

# World Trademark Review Daily

ECJ tells General Court not to disregard national rights in F1 case  
European Union - MAQS Law Firm

Examination/opposition  
International procedures

June 06 2012

In *Formula One Licensing BV v Office for Harmonisation in the Internal Market* (OHIM) (Case C-196/11 P, May 24 2012), the Court of Justice of the European Union (ECJ) has set aside a decision of the General Court in which the latter had upheld a decision of the Board of Appeal of OHIM refusing an opposition filed by *Formula One Licensing BV* against an application to register the mark F1 LIVE in Classes 16, 38 and 41 of the *Nice Classification*.

Applicant Global Sports Media is in the business of broadcasting and commercialising sport in digital media, and owned the Community trademark (CTM) application for the figurative mark reproduced below:



The goods and services in respect of which registration was sought fell within Classes 16, 38 and 41. Formula One Licensing filed a notice of opposition on the basis of Articles 8(1)(b) and (5) of the *Community Trademark Regulation* (40/94).

The Formula One Group is a group of companies responsible for the promotion of the FIA Formula One World Championship and the exploitation of the racing sport's commercial rights. Formula One Licensing is a related Dutch-registered company which owns the following trademarks: the F1 logo, FORMULA 1, FORMULA ONE and F1.

The opposition was based, among other things, on the following earlier trademarks, for which a reputation was claimed:

- The word mark F1, protected by an international registration covering Denmark, France, Germany, Hungary, Italy and Spain, for goods and services in Classes 16, 38, and 41.
- The figurative mark F1 FORMULA 1, registered in the Community under Registration 631 531 on May 19 2003 in respect of goods and services in Classes 16, 38 and 41:



The Opposition Division of OHIM upheld the opposition on the basis of the earlier registration for the word mark F1. It found that the goods and services covered by the two marks were similar or identical and that the signs at issue were similar to a medium degree and, in consequence, there was a likelihood of confusion. The applicant appealed, and the First Board of Appeal of OHIM annulled the Opposition Division's decision, finding that the earlier trademarks and the trademark applied for could not give rise to a likelihood of confusion. Further, the board found that the common word element 'F1' was insufficient in this respect because it was perceived as descriptive in the applied for mark.

Opponent Formula One Licensing appealed to the General Court. The court first noted that the mere fact that the earlier word mark had been registered as a national or international trademark did not prevent it from being largely descriptive or, in other words, from having only a weak intrinsic distinctive character in relation to the goods and services it covers. However, the General Court pointed out that the validity of the applicant's international or national registrations might not be called into question in proceedings for registration of a CTM, but only in cancellation proceedings brought in the member state concerned.

The General Court reached the conclusion that the relevant public would not perceive the 'F1' element in the mark applied for as a distinctive element, but rather as "an element with a descriptive function". The court held that consumers would regard 'F1' in ordinary typeset as an abbreviation of 'Formula 1' - that is to say, as a description - and concluded that there was no likelihood of confusion between the marks at issue.

# World Trademark Review *Daily*

On appeal, the ECJ approved the General Court's finding that the validity of the applicant's international or national registrations might not be called into question in proceedings for registration of a CTM, but only in cancellation proceedings brought in the member state concerned. However, the ECJ found that the General Court's characterisation of a sign as descriptive or generic was essentially equivalent to denying its distinctive character. Therefore, the General Court had called into question the validity of those earlier trademarks in proceedings for registration of a CTM. In those circumstances, Formula One Licensing was justified in claiming that the judgment under appeal was vitiated by an error in law. Consequently, the General Court's judgment was set aside and the case was referred back to the court.

The General Court must now issue a new ruling concerning the issue of likelihood of confusion, this time without effectively ignoring the F1 word mark.

This case appears to build on the Community case law (eg, *MatratzenConcord v OHIM* (Case T-6/01), referred to expressly in this case) whereby weak national marks are given broad protection in oppositions at OHIM. The case started with a far-reaching result for the F1 word mark at the opposition level, but the Board of Appeal and the General Court then curtailed the opponent's rights. While it may appear that the ECJ's decision again broadens the opponent's rights (which would not add legal certainty and encourage appeals), what has actually happened is that the ECJ has remanded the case to the General Court for a new decision - but not necessarily the opposite one. For instance, the ECJ did not appear to take into consideration the fact that national marks might have been registered at a time and in a jurisdiction where distinctiveness was not examined. Although these national rights must now be presumed to be fully valid in a CTM opposition, it remains to be seen whether the General Court will be able to find that there is no likelihood of confusion without completely denying the distinctive character of the national F1 mark.

*Peter Gustav Olson, MAQS Law Firm, Copenhagen*

---

**World Trademark Review ([www.worldtrademarkreview.com](http://www.worldtrademarkreview.com)) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.**