

29 AOUT 2016

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Our Ref: KE/MS/1290457

Date: 3rd August, 2016

Your Ref: I.R. NO. 1290457

Head,
Legal Department
Trade Marks Geographical Indications & Industrial Designs
World Intellectual Property Organization
34, Chemin Des Colombettes
P.O. Box 18
1211 Geneva 20
SWITZERLAND

Dear Sirs,

**RE: I.R. NO. 1290457 NOTIFICATION OF PROVISIONAL REFUSAL BASED ON AN
OPPOSITION**

Reference is made to the International Trade Mark Application designating Kenya under the Madrid Protocol by virtue of Article 9 sexies, with the following particulars:

Name of Applicant	Ilona Olejniczak Stare Bielice 142c-2 PL-75-039Biesiekierz POLAND
Trade Mark	Pitbull - Word
Int. Registration Number	1290457
Class	32
Goods:	32 Non-alcoholic beverages, non-alcoholic fruit extracts, essences for beverage, non-alcoholic cocktails, lemonades, arachnid milk, energizers, isotonic beverages, whey beverages, non-alcoholic fruit juice beverages, fruit nectars, fruit juices, vegetable juices,

	sorbets, lemonade sirups, beverage sirups, mineral sparkling and still water.
Date of Notification	03/03/2016

I hereby confirm the same has been opposed, as provided for under sections 2(1), 14 and 15(1), 15A and 20 (1) of the Trade Marks Act based on an International registration and Kenyan registrations with the following particulars:

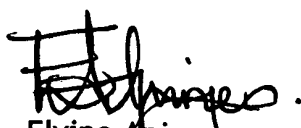
Name of Opponent	Red Bull GmbH
Trade Marks	BULL, RED BULL - Word DOUBLE BULL Device, BULL Device
Int. Registration Number	867085
Trade Mark Numbers	KE/T/2000/050181 KE/T/2000/050186 KE/T/2002/052824
Class	32

I hereby confirm that the grounds on which the provisional refusal is based affect all the goods in Class 32 in respect of which the above-mentioned application was made.

The applicant is required to file its Counter Statement within the next forty-two (42) days from the date of receipt of this notification through a Kenyan based Trade Marks Agent. However there is provision for Extension of Time upon 102 of the Trade Mark Rules.

The grounds of opposition are herewith attached.

Yours faithfully,


Elvine Apiyo
ASSISTANT REGISTRAR OF TRADE MARKS

Encl.

Cc. Ndungu Njoroge & Kwach Advocates
P.O. Box 41546 - 00100
NAIROBI

Ref: 11/143/2016/39

REPUBLIC OF KENYA
THE TRADE MARKS ACT (CAP 506)

NOTICE OF OPPOSITION TO APPLICATION
FOR REGISTRATION OF A TRADE MARK

(in duplicate)

IN THE MATTER of International Trade Mark Registration No.1290457

Pitbull in Class 32 designating Kenya in the name of Ilona Olejniczak of

Stare Bielice, 142c-2, PL-75-039 Biesiekierz, Poland

This opposition is brought by Red Bull GmbH, an Austrian company of Am Brunnen 1,5330 Fuschl am See, Austria hereinafter referred to as "**the Opponent**". The Opponent **HEREBY** gives notice of its intention to oppose the international registration of the Kenyan designation **Pitbull** trade mark advertised under the above number for class 32 in the name of Ilona Olejniczak (hereinafter referred to as "**the Applicant**") in the WIPO Gazette No. 2016/8 dated 3 March 2016. In this notice the above titled international trade mark registration no. 1290457 designating Kenya is referred to as "**the Opposed Application**".

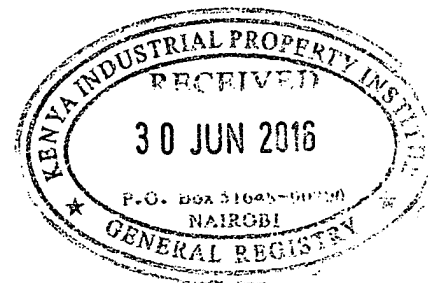
THE GROUNDS of Opposition are as follows:-

1.



The Opponent, together with its related companies, is the sole lawful proprietor in Kenya and in many countries around the world of, *inter alia*, the trade marks RED BULL, BULL Device Left-Sided, DOUBLE BULL Device and BULL which it uses in connection with beverages.

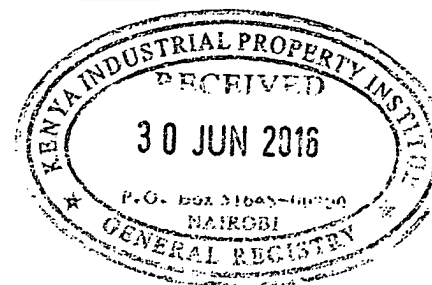
2.

The Opponent is the proprietor in Kenya of the following trade mark registrations in class 32:



Number	Trade Mark No. and Representation	Specification of Goods	Filing Date
1.	International Registration No. 867085 BULL designating Kenya	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.	Priority filing date of 2 June 2005
2.	KE/T/2000/050181 RED BULL	Non-alcoholic beverages including refreshing drinks, energy drinks, milk drinks and isotonic (hyper- and hypotonic) drinks (for use and/or as required by athletes); beer, mineral water and aerated waters, fruit drinks and fruit juices, syrups and other preparations for making beverages as well as effervescent (sherbet) tablets and powders for drinks and non-alcoholic cocktails	17 May 2000

3.	KE/T/2000/050186 	Non-alcoholic beverages including refreshing drinks, energy drinks, milk drinks and isotonic (hyper- and hypotonic) drinks (for use and/or as required by athletes); beer, mineral water and aerated waters, fruit drinks and fruit juices, syrups and other preparations for making beverages as well as effervescent (sherbet) tablets and powders for drinks and non-alcoholic cocktails	17 May 2000
4.	KE/T/2002/052824 	Non-alcoholic beverages including refreshing drinks, energy drinks, whey beverages and isotonic (hyper- and hypotonic) drinks (for use and/or as required by athletes); alcoholic and non-alcoholic malt beverages including beer, wheat beer, malt liquor, porter, ale, stout and lager; 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.	8 April 2002



The Opponent's above-mentioned trade marks are hereinafter referred to as **"the Opponent's trade marks"** or as **"the RED BULL trade marks"**.

3.

The Opponent's distinctive and fanciful trade marks were adopted for the specific purpose of identifying and distinguishing the Opponent's goods and business from those of other entities.

4.

The Opponent's trade marks were first used in 1987 in Austria and are currently in use in 159 countries around the world. The Opponent's trade marks are protected in 207 jurisdictions throughout the world. The Opponent's sales volume has grown from 113 million serving units in 1994 to over 5.4 billion serving units worldwide in 2014.

5.

The Opponent's trade marks have been used and advertised in Kenya and such use commenced prior to the date of the application for registration of the Opposed Application.

6.

The concept or idea of a "bull" plays a central part of the Opponent's brand identity and promotional activities which are not limited to the BULL, Double Bull Device and Bull Device Left-Sided trade marks in the Opponent's portfolio but also in its advertising.

7.

As a result of its extensive use in its advertisement (amongst other facts), the Opponent's trade marks are well-known in Kenya and throughout the world as distinguishing the Opponent's goods from the goods of all other entities. The Opponent enjoys significant goodwill and a substantial reputation in its RED BULL trade marks throughout the world and specifically in Kenya which is of great value to the Opponent.

8.

The Opposed Application consists of the word "Pitbull". We respectfully submit that the Opposed Application is visually, phonetically and conceptually highly similar to the Opponent's RED BULL trade marks. Compared side-by-side and bearing in mind that consumers may not always perfectly recollect the elements of trade marks, the degree of similarity between the word mark elements is significant.

Opposed Application

Pitbull

The Opponent's Trade Marks

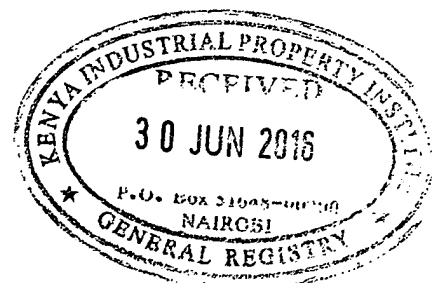
RED BULL

BULL

We respectfully submit that when the Opposed Application is compared with each of the Opponent's trade marks as a whole, the respective trade marks are visually, phonetically and conceptually similar. In particular, the Opponent's international trade mark registration no. 867085 BULL in class 32 designating Kenya is wholly incorporated in the Opposed Application, and when compared visually, the Opposed Application and the Opponent's trade mark registration no. KE/T/2000/050181 RED BULL both contain seven letters and two syllables with the last four letters and last syllable of the respective trade marks being identical.

9.

We respectfully submit that when considering the overall impression of the Opposed Application, bearing in mind that a Pitbull is also an animal known for its tremendous strength as is a bull, the visual, phonetic and conceptual similarities between the respective trade marks are such that the marks are rendered confusingly similar.



10.

The similarity between the Pitbull and RED BULL trade marks is of such a nature that there is a significant risk of consumers being confused into believing that the goods offered by the Applicant under the Pitbull trade mark are in fact the goods of the Opponent or that there is a connection in trade between the goods of the Applicant and those of the Opponent.

11.

The use of the word BULL in the mark Pitbull communicates to consumers the concept of a "BULL" as a dominant element of the Opposed Application. This BULL element is similar to the use of the word BULL, BULL Device Left-Sided and the Double Bull Device appearing in the Opponent's RED BULL trade marks and results in a high degree of similarity between the RED BULL trade mark and the Opposed Application.

12.

Furthermore, the Opposed Application is sought to be registered in respect of goods in class 32, in which the Opponent has earlier registrations covering the same goods and/or same description of goods. As the Opposed Application is sought to be registered in respect of the same goods and/or same description of goods to the Opponent, the risk of confusion is significantly increased.

13.

The Applicant's attempt to secure protection of a trade mark that is visually, phonetically and conceptually so close to the Opponent's RED BULL trade marks appears to constitute a deliberate attempt by the Applicant to take unfair advantage of the goodwill and reputation the Opponent enjoys in its RED BULL trade marks.

14.

The Opposed Application so nearly resembles the Opponent's RED BULL trade marks that use by the Applicant by the Opposed Application is likely to deceive and/or cause confusion

between the goods of the Applicant on the one hand and the Opponent's goods on the other hand. In addition, use of the Opposed Application is likely to cause members of the public to infer that the Opponent has in some way approved or licensed the Applicant or its goods or that there is some connection between the Applicant and the Opponent.

15.

For the above reasons amongst others, the registration of the Opposed Application would be unlawful in terms of Sections 14, 15 and 15A of the Trade Marks Act.

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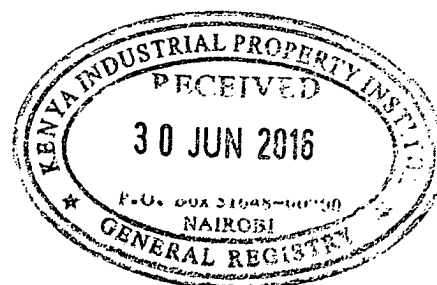
The Applicant has no claim in law or in equity to own or use the Opposed Application, and the Applicant knowing of the fame of the Opponent's RED BULL trade marks has wrongfully adopted a confusingly similar mark and applied to register the Opposed Application in its own name.

17.

For the reasons set out above, amongst others, the Opposed Application is not a trade mark of the Applicant as defined in Section 2(1) of the Trade Marks Act and the Applicant was not and is not entitled in terms of Section 20(1) of the said Act to apply for registration thereof.

18.

The conduct of the Applicant, in copying and adopting the Opponent's RED BULL trade marks and generally, and all the other circumstances of the case, are such that the Opposed Application ought in the discretion of the Registrar to be refused.



19.

THEREFORE we pray that the Opposed Application be refused and that an order of costs be made in favour of the Opponent.

Dated this

30th

day of

June

2016.



NDUNGU NJOROGUE & KWACH
For and on behalf of Red Bull GmbH

DRAWN & FILED BY:-

Ndungu Njoroge & Kwach
Advocates
International House, 12th Floor
Mama Ngina Street
P.O. Box 41546-00100
NAIROBI - (Ref: 11/143/2016/39)

TO:

Registrar of Trade Marks
P.O. Box 51648-00200
NAIROBI

