

Insights and Commentary from Dentons

The combination of Dentons and Kensington Swan offers our clients access to 10,000+ lawyers in 182 locations and 74 countries around the world.

This document was authored by representatives of Kensington Swan prior to our combination's launch and continues to be offered to provide clients with the information they need to do business in an increasingly complex, interconnected and competitive marketplace.

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Red Bull successfully opposes Red Bull Device mark for motor vehicle related goods

Red Bull GmbH v Bullstone Co Limited [2018] NZIPOTM 5

A recent decision of the New Zealand Assistant Commissioner of Trade Marks has confirmed that a reputation associated with one type of core goods can be used to stop registration of a similar mark for very different goods.

Bullstone applied to register the following device mark in New Zealand:

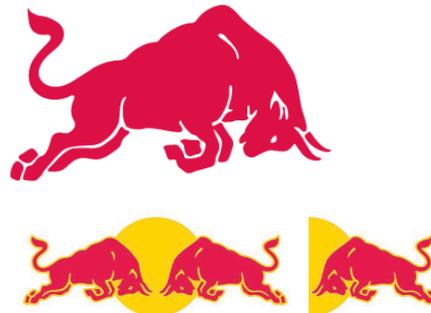


("Bullstone Logo")

The goods were motor vehicle related products in classes 1, 3, 4 and 5. They included chemical additives, windscreen cleaning liquids, oils and lubricants, air freshening preparations and the like. Bullstone is a Korean company with no known presence in New Zealand.

Red Bull opposed the application on two main grounds:

- Use of the Bullstone Logo would be likely to deceive or confuse consumers (section 17(1)(a) Trade Marks Act 2002).
- Bullstone Logo is similar to the following Logo marks that had been extensively used by Red Bull ("Red Bull marks"):



and use of the Bullstone Logo would be taken as indicating a connection in the course of trade with Red Bull, and would be likely to prejudice the interests of Red Bull (section 25(1)(c)).

Red Bull's evidence showed very significant use of its trade marks, including in New Zealand. This included not only activities directly relating to its energy drink products, but also substantial use of its marks in relation to motorsports and other events Red Bull sponsors.

Examples included the following:



The Hearings Officer accepted Red Bull's argument that the Bullstone Logo is "strikingly similar" to the Red Bull marks.

Crucially, on the s 17(1)(a) argument she found, "the evidence demonstrates that it is likely that a substantial number of consumers or potential consumers of the applicant's car care products would make an association between motorsports and the Red Bull marks", or would be caused to wonder whether the goods bearing the Bullstone Logo were produced or licensed by Red Bull.

For the purposes of the s 25(1)(c) argument the Hearings Officer accepted that the Red Bull marks were "well-known" in New Zealand. This finding was based on Red Bull's "significant evidence of its advertising and publicity of its marks through various media and the uptake by the public of that media", as well as the high volume of sales of its products in New Zealand.

Despite the disparate nature of Red Bull's energy drink products and the automotive products of Bullstone, the Hearings Officer found:

- Red Bull's "publicised and wellknown sponsorship of motor racing as a means of promoting its energy drinks will lead a substantial number of consumers who see the opposed mark on the applicant's automotive (and other) goods to conclude that there is a connection in the course of trade between those goods and [Red Bull]".

- Use of the Bullstone Logo would be likely to prejudice Red Bull's interests, based not only on the likelihood of confusion or deception, but also possible dilution of the strength and coherence of Red Bull's well-known marks.

Red Bull's opposition succeeded and the decision was not appealed.

Contact



Jenni Rutter
Partner

E jenni.rutter@kensingtonswan.com
DDI +64 9 914 7251 | M +64 21 225 9474



Charlotte Henley
Partner

E charlotte.henley@kensingtonswan.com
DDI +64 4 915 5955 | M +64 21 442 386