

Formula One's "F1" mark ruled not well-known in Singapore

January 11, 2016

Executive summary

The Singapore High Court has held that the Formula 1 motor race and the F1 H20 powerboat race brand names can co-exist. The High Court Judge held that the "F1" mark was not associated exclusively with the motor race before the relevant date of 11 January 2007. In addition, it was found that before that date, "F1" was the standard by which various vehicles, whether cars or boats, were categorized and, on the evidence, the public did not associate "F1" exclusively with motor races.

Introduction

The Applicant, Idea Marketing SA, is the global promoter for the F1 Powerboat World Championship, a powerboat racing event. These were held in Singapore in 1993, 2003, 2004 and 2005. On 28 March 2007, the Applicants filed an application to register the "F1H20" mark in Singapore, claiming priority from 11 January 2007 (the "**relevant date**").

The Opponent, Formula One Licensing BV, is the trademark owner and manager for the Formula One Grand Prix car racing championship. The Opponent opposed the Applicant's "F1H20" mark on the following grounds:

1. the marks were similar and covered goods or services that were similar and there exists a likelihood of confusion;
2. the Opponent's marks were well-known in Singapore and the use of "F1H20" would indicate a connection between the parties and likely damage the interests of the Opponent;
3. the Opponent's marks were well-known in Singapore and the use of "F1H20" would cause dilution in an unfair manner of the distinctive character of the Opponent's marks;
4. the Applicant was passing off its goods/services as those of the Opponent's; and
5. the Applicant's "F1H20" mark was applied for in bad faith

In support of the opposition, the Opponent had also relied on the plain "F1" word mark that was registered after the relevant date as well as three registered marks that were registered before the relevant date.

The registered marks were:



FORMULA 1



The Opponent's reliance on the plain "F1" mark was that it qualified as an earlier unregistered mark which was

well-known in Singapore.

In the first instance decision of *Formula One Licensing BV v Idea Marketing SA* [2013] SGIPOS 8 by the Intellectual Property Office of Singapore (“**IPOS**”), it was held by the Learned Assistant Registrar Diyanah Binte Baharudin that the Applicant’s F1H20 mark should be allowed to proceed to registration. On appeal to the High Court by the Opponent, the IPOS decision was upheld.

Findings of the High Court

Justice Tay Yong Kwang, agreed with the Learned Registrar of IPOS in dismissing the opposition and allowed the Applicant’s “F1H20” mark to proceed to registration.

He agreed with the finding at IPOS that prior to the relevant date, the terms “F1” and “Formula 1/One” were descriptive and that “F1” was the standard by which the vehicles, whether motor cars or powerboats, were categorised, and the media did not associate “F1” exclusively with the Opponent. Therefore, the unregistered “F1” mark was not well-known in Singapore by January 2007.

The Judge went on to compare the “F1H20” mark with each of the Opponent’s three registered marks to determine whether the Applicant’s mark is disqualified from registration for being similar to an earlier registered mark.

The Learned Judge found that “F1H20” was visually, aurally and conceptually dissimilar to the registered marks. The Judge also found that there was no evidence to suggest that the reasonable consumer was likely to be confused and any possibility of confusion as suggested by the Opponent was only speculative.

Next, the Learned Judge also found that the Opponent failed in establishing that the Applicant had committed the tort of passing off. The Judge held that the Opponent did not have any goodwill in its “F1” mark as it had not started holding its races in Singapore by the relevant date. The first night race in Singapore was held in 2008.

The Learned Judge held that although pre-trading activities may lead to a finding of goodwill, the evidence lodged by the Opponent did not support such a conclusion. In addition, the Judge held that there was no misrepresentation by the Applicant as the term “F1” was first applied to the Applicant’s powerboat races in Singapore 18 years before the Opponent’s night races were held in Singapore. Therefore, at the relevant date, the plain “F1” mark was not linked exclusively with the Opponent.

Finally, the Learned Judge found that the Opponent had not adduced any evidence to discharge its legal burden to prove bad faith.

Future implications of the case

This is a decision that highlights the importance of evidence, which may make or break a case. It reiterates that only evidence prior to the filing/priority date of the mark being opposed will be considered in determining if an opponent’s mark is well-known. Therefore, even though in 2016, the man on the street may associate the “F1” term exclusively with the car racing event held in the heart of Singapore’s city, for the purposes of this case, the Court’s findings are sound – the Court can and shall only base its findings on the evidence placed before it that falls before the relevant date. The decision emphasizes the importance of gathering and tendering substantive, reliable evidence that well pre-dates the mark being opposed if an opponent is to rely on the fact that a mark is allegedly well-known to the relevant sector of the public.

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