and video game

[11] Mr. Everett also testified that the products in the MONSTER GAME line would display MONSTER GAME and MONSTER CABLE, but not MONSTER. (Everett Dep. pp. 62-63).

interactive remote control units", Everett did not testify from first-hand knowledge, rather he simply read the description of goods and recited the date of first use from the registration. (Everett Dep., p. 32). On cross-examination, Mr. Everett admitted that MONSTER had never been used in connection with video games for use with televisions or video game interactive remote control units. (Everett Dep. pp. 94-95).

Mr. Everett further testified that "Monster" is the "corporate entity" and that all of the other divisions and product areas incorporate the word "Monster" followed by a descriptive term (*e.g.*, MONSTER CABLE, MONSTER POWER CELLS, MONSTER MINTS). (Everett Dep., pp. 8-9, 87-88).

While Mr. Everett testified that every gaming and computer related product displays the MONSTER mark (Everett Dep. p. 25), it is not clear whether Mr. Everett means a MONSTER formative mark (*i.e.*, the word "Monster" followed by a descriptive term such MONSTER CABLE or MONSTER GAME) or MONSTER as a stand-alone mark.[12] In view of the ambiguity of Everett's testimony and the lack of any corroborating evidence, there is insufficient evidence to support the use of MONSTER as a stand-alone mark in determining the issue of priority.

[12] On redirect, Everett testified that "Monster" has been used with a modifier. (Everett Dep., p. 100).

With respect to applicants' MONSTER RANCHER trademark registration for video game cartridges (Registration No. 2,268,436 – priority date of December 19, 1997), opposers have proven priority with respect to the following marks:

1. MONSTER COMPUTER for computer related products, Ethernet, phone cables, interconnecting cables for computer devices (1992);
2. MONSTER MULTIMEDIA for cables to connect computer systems to audio-visual connections (mid-1990s);
3. MONSTER NETWORKING for networking cables, Ethernet cables for connection a computer or gaming system to a modem or an infrastructure in a building (1995 or 1997);
4. MONSTER INTERNET for networking cables, Ethernet cables for connection a computer or gaming system to a modem or an infrastructure in a building (1995);
5. MONSTER POWER for electrical power control products, namely, batteries, power strip type electrical outlets, power line conditioners, and electrical power extension cords (1992);
6. MONSTER SPORT for clothing (1992); and,
7. MONSTER GEAR for clothing and other collateral merchandising products such as license plate frames and gym bags (1992).

With respect to the MONSTER RANCHER ADVANCE trademark application (Serial No. 76332973 filed October 31, 2001) and the MONSTER RANCHER trademark application (Serial No. 76389408 filed March 28, 2002), opposers have proven priority for the following marks:

1. MONSTER COMPUTER for computer related products, Ethernet, phone cables, interconnecting cables for computer devices (1992);

2. MONSTER MULTIMEDIA for cables to connect computer systems to audio-visual connections (mid-1990s);

3. MONSTER NETWORKING for networking cables, Ethernet cables for connection a computer or gaming system to a modem or an infrastructure in a building (1995 or 1997);

4. MONSTER INTERNET for networking cables, Ethernet cables for connection a computer or gaming system to a modem or an infrastructure in a building (1995);

5. MONSTER GAME for cables and accessories for the gaming industry; Ethernet cables, audio-visual connection, cables; carrying cases for game consoles; speaker systems (2000 or 2001);

6. MONSTER ATTITUDE for clothing (July 2, 2001);

7. MONSTER BATTERY for rechargeable and non-rechargeable power cells (June 29, 2001);

8. MONSTER POWER for electrical power control products, namely, batteries, power strip type electrical outlets, power line conditioners, and electrical power extension cords (1992);

9. MONSTER SPORT for clothing (1992);

10. MONSTER USB for USB cables and connector devices for computers and components (August 20, 2001);

11. MONSTER LINKS for an online newsletter for disseminate information to customers (1999); and,

12. MONSTER GEAR for clothing and other collateral merchandising products such as license plate frames and gym bags (1992).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all 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). *See also, In re Majestic Distilling Company, Inc.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In this case, those facts include the fame of opposers' marks, the similarity or dissimilarity of the goods and services, the channels of trade, and the similarity or dissimilarity of the marks.

1. The fame of opposers' marks.

The fame of opposers' marks, if it exists, is a dominant factor in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Products, Inc.,* 293 F.3d 1307, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). A famous mark has extensive public recognition and renown. *Id.* Fame may be measured by, *inter alia,* the volume of sales and advertising expenditures of the goods associated with the marks. *Id.*

Opposers contend that the "MONSTER Family of Marks has a relatively long history in the consumer electronics realm and is well known within its industry." (Opposers' Brief, p. 10). Applicants argue that opposers failed to prove that their marks are famous. (Applicants' Brief, p. 26).

We agree that opposers have not presented sufficient evidence to show that their marks are famous. While there is some testimony regarding opposers' sales and the high

quality of their products, there is nothing regarding opposers' advertising expenditures or public recognition and renown of the marks. While there is no doubt that opposers have enjoyed considerable success in the field of electronic components, cables, and connectors, we do not believe that this success translates to fame for opposers' marks. Without any evidence relating to the extent of opposers' advertising, market share, or unsolicited favorable publicity (*i.e.,* the degree of recognition of opposers' marks), we cannot find on this record that consumers have been so exposed to opposers' "Monster" trademarks, or that they are so aware of them, that they can be considered famous for purposes of our analysis. *Cf. Bose Corp. v. QSC Audio Products, Inc., supra* at 1305-1309 (Fed. Cir. 2002).

2. <u>The similarity or dissimilarity of parties' goods and services</u>.

In analyzing the similarity or dissimilarity of the goods and services, we start with the well-settled proposition that it is not necessary that the products and services of the applicants and registrants be similar or even competitive to support a finding of likelihood of confusion. Likelihood of confusion may be found if the respective products and services are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same

persons under conditions that could give rise to the mistaken belief that they emanate from the same source. *In re Pollio Dairy Products Corp.,* 8 USPQ2d 2012, 2015 (TTAB 1988); *Seaguard Corporation v. Seaward International, Inc.,* 223 USPQ 48, 51 (TTAB 1984).

In this case, applicants have registered the mark MONSTER RANCHER for "video game cartridges" and they seek to register the mark MONSTER RANCHER ADVANCE for "game software for computers or for amusement game machines" and "providing a computer game that may be accessed network wide by network users." Applicants also seek to register MONSTER RANCHER for the following products:

> "Cellular telephone cases, decorative magnets, refrigerator magnets," in Class 9;
>
> "Stickers; albums for use with trading cards; trading cards; calendars; paper wall scrolls; posters; clipboards; paper flags; paper banners; printed paper door signs; body decals; photo cards; sticker sheets; paper personal diaries; journals in the fields of animation, TV, games and toys; address books; letter sets consisting of letter files; letter openers and letter racks; temporary tattoos; pencil cases," in Class 16;
>
> "Wallets; purses; school bags; backpacks; tote bags; gym bags; waist packs; children's luggage; kiddie bags, namely, backpacks for children," in Class 18;
>
> "Washcloths and textile wall scrolls," in Class 24;
>
> "Clothing, namely, t-shirts, sweatshirts, knit shirts, shorts, pants, jogging shirts and pants, children's masquerade costumes, caps, hats, gloves, tank tops, long sleeve t-shirts, nightshirts, sleepwear, pajamas, nightgowns, house robes, underwear, boxer shorts," in Class 25; and,

> "Toy walkie-talkies, dolls, toy action figures, toy vehicles other than motorcycles, motor scooters, or all terrain vehicles, yo yo's, toy sculpture kits comprised of toy molds and modeling compounds sold as a unit, role playing games, jigsaw puzzles, shuffle puzzles, cube puzzles, toy model vehicle kits of vehicles other than motorcycles, motor scooters, or all terrain vehicles, skate boards, snowboards, surfboards, hand puppets, collectible card games, costume masks; playing cards," in Class 28.

According to Mr. Everett's testimony (summarized above), opposers use their various "Monster" trademarks on the following products and services:

> Ethernet cables, phone cables, interconnecting cables for computer devices, cables to connect computer systems, audio-visual connections, networking cables, phone cables for connecting a computer or gaming system to a modem or an infrastructure in a building, cables and accessories for the gaming systems, rechargeable and non-rechargeable power cells, electrical power control products, namely, batteries, power strip type electrical outlets, power line conditioners, and electrical power extension cords, USB cables and connectors for computers and components, an online newsletter to communicate with customers, and clothing, namely, t-shirts, jackets, hats, polo shirts, vests, pants, and caps, and other collateral merchandising products such as license plate frames, gym bags, carrying cases for game consoles, speaker systems.

Our review of the record indicates that opposers' core products are consumer electronic equipment for providing high quality connections between electronic equipment (*i.e.*, cables and connectors). (Everett Dep., p. 11, 15, and Exhibit 5). Opposers' cables may be used with computers that play computer games. (Everett Dep., p. 30). For example, there is a MONSTER RANCHER PlayStation 2 video game and a MONSTER CABLE PlayStation 2 cable. Both products plug-in to a PlayStation 2 console. (Everett Dep., pp. 19-

21 and Exhibits 1 and 2). On the other hand, neither opposers, nor their competitors, sell video games. (Everett Dep., pp. 76-78). Moreover, opposers are unaware of any software manufacturers that sell products in the gaming aftermarket. (Everett p. 82).[13] Finally, opposers do not consider applicants to be competitors. (Everett p. 101).

The issue of product relatedness is one of consumer expectation (*i.e.,* whether the circumstances surrounding the marketing of the respective products are such that they are likely to be encountered by the same persons under conditions that could give rise to the mistaken belief that they emanate from the same source). The fact that the products are in the same field does not in and of itself mean that the products are related. *Cooper Industries, Inc., v. Repcoparts USA, Inc.,* 218 USPQ 81, 84 (TTAB 1983)("the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required 'relatedness'"); *UMC Industries, Inc. v. UMC Electronics Co.,* 207 USPQ 861, 879 (TTAB 1980)("the fact that one term, such as 'electronic',

[13] The gaming aftermarket comprises products other than the game console. "So that would involve speakers, **games**, cables, carrying bags, you know, covers you could put over it to keep dust off of it, anything that's purchased after the main piece of hardware itself is purchased." (Emphasis added). (Everett Dep., p. 82).

may be found which generally describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way"). Accordingly, because the products of the parties may be used in connection with computer or video games does not automatically mean that they are "related." *Electronic Data Systems Corp. v. EDSA Micro Corp.,* 23 USPQ2d 1460, 1463 (TTAB 1992)("the fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that that all computer software programs emanate from the same source simply because they are sold under similar marks"); *Information Resources v. X*Press Information,* 6 UPSQ2d 1034, 1038 (TTAB 1988)("there is no 'per se' rule mandating that likelihood of confusion is to be found in all cases where the goods or services in question involve computer software and/or hardware").

It is opposers' burden to establish that applicants' products and services are so closely related to opposers' products and services that purchasers are likely assume that applicants' MONSTER RANCHER products and services emanate from opposers. *Reynolds & Reynolds Co. v. I.E. Systems, Inc.,* 5 UPSQ2d 1749, 1752 (TTAB 1987). With respect to applicants' "video game cartridges," "game software for computers or for amusement game machines," and "providing a

computer game that may be accessed network wide by network users" and opposers' consumer electronic equipment for providing high quality connections between electronic equipment, the products and services are different and highly specialized. In addition, there is no evidence that any gaming hardware companies sell gaming software or vice versa. Under these circumstances, there is no basis to infer that consumers would expect any relationship as to source between opposers' highly specialized cables and connectors and other computer and gaming accessories and applicants' computer games and software.

On the other hand, the clothing products (Class 25) for both parties are substantially identical. Both parties have identified "gym bags" (Class 18) and opposers' carrying cases for game consoles are similar to applicants' cellular telephone cases (Class 9), school bags, backpacks, tote bags, waist packs, children's luggage, and backpacks for children (Class 18).

Opposers did not introduce any testimony or evidence regarding the relationship between opposers' goods and services and applicants' goods in Classes 16, 24, and 28. Accordingly, opposers did not meet their burden of proof regarding the similarity of these products and, therefore, we find that opposers' goods and services are not related to the applicants' goods in those classes.

3. Channels of trade and class of consumers.

Channels of trade mean how and to whom the services are rendered. In that regard, applicants' video games and software and opposers' consumer based electronic applications equipment for providing high quality connections between electronic equipment are sold in the gaming sections of the same types of stores (*e.g.,* Best Buy, EB, Game Stop, Wal-Mart, Target, etc.). (Everett Dep., pp. 22-23). Opposers' products are also sold by Internet retailers such as "Amazon.com" and "Buy.com". (Everett Dep. p. 10). Moreover, the parties sell their products to the same consumers as evidenced by the endorsement opposers sought from applicants. (Everett Dep., pp. 95-96).

Because there are no restrictions on applicants' description of goods and services, we must consider the goods and services to move in all the normal and usual channels of trade and methods of distribution to all potential purchasers. *Octocom Systems, Inc. v. Houston Computer Services, Inc.,* 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank,* 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Accordingly, we find the goods and services of the parties move in the same channels of trade and are sold to the same classes of consumers, including ordinary consumers.

4. Similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.

We agree with opposers that because the marks share the word "Monster" as their first word they are similar in appearance and pronunciation. However, the marks differ in that opposers use the word "Monster" followed by a descriptive term (*e.g.* Cable, Internet, Computer, etc.),[14] while applicants use the word "Monster" followed by the purely arbitrary word "Rancher." Because of this difference, "Monster" is the dominant portion of opposers' marks, but not applicants' marks. With respect to opposers' marks, the word "Monster" is the dominant portion of the marks because it serves as the source indicator while the suffix word is descriptive of the product or product line. *In re National Data Corp.,* 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). On the other hand, applicants' MONSTER RANCHER trademark is a composite unitary mark in which both words have equal significance.

Because the structure of the marks is different, opposers' marks and applicants' mark engender different connotations and commercial impressions. The word "Monster" has the following meanings as set forth in the dictionaries attached as Exhibits 18-21 of applicants' notice of reliance:

[14] Everett Dep., p. 87-88.

> Something extraordinary or unnatural;
>
> An animal or plant deviating from normal;
>
> An imaginary, horrifying animal;
>
> A creature with a strange or frightening appearance;
>
> A person of inhuman and horrible cruelty or wickedness;
>
> An animal of huge size;
>
> Anything of vast and unwieldy proportions;
>
> Of extraordinary size or extent – gigantic, huge, monstrous.

Opposers adopted the word "Monster" as an element of their marks to connote "big, gigantic." (Everett Dep., p. 95). This connotation supports the commercial impression of opposers' products as high performance, heavy-duty cables and connectors. On the other hand, applicants' "Monster" marks connote imaginary and horrifying animals as evidenced by monsters displayed on the cover of applicants' video game cartridges. (Everett Dep., Exhibit 1). *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984)("the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression"); *Northwestern Golf Company v. Acushnet Co.*, 226 USPQ 240, 244 TTAB 1985)(the context in which a mark is used on labels, packaging, or advertising is probative of the significance the mark projects). Accordingly, applicants' marks create

the commercial impression of a rancher managing a group of horrifying creatures (*i.e.,* monsters).

Similarity in appearance, sound, meaning, or the commercial impression of the marks permits, but does not require, a finding that the marks are confusingly similar.

> In appropriate cases, two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or* connotation. Of course, two marks may be extremely similar or even identical in one aspect (sound, appearance or connotation), and yet not be confusingly similar because of significant differences in or more of the other aspects.

Kabushiki Kaisha Hattori Seiko v. Satellite Int'l, Ltd. 29 USPQ2d 1317, 1318 (TTAB 1991), *aff'd without opinion,* 979 F.2d 216 (Fed. Cir. 1992)(emphasis in the original; citation omitted).

With respect to Registration No. 2,258,436 for the mark MONSTER RANCHER for "video game cartridges," we consider the differences in the connotations and the commercial impressions of the marks to outweigh the visual and phonetic similarity. Since "video game cartridges" and "game software for computers or for amusement game machines" and "providing a computer game that may be accessed networkwide by network users" are so closely related, we believe that it is reasonable to assume that applicants will use the same marketing scheme and trade dress in connection with the

MONSTER RANCHER ADVANCE mark as they do with the MONSTER RANCHER trademark and thereby engender the same connotation and commercial impression. In addition, MONSTER RANCHER is also used as the name of the video game, as well as the source of the video game cartridge. (Everett Dep. Ex. 1). Based on the close relationship between "video game cartridges" and "game software for computers or for amusement game machines" and "providing a computer game that may be accessed networkwide by network users," we think that it is reasonable to assume that applicants will perceive MONSTER RANCHER ADVANCE as the name of the computer game, as well as the source of the computer games. Accordingly, we consider the differences in the connotations and the commercial impressions of applicants' MONSTER RANCHER ADVANCE mark (Application Serial No. 76332973) and opposers' "Monster" marks to outweigh the visual and phonetic similarity.

On the other hand, because the products set forth in Application Serial No. 76389408 for the mark MONSTER RANCHER for the products listed in classes 9, 16, 24, 25, and 28 are not closely related to "video game cartridges," we cannot draw any inferences or make any assumptions regarding the marketing scheme and trade dress which applicants may adopt. Although consolidated cases are decided on the same record, the issue of likelihood of confusion for each of the

applications must be decided independently. TBMP §511 (2d ed. rev. 2004)(the cases retain their separate identities and require a separate entry of judgment); 9 Wright Federal Practice and Procedure: Civil 2d §2382 (2006). In this regard, Application Serial No. 76389408 is an intent-to-use application and applicants have not proffered any testimony or other evidence regarding their proposed marketing plan. Therefore, we have no basis to draw any inferences or make any assumptions regarding how this particular MONSTER RANCHER mark will be used. Contrary to our findings in connection with Registration No. 2,268,436 and Application Serial No. 76332973, with respect to the MONSTER RANCHER mark in Application Serial No. 76389408, we consider the visual and phonetic similarities of applicants' mark and opposers' "Monster" marks to outweigh any potential differences in the connotations and commercial impressions.

5. Likelihood of confusion conclusion.

Considering the marks of the parties in relation to their respective goods and services, with respect to applicants' Registration No. 2,268,436 for the mark MONSTER RANCHER for "video game cartridges" and Application Serial No. 76332973 for the mark MONSTER RANCHER ADVANCE intended for use in connection with "game software for computers or for amusement game machines" and "providing a computer game

that may be accessed networkwide by network users," we find that applicants' marks do not so closely resemble opposers' marks as to be likely to cause confusion, to cause mistake, or to deceive.

With respect to applicants' Application Serial No. 76389408 for the mark MONSTER RANCHER intended for use in connection with the products identified in Classes 9, 18, 24, 25, and 28, we find that applicants' mark in Classes 9, 18, and 25 so closely resembles opposers' marks MONSTER GAME for carrying cases for game consoles, MONSTER ATTITUDE, MONSTER SPORT, and MONSTER GEAR for clothing, and MONSTER GEAR for gym bags, as to be likely to cause confusion, to cause mistake, or to deceive. With respect to Application Serial No. 76389408 in Classes 16, 24 and 28, applicants' mark does not so closely resemble opposers' marks as to be likely to cause confusion, to cause mistake, or to deceive.

Dilution

Opposers make no mention of their dilution claim in either their trial brief or reply brief. Applicants argue that because opposers did not argue dilution in their brief, that claim has been waived. In any event, applicants submit that opposers failed to prove their marks are famous and, therefore, the dilution claim must fail. (Applicants' Brief, p. 26). Because the fame of the plaintiff's mark is

an element of a dilution claim and because there is no evidence that opposers' marks are famous, opposers' dilution claims are dismissed.[15]

Decision: The petition to cancel Registration No. 2,268,436 is denied.

The opposition to Application Serial No. 76332973 is dismissed.

The opposition to Application Serial No. 76389408 is sustained in connection with the goods in Classes 9, 18, and 25, but dismissed in connection with the goods in Classes 16, 24, and 28.

[15] Section 45(c)(1) of the Lanham Act, 15 U.S.C. §1125(c)(1), provides, so far as pertinent, that "**The owner of a famous mark** shall be entitled . . . to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark." (Emphasis added).