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## **Red Bull prevents use of RED BULL-related marks for industrial oils**

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The appellate court of the Intellectual Property Court has rendered a decision in favour of Red Bull AG in a trademark infringement case involving the use of RED BULL and related marks by a local company, Ding Oil International Trading Company.

Plaintiff Red Bull AG sued the defendants - Ding Oil and its legal representative - jointly for infringement of the following trademarks:

- RED BULL, registered in 2008 for goods and services in Classes 1 to 3, 5 to 17, 19 to 23 and 27 to 45 of the Nice Classification:

RED BULL

- RED BULL, registered in 2013 for lubricants and greases, and related goods in Class 4:

RED BULL

- RED BULL (and device), registered in 2011 for goods and services in Classes 1 to 3, 5 to 23 and 26 to 45:



- a bull device, registered in 2006 for non-alcoholic beverages and related goods in Class 32:



- RED BULL ENERGY DRINK (and device) in colour, registered in 2006 for non-alcoholic beverages and related goods in Class 32:



The RED BULL mark and RED BULL-related marks were first used by the plaintiff as its brand name for "energy drinks" in Europe and other countries in 1987. The RED BULL-branded products were sold in Taiwan from 2005. Due to the extensive use of the RED BULL marks on "energy drinks", Red Bull has become a leading brand for energy drinks and achieved fame among the relevant consumers globally.

Ding Oil is a local company selling, researching and developing lubricants, motor oils, white oil and chemical additives. In order to use RED BULL-related marks, the wife of Ding Oil's representative registered the following marks:

- RED BULL (with Chinese characters and device), registered in 2010 for lubricants, greases and related goods in Class 4 (disputed mark No 1):



- CORRIDA (and device), registered in 2006 for lubricants, greases and related goods in Class 4 (disputed mark No 2):



- FLY BULL (with Chinese characters and device), registered in 2013 for goods in Classes 1 and 4 (disputed mark No 3):



After obtaining these three trademark registrations, Ding Oil commenced use of its RED BULL-related marks on products and on the signboard of its physical store. In addition, Ding Oil used the term 'Red Bulloil' as a part of its domain name.

To protect its trademark rights, the plaintiff initiated opposition actions against the three marks and, in the meantime, filed an action for infringement to prevent the defendant from using the RED BULL-related marks. The registrations of disputed marks Nos 1 and 2 were subsequently withdrawn following the opposition actions concluded by the IP Court, while the opposition action against disputed mark No 3 is still pending.

In the infringement action, the IP Court held as follows:

- The RED BULL mark and RED BULL-related marks were first used by the plaintiff as a brand name for "energy drinks" in 1987. Because of the plaintiff's extensive use of these marks around the world, including intensive advertisement and sponsorship of the FIA Formula One World Championship and other sports competitions, the marks had achieved fame in the field of "energy drinks" globally, including in Taiwan, before August 19 2005 and December 19 2005 - the filing dates of disputed marks Nos 1 and 2.
- Although the registrations for disputed marks Nos 1 and 2 were withdrawn on May 17 2013 and July 28 2013, respectively, the defendant commenced use of these two marks before the registration dates of the plaintiff's RED BULL marks. Furthermore, disputed marks Nos 1 and 2 are used on "lubricants and motor oil" products, which are not identical or similar to "energy drinks". Therefore, the defendant's use of these two marks before May 17 2013 and July 28 2013 was based on its registrations for these marks and did not constitute trademark infringement.
- Disputed mark No 3, which consisted of the English term 'fly bull', the Chinese characters '飛牛' (meaning 'fly bull') and a bull design with wings, should be considered as distinctive and distinguishable from the plaintiff's RED BULL mark, RED BULL device mark and RED BULL-related

marks. Unless the plaintiff could provide supporting evidence that the existence of disputed mark No 3 would confuse the relevant consumers, the defendant's use of this mark did not constitute trademark infringement.

- However, since the registrations for disputed marks Nos 1 and 2 had been withdrawn on May 17 2013 and July 28 2013, respectively, the defendant could not use these two marks after those dates. Therefore, to prevent the plaintiff's RED BULL marks from being infringed by the defendant's use of disputed marks Nos 1 and 2 in the future, the defendant should not use any mark identical or similar to the plaintiff's RED BULL marks on "lubricants, motor oil, chemical additives, metal processing oil, white oil or anti-rust greases", or packaging and commercial documents for these products. Further, the defendant should not possess, display, sell, export, import or promote (by itself or through any other party authorised by the defendant) the above-listed products under marks identical or similar to disputed marks Nos 1 and 2 or to the plaintiff's RED BULL marks.

Dissatisfied with the decision issued by the IP Court at first instance, the plaintiff appealed. On May 18 2015 the appellate court of the IP Court ruled in favour of the plaintiff based on the following findings:

- In addition to disputed marks Nos 1 to 3, the plaintiff claimed that the defendant also used the following marks on its products without registration:

- RED BULL

- a red-and-yellow bull device:



- a blue-and-silver device:

- FLY BULL



- a red-and-yellow flying bull device:



This constituted infringement of the plaintiff's RED BULL marks. Based on supporting evidence provided by the plaintiff, the defendant had ceased its use of the RED BULL mark and red-and-yellow bull device after September 2 2013, while its use of the blue-and-silver device, FLY BULL mark and red-and-yellow flying bull device continued.

- The plaintiff's RED BULL mark, bull device and RED BULL ENERGY DRINK (and device) mark were registered in 2008 and 2006, respectively. Thus, the defendant's use of the RED BULL mark, red-and-yellow bull device and blue-and-silver device infringed the plaintiff's registrations for the RED BULL mark, bull device and RED BULL ENERGY DRINK (and device) mark from 2008 and 2006, respectively, even though the infringement due to the use of RED BULL and red-and-yellow bull device ceased after September 2 2013.

- Considering that the defendant usually uses FLY BULL and the red-and-yellow flying bull device together, which may convey a concept similar to that created by the plaintiff's use of RED BULL and the bull device together, and due to the fact that the bull in the device is presented in red, the FLY BULL mark and flying bull device were similar to the plaintiff's marks. Since the plaintiff had obtained a registration for RED BULL and related marks for goods such as "lubricants and motor oil" and services such as "motor vehicle maintenance and repair" and expanded its business to "motor vehicle maintenance and repair", the defendant's use of the FLY BULL mark and flying bull device would confuse the relevant consumers and also infringed the plaintiff's marks.
- The defendant's use of the above-mentioned marks without authorisation from the plaintiff might mislead consumers into believing that both parties have contractual or business relationships, and may obstruct fair competition in the field of "motor oil". Therefore, the defendant also violated the Fair Trade Act.

Based on the above, the appellate court of the IP Court held that the defendant's use of the RED BULL mark, red-and-yellow bull device, blue-and-silver device, FLY BULL mark and red-and-yellow flying bull device infringed the plaintiff's RED BULL mark and RED BULL-related marks. It further ruled that Ding Oil and its legal representative were jointly liable for damages, which amounted to 1,500 times the unit selling price of the infringing products.