O-169-07

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2277746C

BY

FORMULA ONE LICENSING BV

TO REGISTER THE TRADE MARK:

F1

IN CLASS 41

AND

THE OPPOSITION THERETO
UNDER NO 94004

BY

RACING-LIVE (SOCIETE ANONYME A DIRECTOIRE)

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BACKGROUND

1) On 13 August 2001 Formula One Licensing BV, which I will refer to as FOL, made an application to register the trade mark **F1** for a variety of goods and services in 10 classes. During the examination process the application was divided. Application no 2277746C was published for opposition purposes in the *Trade Marks Journal* on 23 September 2005 with the following specification of services:

arranging, organising and staging of sports events, tournaments and competitions; production of sport events, tournaments and competitions for radio, film and television; provision of recreation facilities for sports events, tournaments and competitions; provision of information relating to sports via internet or computer communications mediums; organisation of sports competitions, all the aforesaid services relating to Formula One motor racing.

The above services are in class 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The publication stated that the application was proceeding because of distinctiveness acquired through use.

2) On 21 December 2005 RACING-LIVE (Société Anonyme à Directoire), which I will refer to as RL, filed a notice opposition. RL claims that F1 is a recognised abbreviation for Formula One and, therefore, it cannot have distinctive character for services relating to Formula One racing. Consequently, registration of the trade mark would be contrary to section 3(1)(b) of the Trade Marks Act 1994 (the Act). RL claims that the trade mark describes the characteristic of the services as it describes the services' characteristic of being related to formula one motor racing. Consequently, registration of the trade mark would be contrary to section 3(1)(c) of the Act. RL claims that the trade mark is a recognised abbreviation for Formula One in the current language and bona fide and established practices of the trade. Consequently, registration of the trade mark would be contrary to section 3(1)(d) of the Act.

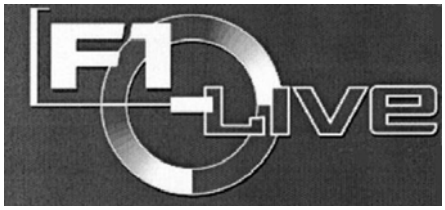
3) FOL filed a counterstatement. It states in its counterstatement that to support its application it had provided evidence of its rights in the name Formula One, its rights in the trade mark F1 and evidence of substantive (sic) use of the trade mark in relation to the

highly controlled and regulated area of motor sports. FOL claims that it has provided evidence of substantive (sic) use of the trade mark F1, sufficient to show that the trade mark has acquired distinctiveness and that it has been used solely by FOL or with FOL's consent. FOL states that on the basis of the evidence the ex parte hearing officer concluded that it had an established reputation in respect of the trade mark F1 and that the public seeing the trade mark F1 in respect of the class 41 services in motor racing would expect those services to originate from FOL.

4) In relation to the grounds of opposition under section 3(1)(b) of the Act, FOL agrees that F1 is a recognised abbreviation of Formula One. However, it is submitted that the trade mark F1 has acquired distinctive character through use and in particular through use in relation to Formula One racing. In relation to the grounds of opposition under section 3(1)(c) of the Act, FOL accepts that the trade mark F1 is a recognised abbreviation for Formula One. However, it states that it is not descriptive of the characteristics of the services of the application. FOL claims that it has full control over the users and usage of the trade mark F1 and Formula One in relation to motor racing and, therefore, the trade marks Formula One and F1 have not become descriptive of the services but retain their distinctiveness through diligent monitoring and substantial use by FOL or its licensees. FOL states that it limits the use of its trade marks and licences in order to "protect the integrity of the association with its trade marks". FOL denies that F1 or Formula One "are used in the current language as alleged by" RL in relation to the grounds of opposition under section 3(1)(d) of the Act. FOL claims that the way it has used the trade marks Formula One and F1 serve to highlight their function as an indicator of origin.

5) FOL claims that the proviso to section 3(1) of the Act applies to its application in relation to all of the grounds of opposition.

6) FOL advises that there is a current opposition procedure brought by FOL against RL before the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) in relation to application no 3778685, for the trade mark:



7) Both sides filed evidence. A hearing was held on 6 June 2007. FOL was represented by Mr McLeod of Hammonds. RL was represented by Ms Széll of Lloyd Wise.

EVIDENCE

Evidence of RL

Witness statement of Sarah Kate Széll

8) Ms Széll is a trade mark attorney acting for RL.

9) Ms Széll exhibits at SKS1 material gleaned from the Internet in relation to the meanings of Formula One. From pages downloaded from Wikipedia on 16 May 2006 the following, inter alia, is learnt:

> "Formula 1, abbreviated to F1, and also known as Grand Prix racing, is the highest class of single-seat open-wheel formula auto racing. The "formula" in the name is a set of rules which all participants and cars must meet."
>
> "The sport is regulated by the Fédération Internationale de l'Automobile, with its headquarters in Place de la Concorde, Paris. Its President is Max Mosley. Formula One's commercial rights are vested in the Formula One Group, now owned by Alpha Prema. Although now a minority shareholder, the sport is still generally promoted and controlled by Bernie Ecclestone."
>
> "The Formula One series has its roots in the European Grand Prix motor racing (*q.v.* for pre-1947 history) of the 1920s and 1930s. A number of Grand Prix racing organisations laid out rules for a World Championship before World War II, but due to the suspension of racing during the war, the World Drivers Championship was not formalised until 1947, and was first run in 1950. A championship for constructors followed in 1958. National championships existed in South Africa and the UK in the 1960s and 1970s. Non-championship Formula One races were held for many years but due to the rising cost of competition, the last of these occurred in 1983.
>
> The sport's title, Formula One, indicates that it is intended to be the most advanced and most competitive of the many racing formulae."
>
> "The inaugural Formula One World Championship was won by Italian Giuseppe Farina in his Alfa Romeo in 1950."
>
> "The formation of the Federation Internationale du Sport Automobile (FIA) in 1979 set off the FISA-FOCA war, during which FISA and its president Jean Marie Balestre clashed repeatedly with the Formula One Constructors Association over television profits and technical regulations."
>
> "1981 saw the signing of the first Concorde Agreement, a contract which bound the teams to compete until its expiration and assured them a share of the profits from the sale of television rights, bringing an end to the FISA-FOCA War and

contributing to Bernie Ecclestone's eventual complete financial control of the sport, after much negotiation."

"During the early 2000s, Bernie Ecclestone's Formula One Administration created a number of trademarks, an official logo, and an official website for the sport in an attempt to give it a corporate identity."

From pages downloaded from formula1.about.com on 21 November 2005 the following is learnt:

"Formula One (also known as F1 and as Grand Prix racing) is the premier class of single-seat open-wheel auto racing, which includes an annual World Drivers Championship. Formula One is the most expensive sport in the world, with annual team budgets soaring into the hundreds of millions."

"While F1 head Bernie Ecclestone had managed to maintain a tenuous peace with unhappy manufacturers for years, the crisis escalated in 2004, when BMW, DaimlerChrysler, Fiat, Ford and Renault formed GPWC Holdings, a corporate vehicle designed to establish their own rival F1 series that would start racing in 2008."

A page downloaded from bartleby.com on 21 November 2005, containing an extract from *The Columbia Encyclopaedia* includes the following:

"Of many different types of competition, the most prestigious involve Formula One (Grand Prix) or "Indy-type" automobiles, both cars with low-slung bodies capable of speeds greater than 230 mph (370 kph)."

Pages downloaded from the news.bbc.co.uk website on 20 June 2006 refer to "F1 teams to discuss rival series" and "Rival F1 series is 'not dead yet'".

Pages downloaded from fl-grandprix.com on 19 December 2005 entitled *Formula One Art & Genius* are included in the exhibit. The first page shows the trade mark the subject of UK registration no 2144749 at the top of the page:

Included in the pages is the following:

"The modern era of Formula One Grand Prix racing began in 1950, but the roots of F1 are far earlier, including such pre-World War II legends as Italian Tazio Nuvolari and the great German teams, Auto Union and Mercedes Benz."

> "The first race using the appellation "Grand Prix" was 1901's French Grand Prix at Le Mans…"
>
> "The first (and, until Dan Gurney's Eagle-Weslake at Spa-Francorchamps in 1967, the only) Grand Prix victory by an American-built car was by Jimmy Murphy in the 1921 French Grand Prix at Le Mans, driving a Duesnberg."

Pages downloaded from Wikipedia on 19 December 2005 deal with formula one engines. The following is stated in the pages:

> "Since its inception in 1947, Formula 1 has used a variety of engine regulations……..F1 engines are phenomenal pieces of engineering…"

In the exhibit there are pages downloaded from circuit-zandvoort.nl on 19 December 2005, the subject of which is the Zandvoort motor racing circuit. The pages include the following:

> "Most of use assume that tracks dry up and blow away once Formula 1, NASCAR or CART abandon them."
>
> "The respected British writer, Nigel Roebuck, called Zandvoort 'the greatest circuit for racing that F1 has ever known'."

The pages give the history of Formula 1 racing at the circuit.

10) Ms Széll exhibits at SKS2 extracts from websites giving explanations of other formulae which are used to describe particular types of motorcar races. Pages downloaded from Wikipedia on 12 June 2006 refer to Formula A:

> "Formula A (FA) is the top level of Go-kart racing or *karting*. This class uses 100cc two-stroke engines, which must be approved by the FIA."

A list of racing formulae from Wikipedia is exhibited. The following formulae are listed:

> Formula One, Formula Two, Formula Three, Formula 3000, Formula D, Formula Ford, Formula 500, Formula Continental, Formula Junior, Formula E, Formula 5000, Formula A, Formula C, Formula Student Germany, Formula lightning, Formula Renault, Formula-G, Formula Holden, Formula Locost, Formula Maruti, Formula Mazda, Formula Nippon, Formula Renault, Formula Vee.

Extracts from Wikipedia, downloaded on 12 June 2006, describe Formula 3000:

> "Formula 3000 was a type of formula racing, active from 1985-2004. It was replaced by GP2 in 2005.

In 1985, the Fédération Internationale d l'Automobile (FIA) created the Formula 3000 championship to become the final preparatory step for drivers hoping to enter the Formula One championship. Formula Two had become too expensive, and was dominated by works-run cars with factory engines; the hope was that Formula 3000 would offer quicker, cheaper, more open racing."

"A small British Formula 3000 series ran for several years in the late 1980s and early 1990s, usually using year-old cars….The American Racing Series, a predecessor to Indy Lights, ran with March F3000 chassis…"

"Japan persisted with Formula Two rules for a couple of years after the demise of F2 in Europe, but then adopted basically F3000 rules as Formula Nippon."

Further printouts from Wikipedia give the following information:

"Formula 500 (F500) is a Sports Car Club of America (SCCA) open wheel road racing class. Formula 500 was originally introduced in the early 1980s as Formula 440 (F440), and is currently one of the fastest growing open wheel racing classes in the United States."

"Formula Three, also called Formula 3 or, in abbreviated form, F3, is a type of formula racing and a class of open-wheeler motor racing."

"There has never been a World Championship for Formula Three. In the 1970s and into the 1980s the European Formula Three Championship and British Formula Three Championship were the most prominent series, with a number of future Formula One champions coming from them. France, Germany, and Italy also had important Formula Three series, but interest in these was originally subsidiary to national formulae – Formula Renault in France and Formula Super Vee in Germany."

"For much of the history of Formula One, Formula Two represented the penultimate step on this road."

"Formula Junior was introduced in 1959…. it was soon realised that there was a need to split it into two new formulae; F2 and F3 were introduced for the 1964 season…."

"Japan ran a series for "Formula 2000" to similar rules for several years (production-based single-cam engines were permitted to run at 2.4 litres, but they soon came into line with International F2 and the Japanese F2 series ran for two years after the end of European F2, before Japan too adopted F3000 rules."

"Formula Vee is a popular single-seater junior motor racing formula, with relatively low-costs in comparison to Formula Ford or Formula BMW."

> "Primarily a class in the Sports Car Club of America many other organizations have adopted the Formula Vee as a class."
>
> "Formula Maruti or FISSME (known as Formula India Single Seater Maruti Engine), is a single seater, open wheel class in motorsport made and raced in India."
>
> "Formula LGB is newly launched single seater, open wheel class in motorsport in India."

11) At SKS3 Ms Széll exhibits copies of pages from *Autosport* magazine of 30 September 1999. The front cover includes the words "HOW F1'S FORGOTTEN MAN FELLED TITLE GIANTS". Another page has an advertisement for www.itv-fi.com; at the top of the advertising the following wording appears: "There is a time and a place to view the web's latest F1 news". An advertisement for Speed Retail Limited exhorts customers to "COME AND SEE US FOR ALL YOUR F1 NEEDS & MUCH MORE BESIDES". Another page gives news about a McLaren F1 GTR driver. A copy of an advertisement for advertising in *Autosport* is reproduced, this promotes the magazine as a place to advertise for staff to work in F1. There are advertisements reproduced for F1 world championship hospitality packages, F1 goods such as race suits and helmets, an advertisements for F1 driving courses, where the public have the opportunity to drive an F1 car, an advertisement for exhausts that are used in F1 cars. There are a number of articles about motor racing which refer to F1 motor racing.

12) At SKS4 Ms Széll exhibits pages downloaded form the Internet which relate to opportunities for the public to drive F1 cars.

13) At SKS5 Ms Széll exhibits material from the application file which shows that FOL accepted a limitation of the specification to "all the aforesaid services being related to Formula 1 racing".

14) At SKS6 Ms Széll exhibits a copy of a witness statement by Patricia A Heavey, with exhibits, which was submitted by FOL at the application stage.

15) Ms Heavey is the trade mark manager of Formula One Management, which I will refer to as FOM. She states that the trade mark F1 has been used by FOL, Formula One Administration Ltd and FOM, which are in the same group. I will refer to the three undertakings as the Group. The FIA Formula One World Championship is regulated by FIA. The championship consists of a series of races, typically 16 or 17 a year, held around the world. Each race is held over a weekend and will typically consist of a number of practice sessions on Friday, qualifying for the race on Saturday and the race on Sunday. FOL is the owner of a trade mark portfolio that has been used since 1982, in relation to the operation of the Championship, under the regulation of FIA. Ms Heavey states that the trade marks include the F1 trade mark and others such as Formula 1 and Grand Prix. She states that the Group has the right under the agreement with the FIA to exploit the races commercially. She does not exhibit the agreement.

16) The British Grand Prix forms part of the championship. Typically the British Grand Prix is held annually in June or July each year and attracts a crowd of over 250,000 people over the course of the weekend. Since 1987 the British Grand Prix has been held at the Silverstone circuit. Each race in the championship is organised by a third party promoter who Ms Heavey states is licensed to use FOL's trade marks, including the trade mark F1, "for very specific purposes" in relation to the organisation of the races. In the United Kingdom, the promoter for the British Grand Prix in 2001 was Brands Hatch Leisure Group Limited. In 2004 it was Silverstone Motorsport Limited. Ms Heavey states that the promoter is licensed to use the F1 trade mark in respect of arranging, organising and staging of the motor race known as the British Grand Prix and since 1997 has been provided with very strict guidelines by the Group to define and control the use. The promoter is provided each season with an artwork pack, containing completed designs for programme covers, media packs, posters, letterheads and fax headers. The promoter is obliged to adopt this artwork, which uses FOL's trade marks, including the F1 trade mark, for the season. Ms Heavey exhibits a letter dated 14 March 2003 (ie after the material date) to Octagon Motorsports Ltd re designs for the 2003 Fosters British Grand Prix. Also included are pictures of various material for 2003. This material does not show use of F1 in non-stylised form but use of the following trade mark:

At PAH2 material relating to the British Grand Prix in 2001, 2000, 1998, 1997, 1996, 1995 and 1994 is exhibited, this material all shows use of the above trade mark, not of F1 in non-stylised form.

17) Ms Heavey states that the promoter is contractually obliged to erect a number of structures at the circuit which bear the F1 trade mark. These structures include the podium and the TV studios for the post session/race interviews. Exhibited at PAH3 are copies of various photographs showing what Ms Heavey describes as use of the F1 trade mark on the podium at the British Grand Prix from 1995 to 2004 and a copy of a photograph from the FIA press conference held at the 2004 Fosters British Grand Prix, obviously well after the material date. Again the use is not of F1 in non-stylised form but of the trade mark shown above.

18) Ms Heavey states that according to the FIA regulations, a safety car and medical car must be present during any timed session taking place over the race week. She states that the safety car and medical car are highly recognisable and highly visible, given that they are the focus of attention when an incident occurs. Ms Heavey states that the F1 trade mark has been used on the safety and medical cars since 1997. She exhibits copies of pictures of the cars at PAH4. The pictures do not show use of F1 without stylisation but of:

19) Ms Heavey states that the championship races are broadcast to 170 countries. She states that the annual cumulative television audience in the United Kingdom is as follows:

1997 116 million
1998 119 million
1999 92 million
2000 94 million
2001 85 million
2002 76 million
2003 76 million.

These figures are described as being "race only". I assume that means they exclude the practice and qualifying rounds. Ms Heavey does not indicate how many races were held in each year. If the minimum number of races was held, 16, then the 1997 figure would represent 7.25 million per race and the 2000 (the last full year before the date of application) figure 4.75 million per race.

20) Ms Heavey states that the Group has licensed the right to use the F1 trade mark in respect of the broadcasting of television programmes relating to the championship to ITV since 1999. She exhibits at PAH5 a copy of a photograph of the ITV broadcasting studio and a label and a shirt used by presenters. The pictures of the studio show F1 sandwiching the ITV sport trade mark, the shirt has the letters itv, beneath which is F1 and beneath this the word sport. On a picture of the studio from outside, F1 can be seen next to various references to ITV sport and its website.

21) Ms Heavey exhibits printouts from the BBC Sport website and the *Daily Telegraph* sport.telegraph website. These relate to the 2001 Formula 1 season, several emanate from after the date of application. On the left hand side of the sport.telegraph website there is an index which reads: Football, Cricket, Rugby Union, Rugby League, Golf, Morse Racing, Motor Sport, Betting, Formula One, ProFantasy Formula 1, Rallying, Motorcycling, Speedway, WRC Latest, Tennis, Tour de France, Other Sports. Included on the printouts are links to, inter alia, FIA, Williams F1 and Benetton Formula One, there are also advertisements for F1 memorabilia.

22) Ms Heavey states that since 2001 the Group has operated a website under the F1 trade mark. She does not state when in 2001 this use commenced and so it could be after the date of application. She exhibits at PAH7 a print of a website page from 2004 and

one that she states is from 2001. On the former page there is a reference to the 2005 FIA Formula One World Championship.

appears on both pages. The page which it is stated emanates from 2001 does bear the wording "Welcome to F1 TV Images". This page refers to Marlboro Magyar Nagydij 2001, presumably the Hungarian Grand Prix, the sport.telegraph printouts indicate that this took place between 17 and 19 August 2001 and so after the date of application.

Witness statement of Julia Helene McFarlane

23) Ms McFarlane is employed as a trade mark assistant by Lloyd Wise, agents for RL.

24) Ms McFarlane's witness statement gives evidence of use of Formula One, Formula 1 and F1 in a variety of other sports and pastimes. In brief, exhibits cover the following areas:

Formula One yachts – rules from 2001 – copyright 1997 – from South Africa.

Formula One yachts evolved from a concept which evolved following racing off Fremantle in 1986 prior to America's Cup.

"The Skeeter is the "Formula One" of ice yachting" – iceboat.org – 21 June 2006.

F1 powerboat racing.

f1boat.com.au – Formula 1 powerboat racing has had a presence in Australia dating back to the 1970s

International Formula One (IF1) - air races.

Formula One air racing - use of F1.

Giant scale air racing – Formula 1, Formula 1GT – 2004 – use of F1 and F1GT – US use.

World water ski racing - Formula 1 Men, Formula 1 Women, Formula 2 women - use of F1

US advertisements for Uvex F1 ski goggles.

US advertisements for Tag Heuer Formula One chronographs.

25) A good deal of the evidence is foreign usage and lacks indications that the usage occurred prior to the date of application.

Evidence of FOL

26) This consists of a witness statement of Cheng Foong Tan. Ms Tan submits much of the same evidence as Ms Széll. She refers to Ms Széll's exhibit SKS1, part of which she exhibits at CFT2. She states that this shows trade marks created by Bernie Ecclestone. The parts she has highlighted refer to the official Formula One logo as being part of Formula One Administration's efforts to give F1 a corporate identity. This is the logo referred to on several occasions above:

Ms Tan also highlights references to "FOM president Bernie Ecclestone has initiated and organized a number of Grands Prix in new countries…" "Formula 1 is generally one of the biggest global TV draws behind football and the Olympics." "During the early 2000s, Bernie Ecclestone's Formula One Administration created a number of trade marks, an official logo, and an official website for the sport in an attempt to give it a corporate identity."

DECISION

27) Section 3(1) of the Act states:

> "3.-(1) The following shall not be registered -
>
> (a) signs which do not satisfy the requirements of section 1(1),
>
> (b) trade marks which are devoid of any distinctive character,
>
> (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

28) Mr McLeod in the second paragraph of skeleton argument wrote:

> "This is a single issue hearing: the question is whether the applicant's evidence showed that the mark has acquired distinctiveness through use such that the opponent's opposition should fail *ab initio*."

At the outset of the hearing I asked Mr McLeod if this meant that he accepted the validity of the objections under sections 3(1)(b) and (c) of the Act, which had been raised and maintained at examination stage. He stated that this was the case. (Ms Széll indicated that she had intended to ask a similar question.) Consequently, it is not necessary for me to deal with the legal issues relating to sections 3(1)(b) and (c) of the Act. It has also been accepted at all times that F1 is a commonly used abbreviation for Formula One or Formula 1.

29) Some of the evidence comes from Wikipedia. FOL to some extent has de facto accepted the validity of this evidence by referring to it in its own evidence. There has been no challenge to the evidence from Wikipedia. The evidence from Wikipedia deals essentially with the history and background of F1 racing, nothing particularly controversial. Wikipedia has sometimes suffered from the self-editing that is intrinsic to it, giving rise at times to potentially libellous statements. However, inherently, I cannot see that what is in Wikipedia is any less likely to be true than what is published in a book or on the websites of news organisations. Mr McLeod did not express any concerns about the Wikipedia evidence. I consider that the evidence from Wikipedia can be taken at face value.

30) The parameters for considering evidence to establish distinctiveness through use were established by the European Court of Justice (ECJ) in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97:

> "51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

> 52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages."

Mr MacLeod described the relevant class of persons as "the average fan of Formula One motor racing". It seems to me that the relevant class of persons is somewhat wider than this, it is the public which watches or reads about the sport; not necessarily individuals who could be classified as fans. However, nothing turns upon this, as no evidence has been furnished in relation to the perspective of fans or any other members of the public. The perceptions of the average consumer are to be judged at the time of application for registration, 13 August 2001[i].

31) In considering the effects of evidence, the perception of the relevant class of persons is important. Has the use made the relevant public see the sign as a trade mark? As there is no survey evidence I have to consider from the evidence before me whether it would appear that the relevant public would have been educated to see F1 as performing the essential function of a trade mark; "to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin"[ii].

32) In considering the issue it is necessary to avoid the "unspoken and illogical assumption that "use equals distinctiveness""[iii].

33) It is noticeable in this case that the opponent has used the applicant's own evidence to show that the sign F1 has not acquired distinctiveness. In her evidence Ms Heavey refers to various examples of use of the sign F1 where in fact the use shown is that of a stylised version. As Ms Széll indicated in her submissions, this case is not about RL's objection to the registration of a stylised form of F1 but the unstylised form that is the subject of the application. Ms Tan in her evidence refers to Ms Széll's exhibit SKS1. These refer to Mr Ecclestone trying to create a corporate identity for F1 with the official Formula One logo:

She also refers to the part of the exhibit which states that Mr Ecclestone's Formula One Administration has created a number of trade marks, an official logo, and an official website for the sport in an attempt to give it a corporate identity. In the evidence of both Ms Heavey and Ms Tan, they are talking about a trade mark that is not the subject of this application.

34) In the pages from news.bbc.co.uk there is a reference to a rival F1 series; these particular pages were downloaded on 20 June 2006, well after the material date. There has been no dispute as to the material which relates to Mr Ecclestone trying to create a corporate identity with trade marks in the early 2000s, indeed Ms Tan has sought to use this material in support of FOL's case. So one would assume that FOL's position would be better as of 20 June 2006, as its policy would have had more time to take effect. One of the extracts from Wikipedia also refers to "their own rival F1 series". To write of a rival F1 series is of its nature to use the term generically. It can be assumed that the writers are not part of the general class of persons concerned but people with an expertise and knowledge of the sport. The index on the left hand side of the sport.telegraph pages lists various sports such as football, rugby union, rugby league; included in the index is Formula One; I consider that it is likely that the class of person concerned owing to the nature of the use in the index and in the article on the page will see Formula 1 as a type of sport. As Wikipedia comments F1 is the highest class of sing-seat open-wheel formula auto racing. There is no hint in the Wikipedia references, which emanate from after the material date, to indicate that F1 is seen as anything than a particular form of motor racing; like all the other numerous formulae of motor racing. One also sees evidence in relation to F1 memorabilia and equipment and F1 cars, none of this suggests that F1 is being used as a trade mark or will be seen as one. Services are supplied in relation to driving F1 cars around race tracks, there is no hint that F1 is used as a trade mark. Use of F1 is made by ITV but either in relation to ITV or in such a form that there is no indication of trade mark use.

35) One of the arguments of FOL is that the Group is the only organisation organising F1 races; this does not mean that the public will perceive F1 as a trade mark. It just means that currently it enjoys a monopoly on the races. However, if private owners of F1 cars race them on a friendly basis is that not an F1 race, if not on a commercial basis? In relation to the current monopoly FOL does not exhibit the agreement between itself and the FIA, it is the FIA that decides on the criteria for F1; according to Ms Heavey's evidence the right of the Group to exploit the races commercially has been granted by FIA. It would be helpful to know on what terms this has been made.

36) The case most pertinent to the issues before me is *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513. Morrit LJ in that case stated:

> "43. With regard to the third and fourth submissions it is necessary to refer to the reference by Neuberger J. to the dictum of Viscount Maugham in *The Shredded Wheat Co. Ltd v. Kellogg Co. of Great Britain Ltd* (1940) 57 R.P.C. 137. At page 30 Neuberger J. said:

"While I am persuaded by Mr Bloch that the three propositions[iv] propounded by Mr Hobbs are perhaps somewhat too rigid, it does seem to me that they have considerable force, and at least provide useful general guidance. In that connection I derive assistance from certain passages in well-known judgments.

In *The Shredded Wheat Co. Ltd v. Kellogg Co. of Great Britain Ltd* (1940) 57 R.P.C. 137, Viscount Maugham said at page 147 that:

> '[I]t may be useful to cite the statement by Mr Justice Parker in *In re Gramophone Company's Application* [1910] 2 Ch. 423 at page 437 since he was a master in this branch of law: "For the purpose of putting a mark on the register, distinctiveness is the all-important point, and in my opinion, if a word which has once been the name of the article ought ever to be registered as a trade mark for that article, it can only be when the word has lost, or practically lost, its original meaning. As long as the word can appropriately be used in a description of the articles or class of articles in respect of which a trade mark is proposed to be registered, so long, in my opinion, ought the registration of that word for those articles or that class of article to be refused."'"

Neuberger J. also referred to the statement of Jacob J. in *British Sugar plc v. James Robertson & Sons Ltd* [1996] R.P.C. 281 at 302 to the effect that for a common descriptive term to acquire a distinctive character it must be shown that its original meaning has been "displaced".”

In paragraph 45 Morrit LJ stated:

> “If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning must be displaced. It is also in that sense that I accept the second submission made by counsel for HHL before Neuberger J.”

At paragraph 49 he stated:

> “First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

In his part of the judgment Chadwick LJ stated on page 534 at line 11 et seq:

> “The test of capacity to distinguish must, as it seems to me, reflect the test which is to be applied, following the decisions of the Court of Justice in *Gut*

> *Springenheide and Tusky* [1998] E.C.R. I-4567 (at paragraph 31) and *Lloyd Schufabrik Meyer v. Klijsen Handel BV* [1999] E.T.M.R. 690, in determining whether there is a likelihood of confusion in the context of Article 5(1)(b) of Directive 89/104. That has not been in dispute on this appeal. The test is whether the average consumer of the category of products concerned would recognise the words as distinctive--that is to say, as a guarantee of origin. For that purpose the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect."

On page 535 at line 11 et seq he stated:

> "As Morrit L.J. has pointed out, a reasonably well informed and reasonably observant and circumspect consumer would know, if it be the case, that the words or word are widely used in a generic or descriptive sense--even if he is, himself, aware that they are also used in a distinctive sense. With that knowledge, it seems to me impossible for him to say that the words identify, for him, the goods as originating from a particular undertaking. Knowing, as he does, that the use of words may be intended as descriptive, he cannot assert that he understands them as necessarily distinctive."

37) The evidence which has been furnished, by both sides, in no way suggests that the ordinary, original meaning of F1, as a type of motor car race and as a description of the cars that compete in it, has been displaced. It does not, in my view, even suggest an element of ambiguity in relation to the sign; and Morrit LJ stated that ambiguity could not establish distinctiveness. I do not see, that the Group currently has the exclusive rights to the commercial exploitation of F1 under the auspice of the FIA, alters that. It tells me that the Group currently has rights to the exploitation of F1 races, it does not tell me that the relevant class of persons would see F1 as anything other than a type of race.

38) Mr McLeod considered that FOL's registrations of F1 and Formula 1 should influence my decision; details of these registrations are exhibited at CFT4 to the statement of Ms Tan. The United Kingdom registrations of F1 are, like this application, scions of application no 2277746. They proceeded upon the basis of prima facie acceptance, so it is difficult to see how they are on a par with this application. The community trade mark registration of Formula 1 does not appear to have proceeded upon the basis of acquired distinctiveness, although it contains the services of this application. As Mr McLeod accepted the validity of the sections 3(1)(b) and (c) objections, I cannot see how the community trade mark registration can be seen as a precedent. It is also the case that I have to consider the case on the basis of the evidence before me, evidence that, in my view, clearly precludes registration.

39) Mr McLeod also considered that RL's Community trade mark application should be taken into account. There has been no pleading of estoppel by election; if there had been it would have been inevitably dismissed as RL's application includes F1 but it is not F1.

40) The specification of the application of itself gives rise to some problems. The specification reads as per Ms Tan's letter of 25 April 2005, to be found within exhibit SKS5. It is clear from the letter that all of the services were supposed to be limited to relating to Formula One motor racing. However, the custom and practice of the classification section of the Trade Marks Registry, is that, to effect this, the limitation should be preceded by a semi-colon. The same custom and practice views the preceding comma as indicating that the limitation relates only to *organisation of sports competitions*. Ms Széll commented upon the anomalous position of FOL where it claims that Formula One is a trade mark and then includes it in a specification. Terms within specifications have to be generic, a trade mark is not generic by nature and does not define any fixed quality or the nature of goods or services; it "defines" whatever the trade mark uses it in relation to. If Formula One is a generic term then it can sit happily in the specification; if it is not, as FOL argues as per its trade mark registration, it cannot. Nothing in this decision turns upon the presence of Formula One in the specification but if it is a trade mark then it should not be in the specification.

41) The validity of the grounds of objection under section 3(1)(d) was not conceded by Mr McLeod. If the evidence of use were sufficient to overcome the section 3(1)(b) and (c) objections I cannot see that it would not be sufficient to overcome the section 3(1)(d) objection. Consequently, I do not consider that I need to consider the grounds under this head.

42) I do not consider that the evidence of FOL allows the proviso to come into play. Indeed, I consider that the evidence, from both sides, shows that F1 is not registrable as a trade mark for the services of the application.

43) I find that the application for registration of the trade mark should be refused.

COSTS

44) RACING-LIVE (Société Anonyme à Directoire) has been successful and is entitled to a contribution towards its costs. I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Evidence	£1,000
Considering evidence of the applicant	£250
Preparation and attendance at hearing	£500
TOTAL	£2,450

I order Formula One Licensing BV to pay RACING-LIVE (Société Anonyme à Directoire) the sum of £2,450. 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 14th day of June 2007

David Landau
For the Registrar
the Comptroller-General

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[i] BL O/127/07 – decision of Professor Annand, sitting as the appointed person.
[ii] *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-37/03 P and many other cases.
[iii] *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281
[iv] The three propositions were:
1. "The name of a product is the very antithesis of a trade mark. It tells you what the product is.
2. So long as a name retains the capacity to function as the name of a product, it is ineligible for registration as a trade mark.
3. The question with which the court is confronted in the present case, and which should be answered in the affirmative on the applicant's contention, is whether the word BACH retains the capacity to function as the name of product. It if does, then, on the basis of his first two propositions, Mr Hobbs contends that the applicants must succeed."