

O-121-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2442910  
BY SUN MARK LTD TO REGISTER THE TRADE MARK "BULLDOG"**

**IN CLASS 32**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 95303  
BY RED BULL GMBH**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2442910  
by Sun Mark Ltd to register the Trade Mark**

**BULLDOG**

**in Class 32**

**and**

**IN THE MATTER OF Opposition thereto under No. 95303  
by Red Bull GmbH**

### **BACKGROUND**

1) On 6 January 2007, Sun Oil Ltd of 428 Long Drive, Greenford Middlesex, UB6 8UH applied under the Trade Marks Act 1994 (“the Act”) for registration of the above trade mark. Sun Oil Ltd later changed its name to Sun Mark Ltd (“Sun Mark”).

2) The application was subsequently published in the Trade Marks Journal on 23 March 2007 in respect of the following goods in Class 32:

*“Still or carbonated health fruit drinks and health fruit juice drinks.”*

3) On 25 June 2007, Red Bull GmbH (“Red Bull”), of Am Brunnen 1, A-5330 Fuschl am See, Austria filed notices of opposition to the application. It bases its opposition on Sections 3(6), 5(2) (b), 5(3) and 5(4) (a) of the Act. In respect to the grounds under Section 5(2) (b), it relies upon nine earlier trade marks and these are listed in the annex to this decision. Of these nine, UK registration 2306424 RED BULL and Community Trade Mark (CTM) registration 4381554 RED BULL ENERGY DRINK and device are also relied upon for the Section 5(3) grounds. All nine registrations contain a list of a wide range of Class 32 goods and Red Bull, in its Statement of Grounds, claims that its rights are particularly strong in relation to drinks. Also, all nine registrations are for trade marks that all contain the word “bull”, either alone or appearing either before or after a second word. Two also include a further device element and one of these contains the additional words “energy drinks”.

4) Red Bull claims that its sales of drinks in the UK began in 1994 and it has built up a reputation in BULL trade marks as a result of its use, which amounted to £162 million in 2006 and with a corresponding marketing expense of £24 million. It claims use of Sun Mark’s trade mark would be detrimental to the distinctive character and/or repute of its BULL trade marks and would also take unfair advantage of that repute and distinctive character. As a result, it claims that Sun

Mark's trade mark should be refused in accordance with the provisions of Section 5(3).

5) It also claims that use of the contested trade mark would be contrary to Section 5(4) (a) of the Act and is liable to be prevented by virtue of the law of passing off based on Red Bull's common law rights in its "RED BULL" signs.

6) Red Bull claims that Sun Mark is aware of its area of business and interest in BULL trade marks, not least because of other trade mark actions between the opponent and a company closely linked to Sun Mark (and what Sun Mark later informs is its parent company). It further claims that Sun Mark's applications to register BULLDOG, BULL MAN and BULL-NRG are intended to antagonise the opponent and that because "energy drinks" per se are not claimed in the current application, it is a covert attempt to obtain a registration for such. This and other alleged activities amount to actions, it says, that fall below the standards of acceptable commercial behaviour in reasonable business dealings and that the application was made in bad faith and should be refused in accordance with the provisions of Section 3(6) of the Act.

7) Sun Mark subsequently filed a counterstatement denying that its trade marks offend Sections 3(6), 5(2) (b), 5(3) and 5(4) (a) of the Act. Red Bull is put to proof of use regarding its claim to have used its BULL trade mark. It cites the existence of other "Bull Dog" trade mark registrations apparently not attacked by Red Bull as a defence that it has not acted in bad faith and as evidence of no likelihood of confusion. It also argues that all of Red Bull's trade marks are conceptually different to its own trade mark.

8) Both parties filed evidence and this is summarised below. Both parties seek an award of costs and neither party wished to be heard, but both filed written submissions in lieu of a hearing.

### **Opponent's Evidence**

9) This takes the form of a witness statement, dated 7 March 2008, by Jennifer Powers, in-house Intellectual Property Counsel with Red Bull. Ms Powers explains that Mr Dietrich Mateschitz, the Managing Director of Red Bull "became involved with the product in 1982", launching it in Austria in 1987 under the name RED BULL ENERGY DRINK, in Hungary and Scotland in 1993 before "a large scale international rollout began" in 1994 with launches in the UK and Germany. Currently, the product is sold in 144 countries with sales volumes growing from 113 million units in 1994 to 3.5 billion units in 2007. Exhibit JP3 is an internally produced chart illustrating unit sales of RED BULL ENERGY DRINK in the European Union. These sales figures indicate sales since 1987 and range from nearly 112 million units in 1995 to over 1.1 billion in the last full year (2006) prior to the filing of the contested application. Between 1993 and 2007, 2.11 billion

units were sold in the UK. Red Bull currently has an annual, worldwide turnover in excess of €3 billion.

10) Ms Powers states that two Formula 1 racing teams Red Bull Racing and Scuderia Toro Rosso are commonly referred to as the “Racing Bulls”, the Red Bull team of acrobatic pilots as the “Flying Bulls”, and that a mixed drink of vodka and Red Bull is commonly referred to as “Vodka Bull”.

11) Exhibit JP5 is another internally generated table showing Red Bull’s worldwide marketing spend ranging from nearly 17 million rising to 176 million in 2006 (no currency is indicated, but Ms Powers in her witness statement talks of a total of nearly €1.3 billion). Ms Powers also claims a marketing spend in the EU of €515.9 million between 1987 and 2007 and €120 million in the UK between 1993 and 2007. Exhibit JP8 is a copy of recordings of television and radio adverts used in English speaking countries, with thirteen broadcasts indicated as being in the UK.

12) The RED BULL trade mark has been promoted through sponsorship of a Formula 1 racing car team, the Salzburg football club that plays in the first national league of Austria and through the organisation of the Red Bull Air Race Series, an aerobic flight competition that takes place in ten large cities around the world. Ms Power points to the very large numbers of spectators for these events, with Exhibit JP12 being, what appears to be, a presentation on “media value” and includes a statistic sourced from “Initiative Worldwide” that this “media value” is €385.4 million. The meaning of “media value” is not provided.

13) Red Bull also organises and sponsors other events and Exhibit JP16 includes a list of such events in the UK. Again, this takes the form of internally generated documents that list the event, place, date and an indication whether the event was “sponsored/supported”. No further details are provided and no explanation of the nature of the sponsorship or support of any event is provided and no examples are provided relating to these events. One hundred events are listed for 2006 and also similar lists are provided for the years 2002 – 2005.

14) Ms Powers also makes a claim that RED BULL is a well known mark by virtue of 83.7% and 90% respectively of the general public in Germany and Austria associating the sign with RED BULL ENERGY DRINK. Exhibit JP17 provides details of the results of the survey conducted in Germany by GfK Market Research (“GfK”) in December 2003 looking at the public awareness of “Red Bull”. This exhibit illustrates that 1030 people were questioned. Using its own calculations and on the basis of “official statistics”, GfK considered this to be a representative sample of the population of Germany. Exhibit JP20 provides similar details of the study conducted in Austria by the “Institute for Motivational Research” of Vienna between 18<sup>th</sup> December 2006 and 9<sup>th</sup> January 2007.

15) Exhibit JP18 is a copy of a report also produced by the Institute of Motivational Research entitled "Secondary Meaning of Red Bull". Again this is a survey of about 1000 people questioned "to determine the degree of the public's familiarity with RED BULL". Once again the results of this survey are consistent with the two mentioned above. One point of interest is that 4% of those surveyed thought "of the mixture of vodka and Red Bull known as "Gummi Bear"". This final point appears to contradict Red Bull's earlier claim that such a drink is commonly known as "Vodka Bull". A further possible contradiction to this earlier claim is found in the decision in respect to proceedings in Austria, a copy of which is provided in Exhibit JP27, which referred to the existence of Red Bull's Austrian trade mark registration for "Vodka Bull" suggesting that it has a proprietary significance rather than a descriptive meaning, at least in Austria.

16) Exhibit JP19 provides copies of a further study conducted by GfK in Germany between 24 November and 1 December 2006. 1022 people were questioned in a study intended to show "to what extent the name "BULL" was known to the relevant consumer groups and was publicly recognised as a reference to a specific company". 79% of all those questioned and 93% of those who were energy drinks users had heard of "BULL" used in connection with energy drinks and 65% and 82% respectively were of the opinion that the name "BULL" refers to a specific company in connection with energy drinks. 59% and 77% respectively identified "BULL" with the company Red Bull.

17) Similarly high recognition rates were observed in a similar study conducted in the Netherlands, a copy of which is provided at Exhibit JP21. Ms Powers also refers to a number of "trial and awareness studies" conducted in various EU Member States including the UK carried out by numerous third party organisations and contends that these illustrate that RED BULL is a notorious or well-known trade mark. The study carried out in the UK in 2006 recorded that 83% of the general public spontaneously associated the trade mark with the energy drink. Prompted awareness was recorded as 99%. Figures in excess of 80% were also recorded for Sweden, Belgium and Finland. Summary information from these studies is provided at Exhibit JP22. Ms Powers explains that the high recognition rate in the UK is as a result of RED BULL enjoying a market share of 79.1%.

18) Exhibit JP24 is a list of cases from jurisdictions other than the UK where the opponent has been involved in actions in an attempt to protect its stable of trade marks. In some of these cases, the court made comments to the effect that RED BULL or RED BULL and device was a well known trade mark.

19) Copies of pages from Red Bull's website are provided at Exhibit JP25. These are dated 28 February 2008 and feature the RED BULL trade mark in various forms, several as represented by earlier registrations relied upon in these proceedings. Exhibit JP26 is a DVD carrying an overview of RED BULL activities and demonstrates that the opponent has well developed promotional activities

and includes sponsorship of events and sports people, an active relationship with the press and television, and a significant web presence.

20) Ms Powers draws attention to decisions in Switzerland, Austria and Romania where the opponent has received favourable judgements against a number of BULLDOG applications. Copies of these decisions together with English translations are provided at Exhibit JP27. Finally, in support of the contention that the applicant is involved in developing numerous “copycat” trade marks similar to the RED BULL trade marks, Ms Powers encloses photographs at Exhibit JP28 of a can of energy drink bearing the trade mark BULLET, the subject of separate proceedings brought by RED BULL.

### **Applicant’s Evidence**

21) This consists of two witness statements by Ms Renu Ranger, in house member of staff designated to deal with intellectual property matters for Sun Mark. In the first of these witness statements, dated 15 May 2008, Ms Ranger makes a number of criticisms of Red Bull’s evidence and expresses a view that Sun Mark is being unfairly targeted by Red Bull. Much of the statement is in the form of submissions regarding the lack of similarity between the respective trade marks and I will deal with this, as appropriate, later in my decision. Attached to the witness statement is a copy of a picture of a can of energy drink bearing the trade mark BULLDOG. I also note that the get up of the can involves the use of a harlequin-type pattern reminiscent of that registered by Red Bull in CTM1381554, relied upon in these proceedings. Ms Ranger states that this is one of a number of BULLDOG trade marks that has escaped the attentions of Red Bull and contends that this demonstrates that Sun Mark has been unfairly targeted by Red Bull.

22) Ms Ranger’s second witness statement, dated 10 July 2008, provided a number of exhibits in support of her comments. Exhibits RR1 and RR2 are copies of articles published in the Grocery Trader publication in its June 2008 edition announcing “a major sales distribution deal” between Double D Beverage and Jenks in relation to the former’s BULLDOG BUZZ energy drink. Sun Mark contends that Double D Beverage successfully registered its trade mark without attack from Red Bull, whilst Sun Mark’s application has been attacked by Red Bull. Exhibits RR3 and RR4 are the two pages (presented separately) of a letter received by Sun Mark from Red Bull, dated 6 June 2007 requesting that Sun Mark withdraw its application for BULLDOG. It is claimed to be evidence of the “high handed attitude” adopted against Sun Mark.

23) Ms Ranger finishes with further submissions and points out that Red Bull have failed to file evidence of use of any of the trade marks it relies upon with the exception of RED BULL.

## **Opponent's Evidence in Reply**

24) This takes the form of a further witness statement by Ms Powers, dated 10 November 2008. This consists essentially of a critique of Ms Ranger's statements that I do not need to itemise here. Ms Powers does advise that BULLDOG BUZZ ENERGY (as it is actually filed) is not registered as Ms Ranger contends, but rather it is the subject of an opposition brought by Red Bull. Finally, Ms Powers points out that the genuine use provisions in the Act do not apply to any of its trade marks relied upon and as a result, Red Bull is not required to adduce any evidence of use.

## **DECISION**

### **Section 5(2) (b)**

25) Section 5(2) (b) reads:

“(2) A trade mark shall not be registered if because –

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

26) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

27) Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

**“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

28) Red Bull relies upon nine earlier rights, all are registered and therefore qualify as earlier marks as defined by Section 6 of the Act. Further all nine registrations completed their registration procedures less than five years before the publication of Sun Mark’s trade mark (“the relevant date”) and as such do not fall foul of the proof of use provisions.

29) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,



(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

### **Comparison of goods**

30) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods

and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

31) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

32) All of Red Bull’s earlier rights include Class 32 specifications that are broadly similar and, in any case, all include “non-alcoholic beverages” at large. This broad term covers the “still or carbonated health fruit drinks and health fruit juice drinks” claimed in Sun Mark’s application. It is well established that goods can be considered identical when those covered by an earlier mark are included in a wider term by a later mark (and vice versa); see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 133/05. As such, I find the respective goods are identical. Two of Red Bull’s earlier rights also include a wider list of goods and services, however, its best case for success lies with the identical goods already identified and, as such, I do not intend to further extend my comparison of goods and services.

### ***The average consumer***

33) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue. In keeping with my approach regarding the comparison of goods, I will limit my findings to identifying the average consumer with respect to the respective parties identical Class 32 goods where, as it naturally follows, the respective average consumer will be the same.

34) The average consumer of the relevant goods, namely non-alcoholic beverages will be the general public, who will be reasonably, but not excessively circumspect. The purchasing act associated with these goods does not involve a particularly well considered process. They are purchased mainly either by ordering over a bar or selecting from a shop shelf where the purchaser will be relatively discerning, but as the goods concerned are relatively low value consumer goods, this discernment will not be of the highest level.

### **Comparison of marks**

35) I will consider each of Red Bull's nine earlier rights in turn. In doing so, I am mindful that when assessing the extent of similarity between the respective trade marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23).

### **Earlier International Registration (IR) 867085**

36) For ease of reference, the respective trade marks are:

| Red Bull's trade mark | Sun Mark's trade mark |
|-----------------------|-----------------------|
| <b>BULL</b>           | BULLDOG               |

37) From the visual perspective, both trade marks are similar in so far as one consists of, and the other contains the word "bull", however, they differ by virtue of Sun Mark's trade mark containing the additional word "dog" at the beginning to produce a word that consists of seven letters. The dominant element of Red Bull's trade mark is, self-evidently, the word "bull". In respect to Sun Mark's trade mark, the two words combine in such a way that neither word is more dominant than the other. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a reasonably low level of visual similarity.

38) Aurally, the respective trade marks share similarity by virtue of the shared single syllable word "bull". Sun Mark's trade mark also contains the second, single syllable word "dog" providing a point of difference between the respective trade marks. With these points in mind, I find that these trade marks share a reasonable level of aural similarity. From a conceptual view point, the Red Bull trade mark can describe the male of a number of animals, but the most readily brought to mind is a male bovine animal. By contrast, Sun Mark's trade mark describes an English bull-baiting breed of dog with a distinctive large head<sup>1</sup>. As such, the respective trade marks are conceptually different.

39) In conclusion, there is a reasonably high level of visual similarity, a reasonable level of aural similarity and a very low level of conceptual similarity. On balance, these factors combine to result only a modest level of similarity between the respective trade marks.

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<sup>1</sup> "bulldog" *World Encyclopedia*. Philip's, 2008. *Oxford Reference Online*. Oxford University Press. UK Intellectual Property Office. 1 May 2009 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t105.e1758>>

**Earlier Registration 2306424**

40) The respective trade marks are:

|                       |                       |
|-----------------------|-----------------------|
| Red Bull's trade mark | Sun Mark's trade mark |
| RED BULL              | BULLDOG               |

41) Similarly to the previous comparison, both trade marks are visually similar in that they both contain the word "bull", but they differ in that in Red Bull's trade mark the word "bull" is preceded by the separate word "red" whereas in Sun Mark's trade mark the word "bull" is conjoined with the word "dog". The separation of the words in the earlier trade mark and the fact they are conjoined in the later trade mark is another point of difference. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a low level of visual similarity.

42) From an aural perspective, as before the respective trade marks share the single syllable word "bull" but in the case of Sun Mark's trade mark, it also contains the second, single syllable word "dog" whereas Red Bull's trade mark contains the word "red". In addition, the different position of the common word "bull" within the respective trade marks provides another point of difference. With these points in mind, I find that these trade marks share only a low level of aural similarity. From a conceptual view point, the Red Bull trade mark describes a male bovine animal coloured red. By contrast, Sun Mark's trade mark describes a breed of dog. As such, the respective trade marks are conceptually different.

43) On balance, all these factors combine to result in only a low level of similarity between the respective trade marks.

**Earlier IR 790480**

44) The respective trade marks are:

|                       |                       |
|-----------------------|-----------------------|
| Red Bull's trade mark | Sun Mark's trade mark |
| <b>BULL RUSH</b>      | BULLDOG               |

45) Again, both trade marks are visually similar in that they both contain the word "bull", but here they differ in that, in Red Bull's trade mark, the word "bull" is followed by the separate word "rush" whereas in Sun Mark's trade mark is the conjoined words "bull" and "dog". Once again, the separation of the words in the earlier trade mark and the fact they are conjoined in the later trade mark is another point of difference. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a low level of visual similarity.

46) From an aural perspective, the respective trade marks share the single syllable word “bull” appearing at the beginning, but Red Bull’s trade mark contains the separate word “rush” whereas in the case of Sun Mark’s trade mark, it contains the additional word “dog”. The effect on the respective trade marks is that the first syllable of both trade marks is identical but there is no similarity between the respective second words/syllables. With these points in mind, I find that these trade marks share a low level of aural similarity. From a conceptual view point, the Red Bull trade mark is a variant spelling of “Bulrush” meaning a reed mace, club rush, or similar waterside plant<sup>2</sup>. Alternatively, it is possible that “rush” will be seen to have the same meaning as in the term “Gold Rush”<sup>3</sup> and as such will be understood to describe a rapid movement of bulls. By contrast, Sun Mark’s trade mark describes a breed of dog. Regardless of which meaning dominates when viewing Red Bull’s trade mark, I find that the respective trade marks are conceptually different.

47) On balance, all these factors combine to result in a low level of similarity between the respective trade marks.

**Earlier IR 790478**

48) The respective trade marks are:

|                       |                       |
|-----------------------|-----------------------|
| Red Bull’s trade mark | Sun Mark’s trade mark |
| <b>LORD BULL</b>      | <b>BULLDOG</b>        |

49) Again, as with all these comparisons, both trade marks are visually similar insofar as they both contain the word “bull”. They differ in that, in Red Bull’s trade mark, the word “bull” is preceded by the separate word “lord” whereas in Sun Mark’s trade mark is the conjoined words “bull” and “dog”. Once again, the separation of the words in the earlier trade mark and the fact they are conjoined in the later trade mark is another point of difference. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a low level of visual similarity.

50) From an aural perspective, the respective trade marks share the single syllable word “bull”, but it is the second and last syllable in the earlier trade mark and the first syllable in the later trade mark. The earlier trade mark begins with the word “lord” whereas Sun Mark’s trade mark contains the additional word “dog” as the second syllable. With these points in mind, I find that these trade

<sup>2</sup> "bulrush n." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. UK Intellectual Property Office. 1 May 2009 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e7388>>

<sup>3</sup> "gold rush n." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. UK Intellectual Property Office. 1 May 2009 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e23644>>

marks share a low level of aural similarity. From a conceptual view point, the Red Bull trade mark appears to describe a person with the title “Lord” and the surname “Bull”. The use of the word “lord” has the effect of changing the perception of the word “bull” in that it is not automatically seen as the description of a male bovine animal, but rather the surname of the Lord. Again, in this case Sun Mark’s trade mark describes a breed of dog. As such, the respective trade marks are conceptually different.

51) On balance, all these factors combine to result only a very low level of similarity between the respective trade marks.

**Earlier IR 790482**

52) The respective trade marks are:

| Red Bull’s trade mark | Sun Mark’s trade mark |
|-----------------------|-----------------------|
| ENERGY BULL           | BULLDOG               |

53) Again, both trade marks are visually similar insofar as they both contain the word “bull”. However, they differ in that, in Red Bull’s trade mark, the word “bull” is preceded by the separate word “energy” whereas in Sun Mark’s trade mark is the conjoined words “bull” and dog”. Again, the separation of the words in the earlier trade mark and the fact they are conjoined in the later trade mark is another point of difference. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a low level of visual similarity.

54) From an aural perspective, the respective trade marks share the single syllable word “bull”, but it is the second and last syllable in the Red Bull’s trade mark and the first syllable in the later trade mark. The earlier trade mark begins with the word “energy” whereas Sun Mark’s trade mark contains the additional word “dog” as the second syllable. With these points in mind, I find that these trade marks share a low level of aural similarity. From a conceptual view point, the Red Bull trade mark appears to be somewhat nebulous as it is not clear how “energy” relates to a “bull”, but it does not detract from the primary meaning associated with “bull”, namely that it describes a male bovine animal. As Sun Mark’s trade mark describes a breed of dog, the respective trade marks are conceptually different.

55) On balance, all these factors combine to result in a low level of similarity between the respective trade marks.

**Earlier Registration CTM 4771473**

56) The respective trade marks are:

|                       |                       |
|-----------------------|-----------------------|
| Red Bull's trade mark | Sun Mark's trade mark |
| CRAZY BULL            | BULLDOG               |


57) Again, both trade marks contain the word "bull". Here, in Red Bull's trade mark, the word "bull" is preceded by the separate word "crazy" whereas Sun Mark's trade mark consists of the conjoined words "bull" and "dog". Again, the separation of the words in the earlier trade mark and the fact they are conjoined in the later trade mark is another point of difference. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a low level of visual similarity.

58) Again, aurally, the respective trade marks share the single syllable word "bull", but the earlier trade mark begins with the word "crazy" whereas Sun Mark's trade mark contains the additional word "dog" as the second syllable. With these points in mind, I find that these trade marks share a low level of aural similarity. From a conceptual view point, the Red Bull trade mark describes a male bovine animal that is "insane or unbalanced" and exhibiting "wild or aggressive behaviour"<sup>4</sup>. As Sun Mark's trade mark describes a breed of dog, the respective trade marks are conceptually different.

59) On balance, all these factors combine to result in a low level of similarity between the respective trade marks.

#### **Earlier Registration CTM 4909297**

60) The respective trade marks are:

|   |                       |
|---|-----------------------|
| Red Bull's trade mark   | Sun Mark's trade mark |
|  | BULLDOG               |

61) Again, both trade marks contain the word "bull". In Red Bull's trade mark, the word "bull" appears in the possessive form together with the word "corner" and the device of a charging bull and further embellishments that give the impression that the bull is moving quickly. Sun Mark's trade mark is the conjoined words "bull" and "dog". The presence of a the device in the Red Bull trade mark and, once again, the separation of the words "Bull's" and "corner" in the earlier trade

<sup>4</sup> "crazy adj." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. UK Intellectual Property Office. 1 May 2009 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e12955>>

mark and the fact that the words are conjoined in the later trade mark are also points of difference. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a low level of visual similarity.

62) Aurally, again both trade marks share the single syllable word “bull”, but in the earlier trade mark the possessive form of the word “bull” is followed by the word “corner” whereas Sun Mark’s trade mark contains the additional word “dog” as the second syllable. With these points in mind, I find that these trade marks share a low level of aural similarity. From a conceptual view point, the Red Bull trade mark describes place named after a male bovine animal. This is reinforced by the device of a charging bull. As Sun Mark’s trade mark describes a breed of dog, the respective trade marks are conceptually different.

63) On balance, all these factors combine to result only a very low level of similarity between the respective trade marks.

### **Earlier Registration CTM 4771499**

60) The respective trade marks are:

|                       |                       |
|-----------------------|-----------------------|
| Red Bull’s trade mark | Sun Mark’s trade mark |
| EXTREME BULL          | BULLDOG               |

64) As previously, both trade marks contain the word “bull”. In Red Bull’s trade mark, the word “bull” appears after the separate word “extreme”. Sun Mark’s trade mark is the conjoined words “bull” and “dog”. Again, the separation of the words in the earlier trade mark and the fact they are conjoined in the later trade mark is another point of difference. Taking all these factors into account and viewing the respective trade marks as a whole, I find that they share a low level of visual similarity.

65) Aurally, again both trade marks share the single syllable word “bull”, but in the earlier trade mark the word “bull” is preceded by the word “extreme” whereas Sun Mark’s trade mark contains the additional word “dog” as the second syllable. With these points in mind, I find that these trade marks share a low level of aural similarity. From a conceptual view point, the Red Bull trade mark is somewhat nebulous. If “bull” is seen as describing a male bovine animal, it is not clear to me how the adjective “extreme” would be understood. An alternative meaning that could be attributed by the consumer is that “bull” is a reference to a nonsense<sup>5</sup> and with “extreme” acting as an intensifier the trade mark as a whole would be understood as a reference to a high level of exaggeration or nonsense. Sun Mark’s trade mark describes a breed of dog and irrespective of the meaning

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<sup>5</sup> “bull<sup>3</sup> n.” *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. UK Intellectual Property Office. 1 May 2009 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e7343>>



attributed by the relevant consumer to EXTREME BULL the respective trade marks are conceptual different.

66) On balance, all these factors combine to result in only a low level of similarity between the respective trade marks.

**Earlier Registration CTM 4381554**

67) The respective trade marks are:

| Red Bull's trade mark   | Sun Mark's trade mark |
|---|-----------------------|
|  The logo for Red Bull Energy Drink, featuring the words "Red Bull" in red and "ENERGY DRINK" in blue, with a red bull silhouette in the center. | BULLDOG               |

68) Here the common elements in the respective trade marks are the same as those discussed with regard to earlier registration 2306424 RED BULL. Red Bull's case is no stronger in respect to this trade mark compared to that in respect of 2306424 and I will therefore no conduct an analysis of similarity in respect to this trade mark and Sun Mark's trade mark.

**Use and distinctive character of the earlier trade marks**

69) All of Red Bull's earlier rights consists of trade marks that have no meaning in relation to non-alcoholic drinks and as such these will enjoy a high level of inherent distinctive character in relation to the relevant goods. The possible exception to this is earlier right M790482 ENERGY BULL. Here the use of the word "energy" will have some meaning in relation to "energy drinks". Nevertheless, when combined with the word "bull" any meaning will have no more than an allusive quality. This allusive quality will result in the trade mark not having the highest level of inherent distinctive character, but nevertheless, as a totality the trade mark still has a reasonable high level.

70) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the

principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

71) Red Bull's evidence only goes to illustrate use of its RED BULL trade mark and no specific information is provided regarding any of its other earlier rights that it relies upon. I therefore conclude that, with the exception of 2306424 RED BULL and CTM4381554 RED BULL ENERGY DRINK and device, the level of distinctive character of Red Bull's earlier rights is not enhanced through use. In respect of the two rights identified above, I will contain my analysis to the right that represents Red Bull's best case, namely the registration for the words RED BULL alone (2306424). In her witness statement, Ms Powers discloses that the RED BULL ENERGY DRINK was launched in the UK in 1994 (but also with a contradictory reference that it launched in Scotland in 1993) and that between 1993 and 2007, 2.11 billion units of RED BULL were sold in the UK. Exhibit JP8 contains recordings of radio and TV commercials and includes 38 different commercials shown in the UK. No information, however, is provided as to what stations these commercials were broadcast, the frequency or other information that might indicate the level of consumer knowledge but the marketing spend in the UK during the same period is disclosed as €120 million. Finally, Ms Powers also referred to a study in 2006 in the UK that concluded 83% of the general public “spontaneously associated” the trade mark with the energy drink and with prompted awareness recorded at 99%. The evidence supporting these claims is somewhat sparse, but Ms Powers does state that Red Bull enjoys a 79.1% market share in the UK. No exhibits of the product itself are provided, neither are there any invoices or references to any trade outlets in the UK. Only a single sales figure covering the whole period 1993 – 2007 is provided, with no annual breakdown. Nevertheless, these claims are not challenged by Sun Mark and I believe there is enough evidence for me to conclude that use of RED BULL in the UK is substantial. As such, I find that it benefits from an enhanced distinctive character in respect of “energy drinks”.

### ***Likelihood of confusion***

72) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

73) Ms Powers cites a number of judgments from Switzerland, Austria and Romania where Red Bull has successfully challenged applications to register BULLDOG in respect of non-alcoholic drinks and energy drinks. There are three decisions from Switzerland, two issued by the Swiss Federal Institute of Intellectual Property (“the Institute”), a third by the Confederate Appellate Commission for Intellectual Property. In respect to the first two, the trade mark opposed consisted of the words BULLDOG ENERGY DRINK placed over a background divided into four coloured squares (a harlequin design) and with a device of a bulldog’s head in the centre. The Institute noted that the harlequin background had the effect of making the integration of BULL into the trade mark “very clearly visible”. The presence of this harlequin background provides a distinct difference between the trade mark at issue in these Swiss proceedings and the trade mark at issue in the current proceedings and for this reason, I do not consider these earlier judgments have any persuasive value. The third judgment is in respect of an attack against the trade mark ENERGY BULL DOG. Again, considerations are different to in the current proceedings. The trade mark begins with the word ENERGY and the words BULL and DOG are separated. Therefore, any conclusions reached by the Swiss authorities do not reflect the same circumstances as in the current proceedings.

74) The main point that arises from the 2004 decision of the Austrian court is that Red Bull have a range of registrations for trade marks all containing the word BULL and that a later BULLDOG application will be perceived by the consumer as being just another trade mark of the BULL family of trade marks, so leading to an indirect risk of confusion in that the consumer will assume that goods sold under the BULLDOG trade mark originate from the same undertaking as the others in the family. However, more recently the ECJ has provided guidance in *Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*(OHIM) C-234/06 P:

“64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.”

75) In the current case, Red Bull makes reference in its submissions to “the extensive use...of their family of BULL trade marks...”, but as I have already noted, Red Bull’s evidence only supports use of the trade mark RED BULL. It does claim that the mixed drink of vodka and RED BULL is known as a “Vodka Bull”, however, there is no evidence of this. In fact, its own Exhibit JP18 illustrates that the public may know such a mixed drink as a “Gummi Bear”. Red Bull also provides some evidence of the association with the word BULL alone with its energy drinks (Exhibit JP19), but this relates to consumer perception in Germany and has no relevance in the analysis of a likelihood of confusion. I am, therefore, unable to treat its nine earlier rights as forming a family of trade marks.

76) The Romanian decision is issued by the State Office for Inventions and Trademarks. Here, I note that the respective trade marks do not only share the word BULL but also have similar get-ups with, once again, both featuring a prominent harlequin background. The analysis of similarity of marks will therefore be somewhat different to in the current case.

77) Of course, all these decisions are considering the relevant consumer in their own jurisdictions, where English is not the first language, or possibly not spoken at all, and this may also require a different analysis to likelihood of confusion than in the current proceedings. In conclusion, whilst noting these earlier decisions, I do not find them necessarily persuasive for the reasons set out above and I see no reason why they should influence my findings in these proceedings.

78) In the current proceedings, the respective goods are, in part, identical and I concluded that the most of the various earlier trade marks share either a low or very low level of similarity with Sun Mark’s trade mark and with one (IR 867085) sharing a modest level of similarity. Despite all being trade marks consisting of, or containing the word BULL, they all share one common difference when compared with Sun Mark’s trade mark. This is that they are all conceptual different. The ECJ has provided some guidance on the weight to be given to conceptual differences where, in *Claude Ruiz-Picasso et al v OHIM (PICASSO)* C-361/04 P, it commented:

“20. ...where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them...

21. ...such a finding is, in this case, entirely part of the process designed to ascertain the overall impression given by those signs and to make a global assessment of the likelihood of confusion between them”

79) In respect of the comparison between Red Bull’s nine earlier trade marks and Sun Mark’s trade mark, I concluded that they all shared a modest, low or very

low level of similarity and that Sun Mark's trade mark has a clear meaning which is easily distinguishable from the meanings of all of Red Bull's trade marks, when viewed as a whole. Giving due notice to the fact that the purchasing act for such goods may not involve a particularly well considered approach, I nevertheless believe these conceptual differences are sufficient to overcome any visual or aural similarity arising from the presence of the shared word BULL. Therefore, having consideration for all the relevant factors and acknowledging the enhanced level of distinctive character that is enjoyed by the earlier trade, I conclude that there is no likelihood of confusion for these goods. The similarities identified will result in the later trade mark doing no more than bringing the earlier trade marks to mind. It would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and as such, there is no direct or indirect confusion.

80) I, therefore, find there is no likelihood of confusion in respect to all nine of Red Bull's earlier rights and Sun Mark's trade mark. Therefore, the opposition under Section 5(2) (b) fails.

#### **Section 5(4) (a)**

81) Taking account of my findings under Section 5(2) (b), I cannot see that Red Bull is in any better position under Section 5(4) (a) and as such, I do not need to discuss these grounds further.

#### **Section 5(3)**

82) I turn to consider the ground of opposition under Section 5(3) of the Act which reads as follows:

“5.-(3) A trade mark which –

- (a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

83) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler A.G. v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc v Hitachi Credit*

(UK) Plc [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited v Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd (DAVIDOFF)* [2003] ETMR 42.

84) The applicable legal principles arising from these cases are as follows.

a) 'Reputation' for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122).

b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign, *Adidas Salomon v Fitnessworld*, paragraphs 29-30.

c) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).

d) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

85) To these, I would also add the following legal principles that have arisen from the recent ECJ judgement in *Intel Corporation Inc. V CPM United Kingdom Ltd (INTEL) C-252/07*:

a) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier trade mark with a reputation and the later trade mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

b) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting trade marks, within the meaning of *Adidas-Salomon and Adidas Benelux*.

c) Whether use of the later trade mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or

the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

d) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

### **Reputation**

86) I begin by assessing Red Bull's claim to a reputation and whether this existed at the relevant date. Red Bull have limited this claim in respect of only two of its earlier rights, namely 2306424 RED BULL and CTM 4381554 RED BULL ENERGY DRINK and device. From the ECJ's comments in *CHEVY* it is known that for a reputation to exist, the relevant trade marks must be known by a significant part of the public concerned and that particularly important considerations are the market share held by the trade marks, the intensity, geographical extent and duration of use and the level of promotion undertaken. I have already concluded that, in respect of Red Bull's UK registration, use in the UK in respect of energy drinks is substantial with unchallenged statements that 2.11 billion units have been sold between 1993 and 2007 and with a corresponding marketing spend of €120 million. An independent study conducted in 2006 concluded that 83% of the general public "spontaneously associated" the trade mark with the energy drink and Ms Powers stated that RED BULL enjoyed a market share of 79.1% in the UK. I therefore conclude that Red Bull enjoys a significant reputation for the trade mark RED BULL in the UK and in respect of energy drinks. In making this finding, I do not need to go on to assess the scale of reputation in relation to CTM4381554 as I do not believe Red Bull's case is any stronger in respect of that earlier right.

87) Red Bull claims that its RED BULL trade mark is well known in Germany and Austria. In *Hotel Cipriani SRL et al v Cipriani (Grosvenor Street) Limited et al* [2008] EWHC 3032 (CH), Mr Justice Arnold also commented that "Section 56 implements in domestic law Article 6bis of the Paris Convention and Article 16 of TRIPs. It provides a remedy for foreign traders whose trade marks are well known in the United Kingdom but do not own goodwill here." With this comment in mind, I find that whether or not RED BULL is "well known" in Germany or Austria will not improve the opponent's position in these proceedings and I have already found that it enjoys a reputation in respect of energy drinks and any enhanced protection in Germany and Austria will not disturb my findings.

## **The “link”**

88) Having established that a reputation exists, I need to go on to consider the existence of the necessary link. I am mindful of the recent comments of the ECJ in *INTEL* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The ECJ also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

89) As I have already found in my analysis under Section 5(2) (b), the respective trade marks are similar in that they share the word BULL, but that they have a number of differences that, significantly, include different meanings resulting in only a modicum of conceptual similarity. When considering this together with the aural and visual similarities, I have found that the respective trade marks share only a lowish level of similarity. There is no dispute that identical goods are involved, namely energy drinks. The relevant consumer of such goods are the general public who will be reasonably, but not excessively circumspect. The reputation associated with RED BULL energy drinks is significant and long standing and has resulted in an enhanced level of distinctive character, however, as I have already found the similarities between the respective trade marks is at such a level that there would be no likelihood of confusion, but that the later trade mark would bring the earlier trade mark to mind.

90) Taking all these factors into account, and in particular my finding that the Sun Mark’s trade mark brings to mind Red Bull earlier trade mark, I find that the



necessary link does exist and as a result, I will go on to consider the issues of detriment and unfair advantage.

### ***Heads of damage***

91) In its judgment in *Sigla SA v OHIM* (Case T-215/03) the CFI set out and described the heads of damage applicable under article 8(5) of Regulation No 40/94 (Section 5(3) as incorporated into the Act). I do not intend to rehearse the findings here, it is sufficient to say that the heads of damage were threefold, namely: 1) detriment to distinctive character, 2) detriment to repute, 3) unfair advantage of the distinctive character or repute.

92) In its statement of grounds, Red Bull claims that an application to register the trade mark BULLDOG is an attempt to “piggyback” on the reputation in its BULL trade marks and in its submissions asserts that use of the trade mark BULLDOG “on a product not manufactured by the opponent and which may be of inferior quality could have a disastrous impact on the high regard in which the opponent’s products are held”. Red Bull conclude that the availability of a BULLDOG drink will be detrimental to the distinctive character and repute of the earlier trade marks and will take unfair advantage of the distinctive character or repute of its earlier trade marks.

93) In relation to detriment to distinctive character (“dilution”), I do not see how use of the trade mark BULLDOG on energy drinks will water down the identity of the RED BULL trade marks with the result that they are no longer capable of arousing immediate association with Red Bull’s goods. The ECJ in *Intel*, made it clear that evidence is required of a change in the economic behaviour of the average consumer of the goods to show use of the later trade mark is or would be detrimental to the distinctive character of the earlier mark, or at least that evidence is required to show that a serious likelihood that such a change will occur in the future. In this case there is certainly no evidence of actual change in economic behaviour and I remain unconvinced by Red Bull’s arguments that is a serious likelihood that such a change will occur. Earlier, I concluded that BULLDOG will do no more than bring BULLDOG to mind, but this is an insufficiently strong link for dilution to occur.

94) In relation to detriment to repute (“tarnishment”), Red Bull have put forward the argument that there is potential for Sun Mark’s trade mark to be used on energy drinks of an inferior quality and that this could, as a consequence, damage Red Bull’s reputation. However, this line of argument was dismissed by Lindsay J. in *e-sure Insurance Limited v Direct Line Insurance Plc* [2007] EWHC 1557 (Ch) at paragraph 127 of his decision where he stated:

“127 At para 6 of its Respondent's Notice Direct Line argues that the potential use of the esure mouse on wheels sign in connection with poor quality services could adversely affect the standing of Direct Line's telephone on wheels trade mark in the eyes of the public and thus harm its overall reputation and reduce its selling power. There was, argues the

Respondent's Notice, an ever-present jeopardy from tarnishment. That, argues the Respondent's Notice, constitutes a material risk of detriment to repute. This attack, as it seems to me, is exactly the sort of attack which the CFI in *Sigla supra* intended to rule out when it said that the objector must produce prima facie evidence of a future risk, which is not hypothetical, of detriment. The Hearing Officer describes no evidence of any likelihood of esure providing poor quality services, either such as would tarnish Direct Line's mark or at all, nor, in the course of argument, was any such evidence drawn to my attention. In his paragraph 174 the Hearing Officer, dealing with such an argument, held as follows: "It is submitted on behalf of esure that this is nothing more than speculation. There is nothing to suggest that esure's reputation as an insurer is such as to reverberate negatively on DL. I agree. I reject this submission".

I detect no error of law in the reasoning that led to that conclusion and accordingly reject the reject the argument in the Respondents' notice that the Hearing Officer should have found that section 5(3) was made out in respect of detriment to repute by tarnishment."

95) Also, as in my findings regarding the claim in relation to dilution, I take the view that the link between the respective goods would not, in any event, be strong enough so as to cause detriment to Red Bull's repute.

96) Finally, in relation to unfair advantage ("free-riding"), taking account of my finding in relation to the strength of the link, I see no obvious reason why Sun Mark will gain any form of advantage from Red Bull's trade marks and reputation. The mere bringing to mind of an earlier trade mark is not, in itself, sufficient to bring about the requisite change in the economic behaviour of people in the market place (*Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, paragraph 102). I am also mindful of the comments of Geoffrey Hobbs QC sitting as the Appointed Person in *C A Sheimer (M) Sdn Bhd's TM Application (VISA)* [2000] RPC 484:

"I think it is clear that Sheimer would gain attention for its products by feeding on the fame of the earlier trade mark. Whether it would gain anything more by way of a marketing advantage than that is a matter for conjecture on the basis of the evidence before me. Since I regard it as quite likely that the distinctive character or reputation of Visa International's earlier trade mark would need to increase the marketability of Sheimer's products more substantially than that in order to provide Sheimer with an unfair advantage of the kind contemplated by Section 5(3) I am not prepared to say that requirement (iv) [that it would, without due cause take unfair advantage of the distinctive character or repute of Visa International's earlier trade mark] is satisfied."

97) In addition the “proprietor of an earlier mark is not required to demonstrate actual and present harm to his mark. He must however adduce *prima facie* evidence of a future risk, which is not hypothetical, of unfair advantage or detriment” (*Spa Monopole v Office for Harmonization in the Internal Market (OHIM)* T-67/04, paragraph 40). However, Red Bull’s evidence fails to demonstrate that (i) for those people who make a link between the respective trade marks, the link they make will affect their economic behaviour; (ii) the reputation of the earlier trade mark will be transposed to the later trade mark with the result that marketing and selling of Sun Mark’s goods becomes easier. This, together with my findings on the nature of the link and the low level of similarity between the respective trade marks brings me to the conclusion that Sun Mark will not benefit from any unfair advantage.

98) In summary, I find that Red Bull will suffer no damage as a result of the use and registration of Sun Mark’s trade mark and the ground of opposition based on Section 5(3) of the Act fails.

### **Section 3(6)**

99) Section 3(6) of the Act reads as follows:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

100) In terms of the date at which the matter falls to be considered, it is well established that the relevant date for consideration of a bad faith claim is the application filing date or at least a date no later than that (*Hotpicks Trade Mark*, [2004] RPC 42 and *Nonogram Trade Mark*, [2001] RPC 21).

101) In *Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J. considered the meaning of “bad faith” in Section 3(6) of the Act and stated (at page 379):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

102) In *Harrison v. Teton Valley Trading Co* [2005] FSR 10, the Court of Appeal confirmed that bad faith is to be judged according to the combined test set out by

the House of Lords in *Twinsectra v Yardley* [2002] 2 AC 164. Paragraphs 25 and 26 of the Court of Appeal decision are of particular assistance and read as follows:

“25. Lord Hutton went on to conclude that the true test for dishonesty was the combined test. He said:

“36. .... Therefore I consider .... that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he sets his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.”

26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.”

103) The Privy Council considered earlier authorities in *Barlow Clowes International Ltd (in liquidation) & Others v Eurotrust International Limited & Others*, [2005] UKPC 37. In particular, their Lordships considered a submission from Counsel that an inquiry into the defendant’s views about standards of honesty is required. The majority of their Lordships were also in agreement with Lord Hutton’s comments in *Twinsectra*. They then went on to state:

“15. Their Lordships accept that there is an element of ambiguity in these remarks which may have encouraged a belief, expressed in some academic writing, that *Twinsectra* had departed from the law as previously understood and invited inquiry not merely into the defendant’s mental state about the nature of the transaction in which he was participating but also into his views about generally acceptable standards of honesty. But they do not consider that this is what Lord Hutton meant. The reference to “what he knows would offend normally accepted standards of honest conduct” meant only that his knowledge of the transaction had to be such as to render his participation contrary to normally acceptable standards of honest conduct. It did not require that he should have had reflections about what those normally acceptable standards were.

16. Similarly in the speech of Lord Hoffmann, the statement (in paragraph

20) that a dishonest state of mind meant “consciousness that one is transgressing ordinary standards of honest behaviour” was in their Lordships’ view, intended to require consciousness of those elements of the transaction which make participation transgress ordinary standards of honest behaviour. It did not also require him to have thought about what those standards were.”

104) On the basis of these authorities it is clear that a finding of bad faith may be made in circumstances which do not involve actual dishonesty. Furthermore, it is not necessary for me to reach a view on the applicant’s state of mind regarding the transaction if I am satisfied that their action in applying for the mark in the light of all the surrounding circumstances would have been considered contrary to normally accepted standards of honest conduct. Thus, in considering the actions of Sun Mark, the test is a combination of the subjective and objective. Furthermore, it is clear that bad faith in addition to dishonesty, may include business dealings which fall short of the standards of acceptable commercial behaviour i.e. unacceptable or reckless behaviour in a particular business context and on a particular set of facts.

105) Red Bull, in its statement of case, allege that Sun Mark’s actions of filing a number of BULL trade mark applications such as BULL MAN, BULL-NRG and the subject of the current proceedings, BULLDOG, whilst at the same time having knowledge of Red Bull’s activities amounts to actions that fall below acceptable standards of commercial behaviour in reasonable business dealings. It goes on to suggest that Sun Mark’s actions are in retaliation for earlier actions brought by Red Bull. It also suggests that the absence of the specific term “energy drinks” from Sun Marks list of goods is an attempt to disguise the application from Red Bull.

106) Ms Ranger, in her witness statement claims that Sun Mark “are not trying to copy Red Bull but register an alternative brand but similar brand to [its] Bullet [trade mark]”. I should explain that BULLET is an earlier trade mark used by Sun Mark on its “popular” energy drink, and was attacked by Red Bull based on an earlier right in BULLIT.

107) I have already found that Sun Mark’s trade mark does no more than bring to mind the trade mark RED BULL or, for that matter, any others earlier trade marks relied upon by Red Bull in these proceedings. As such, it is difficult to see how Sun Mark’s action of filing its application can amount to a dealing which falls short of the standards of acceptable behaviour. Red Bull make allegations that the intention of Sun Mark was to antagonise it and to disguise the application from being detected by it, but no evidence of this is provided and I am unable to conclude that there was any knowledge that what Sun Mark was doing would be regarded as dishonest. In making this finding, I have been mindful that Sun Mark cannot escape such an accusation because it sets its own standards of honesty.

108) In light of all of the above considerations, I find that making the application to register the BULLDOG was not an act of bad faith and the ground under Section 3(6) fails.

### **Costs**

109) The opposition having failed, Sun Mark Ltd is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that it did file written submissions in lieu of attendance. I award costs on the following basis:

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| Considering Notice of Opposition and statement | £200 |
| Statement of case in reply                     | £300 |
| Preparing and filing evidence                  | £500 |
| Considering evidence                           | £250 |
| Filing written submissions                     | £400 |

TOTAL £1650

110) I order Red Bull GmbH to pay Sun Mark Ltd the sum of £1650. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 8<sup>th</sup> day of May 2009**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**

## ANNEX


### List of opponent's earlier marks


| Trade Mark                            | List of Goods and Services  |
|---------------------------------------|---|
| <p>M(EU)867085</p> <p><b>BULL</b></p> | <p><b>Class 32:</b> Non alcoholic beverages including refreshing drinks, energy drinks, whey beverages and isotonic (hyper and hypotonic) drinks (for use and/or as required by athletes); beer, malt beer, wheat beer, porter, ale, stout and lager; non alcoholic malt beverages; mineral water and aerated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages as well as effervescent (sherbet) tablets and powders for drinks and non-alcoholic cocktails.</p>   |
| <p>2306424</p> <p>RED BULL</p>        | <p><b>Class 25:</b> Clothing, footwear, headgear, including t-shirts, blouses, sweaters, anoraks, windbreakers, aprons, caps, hats, headbands, braces, money-belts, sun visors; sportswear, footwear for sports, football boots and studs, ski boots; non-slipping devices for shoes; corsetry; babies' napkins of textile.</p> <p><b>Class 30:</b> Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, edible salt, mustard; vinegar, sauces (condiments), dressings for salad; spices; ice; coffee, tea, cocoa and chocolate drinks; iced tea; coffee and cocoa preparations for making alcoholic and non-alcoholic beverages; cereals for human consumption, including oat flakes and other cereal flakes; food flavourings; confectionery, sweets, fruit gums, chocolate, chocolate products, pralines with liqueur fillings; chocolate mixtures containing alcohol; chewing gums; fruit and muesli bars.</p> <p><b>Class 32:</b> Non alcoholic beverages including refreshing drinks, energy drinks, whey beverages and isotonic (hyper-and hypotonic) drinks; beer, malt beer, wheat beer, malt liquor, porter, ale, stout and lager; non alcoholic malt beverages; mineral water and aerated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages as well as effervescent (sherbet)</p> |

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|  | <p>tablets and powders for drinks and non-alcoholic cocktails.</p> <p><b>Class 33:</b> Alcoholic beverages (except beers); hot and mixed alcoholic drinks, including alcoholic energy drinks, mulled wine and mixed drinks containing milk; alcoholic malt beverages; wines, spirits and liqueurs; alcoholic preparations for making beverages; spirit or wine-based cocktails and aperitifs; beverages containing wine.</p> <p><b>Class 34:</b> Tobacco; tobacco products, including cigars, cigarettes, smoking tobacco, chewing tobacco, snuff tobacco; tobacco substitutes (not for medicinal purposes); smokers' articles namely tobacco tins, cigar and cigarette holders, cigar and cigarette cases, ashtrays, humidors, none of the aforesaid goods of precious metals or their alloys or coated therewith, pipe stands, pipe cleaners, cigar cutters, pipes, pipe bags, lighters, pocket equipment for rolling cigarettes, cigarette papers, cigarette cases, cigarette filters; matches.</p> <p><b>Class 43:</b> Services for providing food and drink, including bar services, cafés, cafeterias, canteens, snack bars, restaurants, self-service restaurants; food and drink catering; temporary accommodation including hotels, boarding houses, holiday camps, tourist homes, motels; temporary accommodation reservations; boarding for animals; rental of transportable buildings, bars and tents; rental of chairs, tables, table linen, glassware and bar equipment.</p> |
| <p>M790480</p> <p><b>BULL RUSH</b></p> | <p><b>Class 32:</b> Non-alcoholic beverages, including refreshment beverages, energy drinks, beverages made with whey and isotonic beverages (hypertonic and hypotonic, intended for use by sportsmen and sportswomen and adapted to their requirements); beers, malt beers, wheat beers, porters, ales, stouts and bottom-fermentation beers known as "lagers"; non-alcoholic malt beverages; mineral and carbonated waters; fruit beverages and fruit juices; syrups, essences and other preparations for making beverages, also effervescent tablets and powders for preparing beverages and non-alcoholic cocktails.</p>   |



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| <p>M790478</p> <p><b>LORD BULL</b></p>     | <p><b>Class 32:</b> Non-alcoholic beverages, including refreshing beverages, energy drinks, whey beverages and isotonic beverages (hypertonic and hypotonic beverages, for sportsmen and women and adapted to their needs); beers, malt beers, wheat beers, porter's ales, ales, stouts and bottom-fermentation beers known as lagers; non-alcoholic malt beverages; mineral and carbonated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages, as well as effervescent tablets and powders for making non-alcoholic beverages and cocktails.</p> |
| <p>M790482</p> <p><b>ENERGY BULL</b></p>   | <p><b>Class 32:</b> Non-alcoholic beverages, including refreshing beverages, energy drinks, whey beverages and isotonic beverages (hypertonic and hypotonic beverages, for sportsmen and women and adapted to their needs); beers, malt beers, wheat beers, porter's ales, ales, stouts and bottom-fermentation beers known as lagers; non-alcoholic malt beverages; mineral and carbonated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages, as well as effervescent tablets and powders for making non-alcoholic beverages and cocktails.</p> |
| <p>CTM4771473</p> <p><b>CRAZY BULL</b></p> | <p><b>Class 32:</b> Non alcoholic beverages including refreshing drinks, energy drinks, whey beverages and isotonic (hyper- and hypotonic) drinks (for use and/or as required by athletes); malt beer, wheat beer, porter, ale, stout and lager; non alcoholic malt beverages; mineral water and aerated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages as well as effervescent (sherbet) tablets and powders for drinks and non-alcoholic cocktails.</p>   |

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| <p>CTM4909297</p>  | <p><b>Class 32:</b> Non alcoholic beverages including refreshing drinks, energy drinks, whey beverages and isotonic (hyper- and hypotonic) drinks (for use and/or as required by athletes); beer, malt beer, wheat beer, porter, ale, stout and lager; non alcoholic malt beverages; mineral water and aerated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages as well as effervescent (sherbet) tablets and powders for drinks and non-alcoholic cocktails.</p> <p><b>Class 33:</b> Alcoholic beverages (except beers); hot and mixed alcoholic drinks, including alcoholic energy drinks, mulled wine and mixed drinks containing milk; alcoholic malt beverages, malt liquor; wines, spirits and liqueurs; alcoholic preparations for making beverages; spirit or wine-based cocktails and aperitifs; beverages containing wine.</p> <p><b>Class 43:</b> Services for providing food and drink, including bar services, cafés, cafeterias, canteens, snack bars, restaurants, self-service restaurants; food and drink catering; temporary accommodation including hotels, boarding houses, holiday camps, tourist homes, motels; temporary accommodation reservations; boarding for animals; rental of transportable buildings, bars and tents; rental of chairs, tables, table linen, glassware and bar equipment.</p> |
| <p>CTM4771499</p> <p>EXTREME BULL</p>   | <p><b>Class 32:</b> Non alcoholic beverages including refreshing drinks, energy drinks, whey beverages and isotonic (hyper- and hypotonic) drinks (for use and/or as required by athletes); beer, malt beer, wheat beer, porter, ale, stout and lager; non alcoholic malt beverages; mineral water and aerated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages as well as effervescent (sherbet) tablets and powders for drinks and non-alcoholic cocktails.</p>  |

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| <p>CTM4381554</p>  <p><b>Description of mark:</b> Protection is claimed for the colours blue (Pantone 2747 C), silver (Pantone 877 C), red (Pantone 1935 C) and gold (Pantone 871 C); <i>the applicant disclaims the words RED BULL, the bull devices and the words Energy Drink contained in this application;</i> the words and figurative elements are exclusively used to show the systematic arrangement of the colours concerned in a predetermined and uniform way; the ratio of the colours is approximately 42% (blue) - 42% (silver) - 11% (red) - 5% (gold).</p> | <p><b>Class 32:</b> Non alcoholic beverages including refreshing drinks, energy drinks, whey beverages and isotonic (hyper- and hypotonic) drinks (for use and/or as required by athletes); beer, malt beer, wheat beer, porter, ale, stout and lager; non alcoholic malt beverages; mineral water and aerated waters; fruit drinks and fruit juices; syrups, essences and other preparations for making beverages as well as effervescent (sherbet) tablets and powders for drinks and non-alcoholic cocktails.</p> |