

## Latest Court Decisions

**2017:**

[December]

• Red Bull Device Mark Case (Cancellation Suit of Trial Decision)

**IP High Court 2017.12.25 H29(Gyo-KE)10080**

### **[SUMMARY/INTRODUCTION]**

The bull device mark in red (the subject trademark) (right upper) was registered in Japan for the goods "gasoline additives" etc. in Classes 1, 3, 4, and 5 in the name of a Korean corporation, Blouson Company Limited.



A Swiss corporation, Red Bull AG, famous for energy drinks, filed an Invalidation Trial against the subject trademark insisting that it was liable to cause confusion with the Red Bull trademark (the cited trademark) (right lower) under Article 4-1-15 of the Japanese Trademark Law.



However, the JPO dismissed the Red Bull's petition and then, Red Bull AG, the Plaintiff, brought the case before the IP High Court.

What was the Court decision ?

### **[Case]**

The JPO's trial decision mentioned that Red Bull's petition for the trial should be dismissed because while Red Bull trademark was well known to the public as the sponsor's trademark for motor sports like the F1 racing and other sports, it was not well known regarding organization of the auto mobile races in Class 41 or other goods and services than energy drinks.

On the contrary, the IP High Court admitted the high degree of recognition of the Red Bull trademark through the F1 racing activities. The activities of the Red Bull Racing Team in the F1 racings were widely announced in many mass media such as newspapers and magazines.

The Red Bull trademark were licensed to many Japanese companies for many goods and services. They put a great deal of marketing expenditure of approx. 58 billion yen in 2013. Their world brand ranking in 2015 at the Forbes magazine was 76 place and their marketing share of the energy drinks in 2013 in Japan was more than 60%.

In view of these facts, the cited Red Bull trademark was well known to Japanese consumers and traders at the time of the filing application of the subject trademark.

As to the similarity of the two bull trademarks, the IP High Court judged that the basic configurations of the two devices were in common such as the bulls in red facing left in the plain background in similar yellow or brown colors with two horns, flexed forefeet, outstretched rear feet and sigmoid tails while there were differences such as the shapes of the backgrounds, the positional relations of the bull devices and the backgrounds, and bents of the heads.

In addition, the IP High Court admitted that the concepts of the two marks were almost identical as "jumping red bull" of the subject trademark and "rushing red bull" of the cited trademark.

As to the likelihood of confusion, the IP High Court judged that the specified goods of the subject trademark contained "gasoline additives, fuel saving agents" in Class 1, "deodorant fragrances for automobiles, detergents for automobiles" in Class 3, "lubricants, fuel additives" in Class 4 and "automobile deodorizers" in Class 5 that were relating to the automobile goods and services for which the cited trademark was well known.

As the result of the above facts, the IP High Court decided that there was the likelihood of confusion between the subject and cited trademarks under Article 4-1-15 of the Trademark Law and the JPO's trial decision was thus cancelled by the Court.

#### **【COMMENTS】**

The cited Red Bull mark of the one bull device was not registered for the goods for which the subject trademark was registered. The Red Bull AG registered only the device mark of the two black bulls (right) for pharmaceuticals (containing "deodorizers") in Class 5 under No. 3106466.



Therefore, there was a possibility of an invalidation trial filing against the subject trademark on the basis of the above device mark of the two black bulls under Article 4-1-11 of the Trademark Law.

However, since it was rather clear that the device mark of the two black bulls was not confusingly similar to the subject bull device mark, such an invalidation trial would be dismissed. For such occasions, Red Bull AG decided to file the invalidation trial on the

grounds of their well-known trademark and the likelihood of confusion as provided in Article 4-1-15 of the Trademark Law.

You will see in the following English translation the difference between Article 4-1-11 and Article 4-1-15 of the Japanese Trademark Law.

**【Article 4-1-11】**

A trademark is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark, or goods or services similar thereto.

**【Article 4-1-15】**

A trademark is likely to cause confusion in connection with the goods or services pertaining to a business of another person (except those listed in Articles 10 to 14).

As you can see, while Article 4-1-11 requires the similarity of the trademarks, Article 4-1-15 does not require it. However, when Article 4-1-15 become an issue in practice, the trademark similarity is also considered. In the subject case, the JPO's Trial decided that the subject trademark and cited trademarks were not similar and that the cited trademark was not well known to the public and therefore, there was not any likelihood of confusion between the subject and cited trademarks.

However, the IP High Court admitted the likelihood of confusion on the ground that while the trademark similarity between two marks was not so high, the cited Red Bull trademark was extremely well known to the Japanese people. The IP High Court accepted application of Article 4-1-15 of the Trademark Law.

Lastly, the word "Red Bull" trademark (right) was registered as a Defensive Trademark on January 20, 2017 for all the 45 classes to protect the well-known trademark "Red Bull" registered for energy drinks and other refreshing beverages in Class 32.

The image shows the Red Bull logo, which consists of the words "Red Bull" in a bold, black, serif font. The letters are closely spaced and have a classic, slightly ornate appearance.