

**IN THE HEARINGS AND MEDIATION GROUP OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T0715123H
International Trade Mark Registration No. 925383
30 September 2013

IN THE MATTER OF A TRADE MARK APPLICATION BY

IDEA MARKETING SA

AND

OPPOSITION THERETO BY

FORMULA ONE LICENSING B.V.

Hearing Officer: Ms Diyanah Binte Baharudin
Assistant Registrar of Trade Marks

Ms Ngori Soon Hui (Drew & Napier LLC) for the Applicants
Mr Daryll Ng, Mr Arthur Loke and Ms Lauren Tang (Virtus Law LLP (Incorporating Arthur Loke LLP)) for the Opponents

Cur Adv Vult

GROUNDSC OF DECISION

1 Idea Marketing SA (the "Applicants") applied to protect the trade mark **F1H2O** (the "Application Mark") in respect of the following goods on 28 March 2007 ("Application Date") (priority date 11 January 2007 in respect of all classes):

Class 09

Sunglasses and spectacles; cords, spectacle frames, lenses and cases for sunglasses and optical apparatus; apparatus for recording, transmitting and reproducing sound or

images; magnetic recording media, recording discs; data processing and computer apparatus and equipment, computers; video games, games for computers and microcomputers; game apparatus for computers and software, in particular computer games.

Class 25

Clothing, footwear, headgear.

Class 38

Broadcasting by radio and television, also on digital networks in particular services directly or indirectly linked to the Internet; telecommunications; electronic transmission of data, images and sound using computer terminals and computer networks, also via the Internet and websites.

Class 41

Education, training; entertainment; sporting and cultural activities; direction, management, organization and execution of sporting competitions, shows, films, games provided online on a computer network.

2 The Application Mark was accepted and published on 21 August 2009 for opposition purposes. Formula One Licensing B.V. (the “**Opponents**”), filed their Notice of Opposition to oppose the registration of the Application Mark on 9 October 2009. The Applicants filed their Counter-Statement on 12 February 2010.

Grounds of Opposition

3 The Opponents rely on Sections 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**the Act**”) in this opposition. The Opponents had initially relied on Section 8(2)(a) of the Act but later dropped this ground of opposition. The Applicants did not object to the same.

Opponents’ Evidence

4 The Opponents filed the following statutory declarations in support of their opposition:

- (i) 1st statutory declaration of Patricia Ann Heavey on 14 October 2010 (dated 11 October 2010) (“**1st Heavey**”);
- (ii) 2nd statutory declaration of Patricia Ann Heavey on 14 June 2011 (dated 7 June 2011) (“**2nd Heavey**”); and
- (iii) 3rd statutory declaration of Patricia Ann Heavey on 6 May 2013 (dated 3 May 2013) (“**3rd Heavey**”).

Applicants’ Evidence

5 The Applicants filed the following statutory declarations in support of the application:

- (i) 1st statutory declaration of Michel Renaud and Jean Menthonnex on 16 February 2011 (dated 11 February 2011) ("1st Renaud");
- (ii) 2nd statutory declaration of Michel Renaud and Jean Menthonnex on 23 March 2011 (dated 18 March 2011) ("2nd Renaud"); and
- (iii) 3rd statutory declaration of Michel Renaud and Jean Menthonnex on 4 February 2013 (dated 28 January 2013) ("3rd Renaud").

6 The Pre-Hearing Review was held on 22 March 2013 and the opposition was heard on 30 September 2013.

Applicable Law and Burden of Proof

7 As the applicable law is the Act, there is no overall onus on the Applicants either before the Registrar during examination or in the present opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.

Introduction

8 The present decision comes at a time when the terms "F1", "FORMULA 1/ONE" and "F1 Singapore Grand Prix" are arguably associated with a series of night races for motor racing, organised by Formula One Administration Limited, a company that is part of the Opponents' group of companies, which have been held in Singapore for the past six years (ie. 2008 – 2013). However, the issue in the present opposition proceedings is whether the Application Mark should be allowed to proceed to registration **as at the date it was deemed to have been applied for, ie., 11 January 2007**. As such, any evidence that post-dates 11 January 2007 is irrelevant for the present opposition proceedings.

9 Prior to the arrival of this series of night races, the Applicants had organized **five** powerboating championships in Singapore, in 1990, 1993, 2003, 2004 and 2005 respectively. In particular, the Applicants made significant investment in advertising and promoting the 2004 edition of the powerboating championships in the local media. The terms "F1" and "FORMULA 1/ONE" were used interchangeably to describe the Applicants' event and also refer to a particular standard associated with powerboating. In 2003 and 2004, several references comparing the "F1"/"FORMULA 1/ONE" powerboating event to "F1"/"FORMULA 1/ONE" motor racing were made in the local media.

10 The Opponents and the Applicants are engaged in a worldwide, multi-jurisdictional battle over the registration of the mark, "F1H2O", namely, in Switzerland, Japan, Republic of Korea, the European Community, Australia and the Russian Federation. The Applicants have thus far been successful in Switzerland, Japan, Republic of Korea and the European Community (pending appeal). The Opponents have withdrawn their opposition in Australia, whilst there is no information on the outcome on the Opponents' application in the Russian Federation as yet.

11 In the present opposition, a key issue is whether the Opponents' plain letter "F1" mark was "well known" in Singapore as at 11 January 2007. If so, the Opponents would be able to rely on this as an "earlier trade mark" that is similar to the Application Mark, "F1H2O", and thereby seek to prevent registration of the Application Mark. If not, the Opponents will only be able to rely on certain other marks which were registered in Singapore earlier than the filing date of the Application Mark, taking into account the priorities claimed in respect of the trade mark, namely:

| Mark | Mark numbers |
|--|---|
|  | T9710956B, T9710957J, T9710958I, T9710959G, T9710960J, T9710961I, T9710962G, T9710963E, T9710964C T0407630H, T0407631F, T0407633B, T0407634J, T0407635I, T0407636G, T0407637E, T0407639A, T0407640E, T0407641C, T0407642A |
| FORMULA 1 | T9710975I, T9710976G, T9710977E, T9710978C, T9710979A, T9710980E, T9710981C, T9710982A, T9710983Z |
|  | T9710967H, T9710971F and T9710972D |

Background

12 The Applicants were appointed as the global promoter for the F1 Powerboat World Championship (the "**F1 Powerboat Championship**"), a high-octane powerboat racing event, in 1993. The F1 Powerboat Championship started globally in the year 1981 and is one of the many watersport competitions administered around the world by the sporting body, Union Internationale Motonautique ("UIM"). Use of the terms "F1" and "FORMULA 1" in the context of powerboating in Singapore first began in the year 1990, with the first F1 Powerboat Championship held under the name "Caltex World Formula One Powerboat Grand Prix" (3rd Renaud, at [6], Exhibit D). A second powerboating championship was held under the name "World Formula 1 Singapore Powerboat Grand Prix" in 1992 (1st Renaud at [13], pp 42-44). Subsequently, the "F1 Powerboat Championship" was held in Singapore for a number of years, ie. 1993, 2003, 2004 and 2005 (1st Renaud at [14], pp 45-50).

13 The Applicants' evidence shows that they have spent some \$192,160 on cinema and outdoor billboard advertising and some \$56,700 on local television advertisement airtime to promote the F1 Powerboat Championship in 2004 (3rd Renaud, Exhibit E, p 148). A substantial amount of local press was generated as a result of the F1 Powerboat Championships in 2003 and 2004 (3rd Renaud, Exhibit E).

14 The Opponents, on the other hand, are the trade mark managers for the FIA Formula One World Championship (the "**F1 Motor Championship**"). In 1997, the Federation Internationale de l'Automobile ("FIA") granted the right to organise and commercially exploit the F1 Motor Championship to the Opponents' group of companies (1st Heavey at [6.3]-[6.4], pp 3-4). They opposed the Application Mark on the basis of their prior registrations, as follows:

| Trade Mark | Trade Mark No | Class | Application Date |
|---|----------------------|---|---|
| | | | Priority Date |
| F1 | T0716488G | 03,04,09,12,14,1 6,18,21,24,25,26, 28,30,34,35,38,4 1,42 | 10 May 2007 - |
|  | T0716681B | 01,03,04,07,08,0 9,11,12,14,16,18, 21,25,28,29,30,3 2,33,34,35,36,38, 39,41,42,43 | 10 May 2007 - |
|  | T9710956B | 04 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710957J | 09 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710958I | 16 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710959G | 18 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710960J | 25 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710961I | 28 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710962G | 38 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710963E | 41 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710964C | 42 | 05 September 1997 - |
|  | T0407630H | 09 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407631F | 12 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407633B | 16 | 05 September 2003 11 July 2003 (Benelux) |

| Trade Mark | Trade Mark No | Class | Application Date |
|---|----------------------|--------------------|---|
| | | | Priority Date |
|  | T0407634J | 32 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407635I | 33 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407636G | 34 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407637E | 35 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407639A | 38 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407640E | 39 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407641C | 41 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0407642A | 42 | 05 September 2003 11 July 2003 (Benelux) |
|  | T0710361F | 14 | 11 May 2007 - |
|  | T0710362D | 36 | 11 May 2007 - |
|  | T0710363B | 43 | 11 May 2007 - |
| F1 PIT STOP CAFE | T0719124H | 16, 18, 21, 25, 43 | 24 September 2007 - |
| FORMULA 1 | T9710975I | 04 | 05 September 1997 - |
| FORMULA 1 | T9710976G | 09 | 05 September 1997 - |
| FORMULA 1 | T9710977E | 16 | 05 September 1997 - |
| FORMULA 1 | T9710978C | 18 | 05 September 1997 - |
| FORMULA 1 | T9710979A | 25 | 05 September 1997 - |
| FORMULA 1 | T9710980E | 28 | 05 September 1997 - |
| FORMULA 1 | T9710981C | 38 | 05 September 1997 - |
| FORMULA 1 | T9710982A | 41 | 05 September 1997 |

| Trade Mark | Trade Mark No | Class | Application Date | Priority Date |
|--|---------------|--|-------------------|------------------------------|
| FORMULA 1 | T9710983Z | 42 | 05 September 1997 | - |
| FORMULA 1 | T0715769D | 04, 09, 12, 16, 18, 25, 28, 35, 38, 41, 42 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0703065A | 09 | 13 February 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0703067H | 16 | 13 February 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0703068F | 18 | 13 February 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0703069D | 25 | 13 February 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0703071F | 28 | 13 February 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0703072D | 38 | 13 February 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0703073B | 41 | 13 February 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710246F | 03 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710247D | 14 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710248B | 21 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710249J | 32 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710250D | 33 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710251B | 34 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710252J | 35 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710253I | 36 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710254G | 39 | 10 May 2007 | - |
| FORMULA 1 SINGAPORE GRAND PRIX | T0710255E | 43 | 10 May 2007 | - |
| FIA HISTORIC FORMULA ONE CHAMPIONSHIP | T0721333J | 16, 38, 41 | 18 May 2007 | - |
| FIA FORMULA ONE WORLD CHAMPIONSHIP | T0721334I | 16, 38, 41 | 18 May 2007 | 31 January 2007 (Benelux) |

| Trade Mark | Trade Mark No | Class | Application Date Priority Date |
|---|---------------|------------|--|
|  | T9710967H | 16 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710971F | 38 | 05 September 1997 30 May 1997 (Austria) |
|  | T9710972D | 41 | 05 September 1997 30 May 1997 (Austria) |
|  | T0721704B | 16, 38, 41 | 23 May 2007 27 March 2007 (Benelux) |
|  | T0906526F | 39, 41, 43 | 02 February 2009 30 October 2008 (Benelux) |

(collectively, the "**Opponents' Marks**")

15 The Opponents made reference to the "F1 Logo" throughout their evidence and their written submissions. At the hearing, the Opponents clarified that this was a reference to the **plain letter "F1"** mark. I shall refer to this as the "**Plain F1 Mark**".

16 The Opponents' group of companies will usually appoint a separate company (the "**Promoter**") to promote and advertise the F1 Motor Championship. Such promotion and advertisement includes, *inter alia*, the use of the Plain F1 Mark on programme booklets, tickets and other literature. The Promoter is also obliged to erect a number of structures all of which bear the Plain F1 Mark. The Opponents maintain strict standards in relation to the use of the Opponents' Marks, including the Plain F1 Mark, by the Promoter. The Opponents also carry out broadcasting services using the Plain F1 Mark, ensuring consistent high quality television coverage of each F1 Motor Championship race, which includes footage of the Opponents' Marks, including the Plain F1 Mark, used at the podium ceremony in each race. Based on these statements, the Opponents conclude that the Opponents' Marks enjoy an "outstanding level of distinctiveness" in relation to Classes 38, 41 and 42, for, *inter alia*, "radio and television broadcasting", "production of sports events" and "scientific and technological services and research and design relating thereto" (1st Renaud, [8.3.1], p 11).

17 Off the track the Opponents' Plain F1 Mark and the word marks "FORMULA 1/ONE" are also used on other goods and services, such as printed publications, computer games, season review videos/DVDs, mobile phones, clothing and souvenirs such as

mugs, bags, watches, toys, beer and champagne. In particular, since February 2004, the Opponents' Group granted a licence to HAYMARKET PUBLICATIONS LIMITED to use the Plain F1 Mark in the title of their monthly magazine titled "F1 RACING", which is "published in numerous countries including Singapore." In relation to merchandising of souvenir products, "an Asianwide licence, including Singapore" was granted to LOGO HOUSE SDN BHD in 2003, to use the Plain F1 Mark on a range of products offered for sale. The Opponents routinely receive licensing requests from third parties, but are very selective about the organizations and companies they wish their marks to be associated with. The Opponents submit that these requests for consent show that the Opponents' Marks enjoy a great level of consumer awareness and acceptance and an enhanced level of distinctiveness for goods and services in Class 3, 9, 14, 16, 18, 21, 25, 28, 33, 34, 35, 39 and 43 (see, generally, 1st Heavey, [9.1], pp 18-19).

PRELIMINARY DECISION

18 At the hearing, the Opponents referred to a trade mark which had not been pleaded in their Notice of Opposition dated 9 October 2009 ("**Notice of Opposition**"), which has been referred to in 1st Heavey. This trade mark was described as ""F1" in plain lettering registered in the name of FOL [not defined]...Benelux trade mark No 657310 with a priority of 25 June 1999" (the "**Benelux F1 Mark**"). No representation of the Benelux F1 Mark has been included in 1st Heavey.

19 Rule 30 of the Trade Marks Rules (Cap 332, 2008 Rev Ed) ("**the Rules**") reads

Contents of notice of opposition

30. –(1) The notice of opposition shall contain a statement of the grounds upon which the opponent opposes the registration.

(2) If registration is opposed on the ground that the mark is identical or similar to an earlier trade mark —

- (a) a representation of the earlier trade mark;
 - (b) the registration number of the earlier trade mark, if registered, or the number accorded by the Registrar to the application for registration of the earlier trade mark, if pending registration; and
 - (c) the class number and specification of the goods or services in respect of which the mark is registered or for which registration is sought or, if the mark is neither registered nor pending registration, in respect of which the mark is used,
- shall be included in the notice for the purpose of determining if the mark is identical or similar to the earlier trade mark

20 Rule 30 of the Rules specifies that it is the **notice of opposition** (as opposed to the **statutory declaration**) which shall contain a statement of the grounds upon which the opponent opposes the registration and that the opponent is to specify the earlier trade

mark he is relying on. The Opponents have not included the Benelux F1 Mark as an earlier trade mark upon which the Opponents are relying for the opposition. Neither have they made any application to amend their Notice of Opposition to include the Benelux F1 Mark either on the hearing day or prior to the hearing itself. As the Benelux F1 Mark has not been pleaded as an earlier trade mark that the Opponents are relying on, it is disregarded in the context of the present opposition proceedings.

MAIN DECISION

Ground of Opposition under Section 8(2)(b)

21 Section 8(2)(b) of the Act reads:

8. — (2) A trade mark shall not be registered if because —

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

Threshold Issue – What are the Opponents' "earlier trade mark(s)"?

22 There is some dispute between the parties as to which of the Opponents' Marks should be considered as "earlier trade mark(s)" under Section 8(2)(b) and Section 8(4)(b) of the Act. I will deal with this threshold issue first to determine which of the Opponents' Marks should be compared with the Application Mark for the purposes of Section 8(2)(b) and Section 8(4)(b) of the Act.

23 Section 2(1) of the Act defines an "earlier trade mark" as

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) **a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,**

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

(Emphasis added)

24 Section 2(1) of the Act defines a "well known trade mark" as

- (a) any registered trade mark that is well known in Singapore; or
- (b) **any unregistered trade mark that is well known in Singapore** and that belongs to a person who —
 - (i) is a national of a Convention country; or
 - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,
whether or not that person carries on business, or has any goodwill, in Singapore.

(Emphasis added)

25 Section 2(7) of the Act provides the factors to be taken into account when deciding whether a trade mark is "well known" in Singapore:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of —
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

26 Section 2(8) of the Act states that "[w]here it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore."

27 Finally, Section 2(9) of the Act defines the “relevant sector of the public in Singapore” in Section 2(7) and 2(8) as including any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods to which the trade mark is applied;

- (b) all persons in Singapore involved in the distribution of the goods to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods to which the trade mark is applied.

Opponents' Submissions

28 The Opponents submit that all of the Opponents' Marks are "earlier marks" within the definition of Section 2(1)(a) of the Act. In the alternative, the Opponents submitted that even if these marks were not considered "earlier marks", these marks (in particular, the Plain F1 Mark) would satisfy the definition of being "well known" in Singapore under Section 2(1)(b) of the Act. In particular, the Opponents urged me to consider the concept and idea of "F1" as a whole, that it is evocative of motor racing. The Opponents did not dispute the Applicants' submission that the relevant date to consider would be the priority date of the Application Mark, on 11 January 2007.

29 The Opponents submitted, at the hearing, that the relevant sector of the public for the purposes of determining whether the Opponents' marks were "well known" would refer to the public at large.

30 The Opponents submitted that the history of the trade marks "F1" and "FORMULA 1" began in 1948 when the FIA developed a set of rules identifying the technical specification to which motor cars must comply in order to compete in the FIA's prestigious FIA Formula One World Championship which was to commence in 1950. These races represented the pinnacle of single seater racing car design, incorporating dramatic advancement in motor car design that had taken place during the Second World War. The trade marks "F1" and "FORMULA 1" had been used as identifiers of that particular series of races and have, since 1950, been used to designate the organizing of these races and the commercial activities connected therewith.

31 To illustrate the point, the Opponents referred me to a book written by Ian De Cotta (a Senior Correspondent with the local TODAY newspaper) ("De Cotta Book") (2nd Heavey, Annex K) on the history of motor racing in Singapore. The Opponents highlighted parts of the book that described the history of motor racing in Singapore in the following terms:

By no means was motor racing just a spectator sport in Singapore. There had always been a racing culture on the island, after the birth of the Singapore Motoring Club (SMC) in 1949 and the British Forces Motor Club in 1956. Both clubs regularly organised private motorsports events in Singapore and across the Causeway in what was then still called Malaya.

.....

By 1973, confidence was high that motor racing was moving in a big way for Singapore. All indications were that Singapore would, in time, be ready for Formula 1.

But the Singapore Grand Prix died a sudden death and motor racing went into a tailspin, with small group of men with a passion for the sport keeping it alive. Thirty-five years would pass before Singapore returned as a venue for motorsports in the biggest possible way, with Formula 1's SingTel Singapore Grand Prix on September 28, 2008.

32 The Opponents also tendered several press articles documenting the hype leading up to the Opponents' first night race in Singapore in 2008, including the following:

- (i) Article from TODAY newspaper, "*Singapore pit-stop for F1?*", dated 28 March 2006;
- (ii) Article from TODAY newspaper, "*Thumbs up for F1 in S'pore*", dated 29 March 2006, citing the Singapore Tourism Board's welcoming "the possibility that Singapore could now host a round of the Formula 1 world championships";
- (iii) Article from TODAY newspaper, "*Mosley backs F1 in Singapore*", dated 31 March 2006;
- (iv) Article from TODAY newspaper, "*300 kmh on S'pore roads?*", dated 12 January 2007, informing that "F1 supremo Bernie Ecclestone has been in talks with at least two Singaporean groups to stage a race here as early as next year";
- (v) Article from TODAY newspaper, "*And Alonso's first past the Merlion!*" dated 15 January 2007;
- (vi) Internet article by Channel News Asia, "*Motor racing: Singapore to host the first F1 Grand Prix*" dated 11 May 2007, writing that "Singapore will host its debut Formula One Grand Prix on a street circuit next year";
- (vii) Internet article on "The Official F1 Website", "*Singapore confirms 2008 night race*" dated 11 May 2007.

33 Several other news articles pertaining to the Opponents' "Formula 1 SingTel Singapore Grand Prix" in 2008 were also tendered.

34 The Opponents submitted, briefly, that their motor races have been held in Sepang, Malaysia, since 1999, and that Singaporeans would be familiar with the Opponents' motor races as a result of Singapore's proximity with Malaysia.

Applicants' Submissions

35 The Applicants submitted that to qualify as an earlier trade mark under Section 2(1) of the Act, the Opponents' Marks must either have filing/priority dates earlier than 11 January 2007, which is the date on which the Application Mark is deemed to have been registered, by virtue of priority claimed from an earlier Swiss trade mark registration. The Applicants submit that only the following marks pre-date the Application Mark:

| Mark | Mark numbers |
|---|---|
|  | T9710956B, T9710957J, T9710958I, T9710959G, T9710960J, T9710961I, T9710962G, T9710963E, T9710964C T0407630H, T0407631F, T0407633B, T0407634J, T0407635I, T0407636G, T0407637E, T0407639A, T0407640E, T0407641C, T0407642A |
| FORMULA 1 | T9710975I, T9710976G, T9710977E, T9710978C, T9710979A, T9710980E, T9710981C, T9710982A, T9710983Z |
|  | T9710967H, T9710971F and T9710972D |

36 However, to err on the side of caution, the Applicants proceeded to consider whether all the Opponents' Marks were "well known". The Applicants submitted, firstly, that the relevant sector of the public would be the actual and potential consumers in Singapore of the Opponents' motor-sporting events and merchandise, distributors of the Opponents' motor-sporting events and merchandise and other businesses, companies dealing in similar motor-sporting events and merchandise as well as companies interested in becoming the licensees of Opponents' Marks, citing *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216; [2009] SGCA 13 ("Amanresorts") and *Chery Automobile Co Ltd v Tencent Holdings Limited* [2010] SGIPOS 3 ("Chery Automobile").

37 The Applicants submit that the Opponents have not lodged any evidence to show the extent to which their marks are known to or recognized by the relevant sector of the public in Singapore. The Opponents have only made general and unsubstantiated claims as to the use of their marks which have no reference to the Singapore market, save for three instances listed below. In any event, no evidence of these three instances have been provided (in 1st Heavey):

- (i) The Opponents' description of how a local event would have been named along the lines of "Formula 1 Singtel Singapore Grand Prix" if Singtel were the promoter appointed;
- (ii) The Opponents' reference to how a monthly magazine F1 RACING is "published in numerous countries including Singapore; and
- (iii) The Opponents' reference to "an Asian-wide license, including Singapore", granted to a company to use the "F1 Logo" on various products.

38 In relation to the TODAY newspaper articles at Annex I of the Opponents' 2nd Heavey, the Applicants submit that these articles only deal with the possibility of the Opponents' motor-racing events being held in Singapore and do not demonstrate that the Opponents' marks had become well known in Singapore as at 11 January 2007 or 28

March 2007 (the latter date used in relation to the Opponents' submission as to Section 8(5) read with Section 8(4) of the Act, which will be discussed later).

39 In relation to the articles from internet websites at Annex J of the Opponents' 2nd Heavey, the Applicants submit that these are irrelevant as they post-date 28 March 2007. As for the De Cotta Book at Annex K of the Opponents' 2nd Heavey, the Applicants submit that the book contains a "Foreword" dated July 2008, which can only mean that the book was published later that year (2008). The conclusion to the De Cotta Book only cements the view that the Opponents did not have a presence in Singapore prior to 2008:

"We knew that Formula 1 was somewhere on the horizon and it would be a shame if Singapore's rich history in motor sport was forgotten in the hype. We wanted Singaporeans to know, should the engines of Formula 1 cars ever roar to life here, that they were not the first high-powered cars to have raced on our streets."

40 The Applicants submit that the Opponents have not addressed the deficiency in their evidence and have only referred to their Formula One World Championship held in 2008 and 2010 in Singapore (2nd Heavey, at [27]). Since these races took place after 11 January 2007 or 28 March 2007, the claims made by the Opponents as to the number of persons attending these races and their turnover are completely irrelevant. The Applicants also submit that the registration of the Opponents' trade marks in Singapore prior to the Application Date is irrelevant because registration does not equate to use of the marks in the Singapore market, and that in any case, the Opponents' earliest local trade marks were only filed in 1997 – seven years after the first F1 powerboat racing championship took place in Singapore. The Opponents' reference to a survey carried out on the German population that "F1" enjoys an "outstanding level of consumer awareness and a pre-eminent reputation" in Germany is irrelevant because it was not carried out in Singapore.

Decision on Threshold Issue

Relevant Date

41 To qualify as an earlier trade mark under Section 2(1) of the Act, the Opponents' Marks must either have filing/priority dates earlier than 11 January 2007 or must have been well known before 11 January 2007.

42 In their written submissions, the Applicants have referred to Section 8(5) of the Act to show that the Opponents must establish that in respect of those of their marks which qualify as "earlier marks" relative to the Application Mark, these had become well known in Singapore before the filing date of the Application Mark, ie. since 28 March 2007. However, in this case, there is no objection by the Opponents that the relevant date is 11 January 2007. If the Opponents have the burden of proving that the Opponents' Marks are well known prior to 11 January 2007, it does not add anything to the Applicants' case that the Opponents must additionally show that they were well known prior to 28 March 2007. I will therefore consider the relevant date to be 11 January 2007 only.

Evidence to be taken into account

43 Another issue that arose during the hearing was whether the evidence relating to the Opponents' Marks after 11 January 2007 should be taken into consideration in determining whether the Opponents' mark was well known before that date. On this point, counsel for the Applicants took the position that this would mean all evidence that was dated after 11 January 2007 should not be taken into account. Counsel for the Opponents submitted that there should not be a specific "cut-off" date to determine which evidence was relevant. Articles post-dating 11 January 2007 would still be relevant if used to illustrate continuity and historical evidence. No authorities were tendered by either party on this specific point.

44 I agree with the Applicants that the material which post-dates the relevant date of 11 January 2007 should generally not be taken into account for the purposes of the inquiry. This includes the Bridgestone's Guide to Singapore's 1st Night Race 2008 (2nd Heavey, Annex K) and several TODAY news articles dated 12 January 2007 and 15 January 2007 (2nd Heavey, Annex I) and the De Cotta Book (2nd Heavey, Annex K). I note that in the "Acknowledgements" page, the author writes that "It was June 2008. The book had to go to the printers in August. I had just three months to deliver the book," which suggests that the book was only published in September 2008.

45 In any event, the Opponents are using the De Cotta Book not so much as evidence of the Opponents' use and promotion of the mark, but rather, evidence that proves the existence of historical facts regarding a "Singapore Grand Prix" in the 1960s – 1970s. A document adduced to establish the facts it refers to in the absence of direct evidence of the facts contained in it (ie. the evidence of someone who has personal knowledge of the facts) would be generally inadmissible as it is hearsay: **Pinsler, Jeffrey, Evidence and the Litigation Process (3rd Edition)** (LexisNexis: 2010). The Opponents have not put forward any arguments as to why this evidence should be admitted pursuant to an exception to the hearsay rule. Accordingly, the facts stated in the De Cotta Book are treated as inadmissible in the present opposition proceedings.

"Earlier Trade Mark"

46 The plain wording of Section 2(1)(a) provides that an "earlier trade mark" is one that has a registration date that is earlier in time than an application mark, taking into account the relevant priority dates in respect of the trade marks. Since the Application Mark has a priority date of 11 January 2007, it follows that only the Opponents' trade marks that were registered earlier than 11 January 2007 will be considered to be "earlier trade marks". I agree with the Applicants' submission that the following will be considered to be the Opponents' "earlier trade marks" under Section 2(1)(a) of the Act:

| Mark | Mark numbers |
|------|--------------|
| | |

| Mark | Mark numbers |
|---|---|
|  | T9710956B, T9710957J, T9710958I, T9710959G, T9710960J, T9710961I, T9710962G, T9710963E, T9710964C T0407630H, T0407631F, T0407633B, T0407634J, T0407635I, T0407636G, T0407637E, T0407639A, T0407640E, T0407641C, T0407642A |
| FORMULA 1 | T9710975I, T9710976G, T9710977E, T9710978C, T9710979A, T9710980E, T9710981C, T9710982A, T9710983Z |
|  | T9710967H, T9710971F and T9710972D |

"Well Known in Singapore"

47 The Opponents have submitted that all the Opponents' Marks should be considered in determining the question of whether they are "well known in Singapore" and therefore an "earlier trade mark" under Section 2(1)(b) of the Act. However, they acknowledged that of these marks, they would only rely on the Plain F1 Mark to determine if there has been any confusion. They urged me to consider "the concept of F1 as a whole." In any event the evidence only makes reference to the application of the word marks "F1" and "FORMULA 1/ONE" to the Opponents' goods and services. No evidence has been tendered as to the application of any of the other Opponents' Marks to the Opponents' **goods and services per se**. The analysis in the following section will cover all of the Opponents' Marks, but my focus will be on whether the Plain F1 Mark can be considered to be well known in Singapore, given that it was registered beyond the relevant date and cannot automatically qualify as an "earlier trade mark."

48 I find that the Opponents' Marks and specifically, the Plain F1 Mark, are not well known in Singapore as at 11 January 2007. My reasons are as follows.

Relevant sector of the public

49 In considering the application of the factors listed in Section 2(7) of the Act to determine if a mark is "well known", the Court of Appeal explained the competing considerations for protecting well known trade marks in *Amanresorts* at [143] and [144] as follows:

143 There is an overarching policy question, applicable to the general construction of all provisions on the protection of well-known trade marks, which reflects a tension between two key positions. On the one hand, well known trade marks are usually the result of careful planning, hard work, large investments in branding and marketing as well as an established presence in a market. From this perspective, well-known trade marks deserve to be protected because of the time,

effort and money which have been expended on their development and promotion. Alternatively, one could justify protection of well-known trade marks from a consumer welfare perspective, in that such trade marks perform crucial signalling, symbolic and even myth-making roles in society. These views may lead one to conclude that well-known trade marks should be given greater protection than what may loosely be called "ordinary" trade marks (*ie*, trade marks which do not satisfy the definition of "well known trade mark[s]" in s 2(1) of the current TMA).

144 On the other hand, one may legitimately ask whether well-known trade marks deserve any better protection than ordinary trade marks. There are strong economic and social reasons why the answer to this question may well be "no". Monopolies and barriers to entry created by strong trade mark protection are disincentives to competition and distort the proper functioning of the free market economy. Socially, the commercial monopolisation of words and symbols is detrimental to free enterprise, whether of a commercial or a private nature, in so far as well-known trade marks are likely to be important subjects of everyday commentary, comparison and critique. Even if strong protection of well-known trade marks is justified, some argue that the extra-special rights which accompany such protection should be strictly limited to an extremely small group of particularly well-known trade marks.

50 It is with these policy considerations in mind that the Court of Appeal analysed the legislative provisions in relation to well known trade marks, beginning with the definition of who the "relevant sector of the public" should be for the purposes of Section 2(9) of the Act. The Court of Appeal, citing the Explanatory Notes to the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks ("Joint Recommendation"), held at [146] that

It is not permitted to apply a more stringent test such as, for example, that the mark be well known by the public at large. The reason for this is that marks are often used in relation to goods or services which are directed to certain sectors of the public such as, for example, customers belonging to a certain group of income, age or sex. An extensive definition of the sector of the public which should have knowledge of the mark would not further the purpose of international protection of well-known marks, namely, to prohibit use or registration of either passing off their goods or services as those of the real owner of the mark, or selling the right to the owner of the well-known mark.

(Emphasis added)

51 The Court of Appeal then held that the inquiry into the "relevant sector of the public" would be "much more focused and manageable if one looks only at the specific goods or services to which the plaintiff's trade mark has been applied (*ie*. if one considers only *the plaintiff's* goods or services) (emphasis in judgment), and concluded that the relevant sector of the public in Singapore is the "actual and/or potential consumers of the [Opponents'] goods and services" (at [154]).

52 However, in another section of *Amanresorts* (in the context of analysing the meaning of "would indicate a connection between those goods or services and the

proprietor"), the Court of Appeal held at [229] that "it is not too difficult for a trade mark to be regarded as "well known in Singapore" – essentially, the trade mark in question need only be recognised or known by "any relevant sector of the public in Singapore" [emphasis added] (see s 2(7)(a) of the current TMA), **which sector could in certain cases be minuscule**" (emphasis mine). It must be remembered that this remark was made in the context of the fact scenario in *Amanresorts* – the Amanresorts Group was found to have adopted a "selective marketing campaign" that was "plainly limited to the well-heeled" (at [58] of the judgment). Despite this purposefully small group of persons that their goods and/or services were directed to, the Court of Appeal found that there was evidence of "a great deal of promotion of the "Aman" names targeted at this group of consumers" (at [154]), including (at [5]-[6] and [12]-[19]):

- (i) Worldwide sales of their goods and services of more than S\$39 million in 1995 to more than US\$86 million in 2006;
- (ii) An international reservations office located in Singapore that handled approximately 30% to 40% of their global reservations;
- (iii) 1,382 Singaporean visitors to Amanusa Bali between 1995 and 2005;
- (iv) More than US\$3 million spent on promoting and marketing their goods and services globally;
- (v) Newsletter "Amanews" distributed to 2,700 persons in Singapore;
- (vi) Marketing strategy to promote the Amanresorts Group to 900 American Express Centurion members and 4,200 American Express Platinum members in Singapore; and
- (vii) Features in several local publications, such as Asian Style Hotels, Singapore, in 2005.

53 In contrast, the Opponents in the present case submit that the "relevant sector of the public" in Singapore is "the public at large," but have not adduced corresponding evidence to prove the same. In view of the dicta in *Amanresorts* at [229] (of the judgement) above, it seems odd that the Opponents would commit themselves to proving that the Opponents' Marks and the Plain F1 Mark are well known to such a broad class of persons, when they could have submitted that the relevant sector of the public was a much smaller group of persons in the first place (and thus, perhaps making their case easier to prove). In their evidence, the Opponents appear to have directed their advertising and promotion activity to a very wide range of persons: in 1st Heavey, the Opponents make reference to the use of the Plain F1 Mark in connection with motor racing (1st Heavey, [7.1] – [7.3]), broadcasting of such motor racing events (1st Heavey, [8.3]) as well as "other goods and services" such as computer games, videos, electronic publishing, news reporting services, business and sports information services, live timing and e-retailing, printed publications, merchandise, including clothing, toys and playthings, bags, jewellery, stationery, party goods, greeting cards, etc, watches, clothing, headgear, bags, car accessories, personal effects, souvenirs, household items, mobile phones, mobile phone applications, champagne, delivery services, beer and even financial services (1st Heavey, [8.5]). However, this is a bare assertion which is unsupported by documentary evidence.

54 The Opponents have just two references in 1st Heavey pertaining to the Singapore market:

- (i) since February 2004, they have granted a licence to HAYMARKET PUBLICATIONS LIMITED to use the Plain F1 Mark in the title of a monthly magazine titled "F1 RACING" and
- (ii) in 2003, the Opponents granted an "Asianwide licence, including Singapore,...to LOGO HOUSE Sdn Bhd to use the F1 logo [the Plain F1 Mark] on a range of products offered for sale including clothing, headgear, bags, stationery, car accessories, personal effects, toys & games, souvenirs, household items (see also [17] above).

55 There are also two references in the Opponents' 2nd Heavey (Annex I) to Singaporeans' attendance at the Sepang International Circuit in Johore Bahru, Malaysia ("Sepang Circuit"):

- (iii) Article from TODAY newspaper, "*Thumbs up for F1 in S'pore*", dated 29 March 2006, stating that the Sepang Circuit "attracts about 15,000 Singapore fans to the Malaysian Grand Prix"; and
- (iv) Article from TODAY newspaper, "*Mosley backs F1 in Singapore*", dated 31 March 2006, where the (then) president of the FIA, Max Mosley, was quoted as saying that "many Singaporeans frequent the Malaysian Grand Prix" and that he "believe(s) Singapore contributes the biggest number of foreign spectators for [the Sepang Circuit] race".

56 In view of the above, I am unable to accept that the relevant sector of the public in Singapore are either the "public at large" (per the Opponents) or the "actual and potential consumers in Singapore of the Opponents' motor-sporting events and merchandise, distributors of the Opponents' motor-sporting events and merchandise and other businesses, companies dealing in similar motor-sporting events and merchandise **as well as companies interested in becoming the licensees of Opponents' Marks**" (per the Applicants; emphasis mine). As the Joint Recommendation explains, in deciding whether to further the purposes of the international protection of well known marks, the relevant sector cannot be the "public at large", but a smaller, specific group to which the Opponents' goods and services are directed to. On the other hand, the Applicants' submission, whilst confining the definition to the motor racing business only, includes "potential" businesses and companies which is not contemplated by Section 2(9)(c). Section 2(9)(c) refers only to "all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied" – and not such **potential** businesses and companies in Singapore. In short, both definitions appear too broad to suit the definition of Section 2(9)(c).

57 In view of the dicta in *Amanresorts* at [229] above, the smallest and most specific group of persons who would have been exposed to the Opponents' Plain F1 Mark as applied on their services (and perhaps goods) would be the Singaporean fans who visit the Sepang Circuit to watch the Malaysia leg of the Opponents' motor races. To take a slightly broader view, the relevant sector of the public would also include the Singapore

distributors and readers of the "F1 RACING" magazine in Singapore as well as the actual and potential consumers of the range of products offered for sale including clothing, headgear, bags, stationery, car accessories, personal effects, toys and games, souvenirs, household items, and their distributors. However, as will be discussed later (see [64] – [76] below), there is no evidence to show that the Plain F1 Mark is well known to either of these groups of persons and the case does not turn upon this definition.

58 I now turn to Section 2(7) of the Act to examine whether the Opponents' Plain F1 Mark is well known to the relevant sector of the public.

Distinctiveness of the Opponents' Plain F1 Mark

59 As stated at [49] above, there is tension between the protection of a well known mark that a trader has made significant investment in and the need to prevent commercial monopolization of trade marks that are essentially "words and symbols" insofar that they should be left free to be the subjects of "everyday commentary, comparison and critique." I find that the Opponents' Plain F1 Mark is descriptive and therefore, I should be cautious in granting the Opponents' Plain F1 Mark "well known" mark protection.

60 The evidence suggests that the Plain F1 Mark is descriptive of a particular class or standard of sport in both motor racing and powerboat racing. The Opponents themselves submit that the term "F1" refers to a set of rules identifying the technical specifications to which motor cars must comply in order to compete in the Opponents' motor racing championship (see above at [30]).

61 The Applicants' evidence also shows that "F1" is the name of a particular standard associated with power boating, as opposed to an invented word to describe the Applicants' power boating event (emphasis added):

- (i) Article from Straits Times newspaper dated 11 September 2004, "*Women making waves*", where Ms Procaccini, one of the managers of the UIM Formula One Powerboat Championship teams, speaking about womens' participation in the sport, informs the newspaper that "[t]here are also many lower divisions like **Formula Two** where [women] can race when they are young and develop passion, and knowledge of the sport";
- (ii) Article from "Think Magazine" dated 18 August 2004, "*UIM F1 Powerboat Championships*", which writes that "[t]he Singapore race forms part of the UIM F1 Powerboat World Championship with points contributing to the overall World ranking, similar to F1 Cars. **Drivers from more than 14 countries compete in a sport which puts them at the pinnacle of their careers, with many having started off in F2 and F4 before reaching the heady heights of Formula 1**"; and
- (iii) Article from I-S Magazine dated 10 September 2004, "*Too Fast Too Furious*", where powerboat racer Massimiliano Moreschi stated in an interview: "When I am not travelling on the F1 Powerboat circuit, I take part in local events using **a different class of boats. While these are not as**

powerful as F1 boats, you still get good practice at high speed maneuvering and reaction times –which helps me prepare for the F1 Championships."

62 Furthermore, it appears that the term "F1" has been used in the context of powerboating in 2003-2004, at the time when the Opponents' "Formula 1" mark (see above at [46]) was already registered. This is evident from the Applicants' numerous newspaper and internet articles which refer to their races as the "F1"/"FORMULA 1/ONE" powerboat race in 2003 and 2004. The two sports (ie. powerboating and motor racing) have even been referred to in the media as being "F1" events without any evidence that the public associates the term "F1" with motor racing in particular. The following news articles in the media draw comparison between the two sports, demonstrating how the term "F1" is equally used in the context of both sports:

- (i) Article from Straits Times (Sports) dated 11 September 2004, "*F1 v F1*", comparing an F1 car and an F1 powerboat;
- (ii) Article from The Sunday Times dated 12 September 2004, "*Women Making Waves*," referring to the "Formula Two" tier of powerboat racing and comparing powerboating with "Formula 1 cars", which is "a completely different world" with "so much more money and a lot more ego";
- (iii) Article in The Peak magazine, "*Precision Masters*", dated 9 September 2004, comparing the points and ranking system of the "UIM F1 Powerboat World Championships" as being "similar to F1 Cars";
- (iv) Article in The Business Times Singapore, dated 15 March 2003, "*Powerboat racing is back – with money and glamour in tow*", stating that "The F1 Powerboat championships is set up in much the same way as Formula One motor racing"; and
- (v) Article in The Business Times Singapore, dated 24 October 2003, "*Storming the Bay; Come this weekend the Marina Bay area will stage the Spore leg of the F-1 Powerboat World Championship after a 11-year hiatus*", referring to the "F-1 motor races" and later referring to the "UIM F-1 promoter" and the "F-1 contingent".

63 I also note that in the European chapter of the parties' dispute, the Fourth Board of Appeal (Case R 1247/2011-4) (20 November 2013) considered that the distinctiveness of the term "F1" and held that it "refers directly to the 'top class of professional motor racing'" and was therefore "descriptive and lacks distinctive character *per se* for sport events (and any other types of goods and services connected to sport events). I am informed that the Opponents have appealed this decision, although there was no information on the results of the appeal at the time of hearing. For the present, it is interesting to note that even in the European Union, the Opponents' primary market (see 1st Heavey at [6.6]), the Plain F1 Mark has not been found to be of any distinctive character for "sport events".

Whether well known to the relevant sector of the public

64 In assessing whether a trade mark is well known in Singapore, the Court of Appeal in *Amanresorts* held at [137] that "it appears that the court is ordinarily free to disregard any or all of the factors listed in s 2(7) as the case requires (subject to [Section 2(7)(a) of the Act]), and to take additional factors into consideration." Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore due to s 2(8) of the Act which states that "[w]here it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore", see [139] of *Amanresorts*. However, the other factors listed in Section 2(7) are only disregarded if the mark in question meets the threshold set in Section 2(7)(a) (see *Amanresorts* at [140]).

65 The Opponents have not adduced sufficient evidence that their Plain F1 Mark was well known as at 11 January 2007 to the relevant sector of the public in Singapore. The evidence referred to at [54]-[55] above are merely bare statements made by the Opponents in relation to the Singapore market. No further particulars as to the circulation of the "F1 RACING" magazine in Singapore or the revenue derived from sales of such magazine in Singapore have been adduced. No supporting documents or other evidence as to either of the Opponents' licensing projects in Singapore have been produced by the Opponents. Accordingly, I find that the Opponents' Marks, specifically the "F1" and "FORMULA 1/ONE" do not satisfy Section 2(7)(a) of the Act.

66 As the Opponents' Marks do not meet the criteria of being well known in Singapore under Section 2(7)(a), I now turn to the next factor in the list of considerations, under Section 2(7)(b) of the Act. Section 2(7)(b) provides that the duration, extent and geographical area of any use or promotion of the mark may be taken into account in the analysis. The Explanatory Notes to the Joint Recommendation ("Explanatory Notes") states that

The duration, extent and geographical area of any use of the mark are highly relevant indicators as to the determination whether or not a mark is well known by the relevant sector of the public. Attention is drawn to Article 2(3)(a)(i), providing that actual use of a mark in the State in which it is to be protected as a well-known mark cannot be required. **However, use of the mark in neighbouring territories, in territories in which the same language or languages are spoken, in territories which are covered by the same media (television or printed press) or in territories which have close trade relations may be relevant for establishing the knowledge of that mark in a given state.** (Emphasis added)

67 As a general remark, it is apparent from the Explanatory Notes that an opponent who claims that his mark is well known in another country or territory should demonstrate how this evidence contributes to the mark being well known in Singapore.

68 In the present proceedings, the Opponents have made very vague references in their statutory declarations as to their activities "globally" (see, for example, 1st Heavey at [8.3.1], [8.5.1]) or "worldwide" (see, for example, 1st Heavey at [8.5.1(a)], [8.5.5(c)], [8.5.7(a)-(b)]), but without any supporting documentation to the same or any explanation as to how they could contribute towards the mark being well known in Singapore. I

highlight the following examples from the Opponents' 1st Heavey with an analysis of the same to illustrate my point:

- (iv) At [8.3.1]: "Apart from organizing the race another prominent activity carried out by the Opponents' Group is to provide broadcasting services under the opposition marks, including the "F1" Logo, for at least the last decade. During this period there has been a transformation of the Championship from a mere live television event to a global television spectacle and this transformation is attributable solely to the efforts of the Opponents' Group. In particular the Opponent ensures high quality television coverage of each race by production of a single "International Feed" which is available to each national broadcaster for transmission by using state-of-the-art technology. Furthermore, Opponents' Group has at a cost of some hundreds of million of dollars over the last 10 years developed the in-car-camera technology which has added a further dimension to the provision of images of broadcasting. Apart from exercising strict quality control of the broadcast Opponent's Group makes sure that the broadcast itself is branded with the "F1" Logo as it is incorporated into the International Feed standard-format title sequence. Apart from that, national broadcasters are obliged to televise each race until at least 10 minutes after the finish, in order to show the Opponent's marks, including the "F1" Logo, during the podium ceremony. Summarizing, it is Opponent's Group's role as a TV broadcaster that has ensured the **worldwide quality** of television coverage of the races, which has, in turn, enhanced the reputation of the races and thus the consumer awareness of the Opponent's marks."
- a) Analysis: Apart from the fact that it is unclear whether it was the Opponents or another company within their group or a third party who had undertaken the promotion and advertisement of the mark, there are no further particulars as to which countries the programme was broadcast to, who the "national broadcasters" referred to are, and how much viewership the Opponents had managed to garner for each country. Further, there is nothing to suggest that such efforts have contributed to the mark being well known in Singapore.
- (v) At [8.5.1(a)]: "One of the most successful ranges of products bearing the "F1" mark, the "F1" Logo and the word marks "FORMULA 1/ONE" and "FORMEL 1" has been computer games which are sold both at the circuit as well as in the usual retail outlets. Commonly they feature high quality graphics of the cars competing in the races that are organized under the Opponent's marks. Opponent's Group first granted a licence for computer games as early as 1994, in previous years there may have been as many as four **global** licensees (e.g. VIDEO SYSTEMS, PSYGNOSIS (SONY), ELECTRONIC ARTS (EA) and HASBRO)."
- b) Analysis: There are no further particulars as to where the computer games are sold, how many sets were sold and in which countries

they were sold. There is nothing to suggest that such efforts have contributed to the mark being well known in Singapore.

(vi) At [8.5.7(a)]: "Since 2006, the Opponents' Group granted a **worldwide licence**, worth several hundred thousand dollars, to Jacques Lemans GmbH, an Austrian company, to use the "F1" Logo on watches offered for sale."

c) Analysis: Again, there are no further particulars as to which countries "worldwide" refers to, neither is there any documentary evidence regarding the use of the Plain F1 Mark on watches offered for sale in these countries. Further, there is nothing to suggest that such efforts have contributed to the mark being well known in Singapore.

69 The Opponents also rely on a public survey concerning the prominence of the term "F1" in connection with car races (1st Heavey, [7.4], Annex A), in Germany (the "**German Survey**"). This survey was conducted between 22 March 2005 to 29 March 2005 on "a representative cross-section of the German population" residing in Germany, specified to be "German-speaking persons from the age of 14 years" who had "revealed their interest in motor-racing". The Opponents claim that the study "clearly documents that the designation "F1" in connection with motor racings events, in particular with "Formula 1" motor-races, enjoys a high degree of distinctiveness and has even acquired a secondary meaning in connection with motor-racing events so that as a result "F1" is to be considered a well known mark (1st Heavey, [7.4.8]). The only attempt made to show the relevance of this survey to the relevant sector of the public in Singapore is just a brief line in 1st Heavey at [7.4.9]:

Although the survey only concerned Germany the results can be seen as exemplary for the other countries, such as Singapore, in which the Championship is likewise televised and promoted.

70 No further evidence has been provided as to the alleged television or promotion of the "F1" and/or "FORMULA 1/ONE" marks in Singapore. In any event, the German Survey is completely irrelevant as evidence that the "F1" and "FORMULA 1/ONE" marks are well known in Singapore as it concerns an entirely different audience that has no connection to the relevant sector of the public in Singapore.

71 Perhaps the only piece of evidence of the use of the "F1" and "FORMULA 1/ONE" in a foreign country that may contribute to them being well known in Singapore are the following references to Singaporeans attending the Opponents' motor races at the Sepang Circuit in Johore (see [55] above). However, it is unclear from the evidence whether these 15,000 fans represent the total number of people that visited Sepang Circuit in 2006 alone or whether they represented an average number of fans each year or the cumulative number of fans over a few years, since Sepang Circuit's opening in 1999. In any event, just **one** reference to the number of fans that visited Sepang Circuit during one or more years, without any other piece of independent or corroborative evidence, is insufficient to show that the "F1" and "FORMULA 1/ONE" marks were well known to the relevant sector of the public in Singapore. As for the second TODAY newspaper article dated 31

March 2006, the statements made by Max Mosley are hearsay evidence as he has not deposed any statutory declaration to confirm the facts stated in the article. Additionally, these facts are merely a statement of Mr Mosley's opinion and are not admissible as evidence that the "F1" and "FORMULA 1/ONE" marks were well known to the relevant sector of the public in Singapore. No submissions were made by the Opponents on this particular point.

72 With regard to Section 2(7)(c), the Explanatory Notes to the Joint Recommendation provide that

The number of registrations of a mark obtained worldwide and the duration of those registrations may be an indicator as to whether such a mark can be considered to be well known...**Registrations are relevant only to the extent that they reflect use or recognition of the mark, for example, if the mark is actually used in the country for which it was registered, or was registered with a bona fide intention of using it.**

(Emphasis added)

73 The Opponents have repeatedly emphasized that they have numerous registrations across the globe (see [14] above). However, as the Applicants have rightly noted in their written submissions, the Opponents' registrations do not automatically equate to use of the mark. As the Opponents have not proved use or recognition of the Opponents' Marks, the registrations tendered by them do not assist to prove that their marks are well known.

74 I now turn to Section 2(7)(d) which considers whether there has been any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory. I find this criterion relevant to the present query as the Opponents and the Applicants appear to have been engaged in conflict over the marks "F1" and "F1H2O" in several countries all over the world (see [10] above). However, the issue of whether the Opponents' marks were well known was only raised in the European Community proceedings. In these proceedings, the Fourth Board of Appeal held that the Opponents' Plain F1 Mark was not a mark with a "reputation" under Section 8(5) of the Community Trade Marks Regulations (CTMR) (similar to our Section 8(4) of the Act) (see 3rd Renaud, Exhibit A, at [45] and [71]). Although the decision is the subject of further appeal, it is interesting to note that the Opponents have failed to establish that their Plain F1 Mark is well known, even to their primary market (1st Heavey at [6.6]).

75 No arguments were made by the Opponents on the basis of Section 2(7)(e) (ie. "any value associated with the trade mark") and I will therefore exclude this from the present analysis.

76 In view of the foregoing, I find that the Opponents' Marks, specifically the "F1" and "FORMULA 1/ONE" marks, were not well known to the relevant sector of the public in Singapore as at 11 January 2007.

Similarity of Marks

77 The similarity analysis under Section 8(2)(b) will therefore continue on the basis of the Opponents' prior registered trade marks, namely,  , **FORMULA 1** and  (see [46] above), hereinafter referred to as the "**Opponents' Earlier Marks**".

78 With regard to the similarity of marks, the Opponents' submissions were premised on the acceptance of the Plain F1 Mark as an "earlier trade mark" under Section 2 of the Act. The Opponents submit that the dominant component of the Application Mark are the letters "F1", as it is positioned at the beginning of the mark and because the rest of the mark, ie. "H2O" is "an obvious descriptive hint to the fact that the races take place on water and that the claimed goods and services are related to these races on water" (Opponents' written submissions, at [24]). The Opponents submit that where an older trade mark as a whole is fully incorporated into the other sign, the signs are similar and when the goods are identical or highly similar, there is a likelihood of confusion: **Medion AG v Thomson Multimedia Sales Germany & Austria GmbH** (Case C-120/04) ("Thomson Life").

79 The Applicants on the other hand submit that there is no reason why the elements "F1" would be the essential and dominant element of the Application Mark, as the letters and numbers "F1H2O" are of equal size and prominence. The Applicants referred to the opposition decision of the Japanese Board of Appeals, where it was held that the same mark should be perceived as "an inseparably-united construction and thus the "F1" element should not be independently grabbed." Further, in the decision of the Opposition Division at OHIM, it was held that the element "H2O" was the distinctive element of the F1H2O mark "since it is not common to use chemical symbols to describe sports activities" and that "F1" is but an ordinary term which refers to "the top class of professional motor racing." The Applicants submit that "F1" is not distinctive and therefore, less visual alteration is necessary to ensure that the later mark is not similar: **Lionel Bently & Brad Sherman, Intellectual Property Law (3rd Edition)** (Oxford University Press: 2009) ("Bently & Sherman"), at 866. The Applicants submit that the proposition in *Thomson Life* is untenable and cited **The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd [2005] 4 SLR(R) 816** ("Polo") where it was held that just because the registered mark was wholly included in the challenged sign, it did not mean that it would necessarily cause confusion between the two.

General principles in analysing similarity of marks

80 The Court of Appeal in **Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA [2013] 1 SLR 531** ("Sarika") at [16] (affirmed by the Court of Appeal recently in **Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal** [2013] SGCA 26 ("Hai Tong") at [39]) held that (citations omitted):

The decided cases have established that the court will consider three aspects of similarity, *viz*, visual, aural and conceptual similarity. However, it is not a pre-

requisite that all three aspects of similarity must be made out before there can be a finding of similarity between the sign and the mark. The relative importance of each aspect of similarity varies with the circumstances, in particular, with the goods and types of marks. Simply put, a trade-off between the three aspects of similarity can be made, and each case ought to be viewed in its own context. Whether there is similarity between the sign and the mark is a question of fact and degree for the court to determine.

81 In assessing similarity between two contesting marks, the court considers them as a whole but does not take into account any external added matter or circumstances because the comparison is mark-for-mark: *Hai Tong* at [40(b)]. This inquiry should be undertaken from the perspective of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, and it is assumed that the average consumer has "imperfect recollection", such that the contesting marks are not compared side by side and examined in detail for the sake of isolating particular points of difference. The court will consider the general impression likely left on the essential or dominant features of the marks (*Hai Tong* at [40(c)-(d)]). I will examine each of the three prior marks against the Application Mark in turn. I will not consider the issue of whether the Plain F1 Mark ("F1") and the Application Mark ("F1H2O") are similar, given my findings at [47]-[76] above.

F1H2O and 

82 Visually, the mark "F1H2O" is simply a combination of letters and numbers that are all equally dominant relative to each other and are likely to be perceived by the average Singaporean consumer as such. The mark  , on the other hand, features a heavily stylized version of "F1" and a much smaller byline that reads "Formula 1". The dominant feature of the mark is the heavily stylized "F1" logo, which accounts for about 90% of the overall mark. There are several narrow, horizontal lines that fade from left to right to give the impression of speed, whilst the letters "F" and "1" are slanted towards the right, further contributing to the impression of speed. The effect of the stylization plays a clever visual trick, allowing the eye to see either "F1" or simply a number "1", from the impression created by the negative space in the stylized logo. This is very different from the plain letter "F1H2O" which is a straightforward, unembellished combination of letters and numbers. I find that the two marks are not at all similar.

83 I move on to examine aural similarity between the two marks. The test for aural similarity for word marks is usually a quantitative assessment of the relative number of syllables which two marks have in common: *Sarika* (citing *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 1 SLR 382) at [28]. It would also be correct to consider how an average Singaporean consumer would pronounce the respective words: *Sarika* at [30]. The average Singaporean consumer is likely to pronounce the Application Mark as "F-ONE-H-TWO-OH" (5 syllables) whilst the  is likely to be referred to aurally as the "F-ONE" (2 syllables) or "FOR-MIU-LA-ONE" (4 syllables) marks. The Application Mark, although having the same first two syllables when compared to the

earlier pronunciation, contains three additional syllables "H-TWO-OH". In relation to the latter pronunciation, the syllables are all pronounced differently, except for the syllable "ONE", which is placed in a different position in the syntax of each mark. Given the difference in the number of syllables, the enunciation of the syllables and their relative positions in each of the marks, I find that the two marks are aurally dissimilar.

84 Conceptually, the Applicants coined the mark "F1H2O" to refer to their power boating races, which are also referred to as the "F1 Powerboat World Championship", and the fact that power boating is a water sport (H2O being a reference to water) (see 1st Renaud at [9]). The Opponents on the other hand submit that the terms "F1" and "Formula 1" were used by FIA to refer to their motor races. However, in relation to

 in particular, there is no evidence on what the Opponents' or their contractors' concept was, although one may surmise from the stylization of the logo that it is likely to allude to the notion of speed. It is important to remember that we are not considering the plain letter mark "F1" or "Formula 1" here, but the mark  as a whole. Bearing in mind that in deciding whether there is conceptual similarity, the inquiry is directed at the ideas that lie behind or inform the marks in question (**Hai Tong** at [70]), I find that the two marks are not conceptually similar. "F1H2O" is centered around the theme of a sport that is held on water whilst  is centered around the idea of speed.

F1H2O and FORMULA 1

85 Visually, the mark "F1H2O" is comprised of a combination of letters and numbers in a format that gives the viewer the impression that it is a type of chemical formulae. No attempt has been made to differentiate any of the letters or numbers or combination thereof and thus they appear equally dominant relative to each other. The mark "FORMULA 1" on the other hand comprises of a whole, unabbreviated English word "FORMULA" and a number "1". The two marks are similar to the extent that the average Singaporean consumer who reads the marks visually would be prompted to think of some kind of formula. However, the visual appearance of F1H2O is that of an abbreviation whilst FORMULA 1 is that of a full word. I find that the marks on the whole share only some slight visual similarity.

86 Aurally, F1H2O is likely to be broken down into its individual letters and numbers and pronounced as "F-ONE-H-TWO-OH" (5 syllables) whilst FORMULA 1 is likely to be pronounced as "FOR-MIU-LA-ONE" (4 syllables). Each syllable of the two marks is different when pronounced aurally, save for the number "ONE". However, the syllable "ONE" appears at a different point in the syntax of each mark, and does not contribute to any aural similarity. Accordingly I find that the marks are aurally dissimilar.

87 Conceptually, F1H2O refers to a power boating as a water sport (see [78] above). The concept behind "FORMULA 1" has not been specifically described by the Opponents, although it would appear from their evidence in 1st Heavey (at [6.1]) to refer to a technical specification designating "the pinnacle of single seater racing design"(see

[30] above). F1H2O is centered around the concept of a sport held on water whilst FORMULA 1 is centered around the concept of the top class of motor racing. The former focuses on the idea of location (ie. on water) whilst the latter focuses on the idea of status (ie. pinnacle, top in its class), and are therefore conceptually different.



F1H2O and



88 Visually, the two marks are markedly different. F1H2O comprises of a combination

of plain letters and numbers whilst is a device with some words embedded within it. About 40% of the device is occupied by the image of a sports car carved out from the negative space between the capital letters "FIA". There are no elements of both marks that are similar.

89 There were no submissions on the point of aural similarity and I find that for these



two marks, aural similarity is the least important element. Given that is a device that has very strong visual impact, it is less likely to reach out to the average Singaporean consumer aurally as it is visually. When referred to aurally, the device may be referred to as the "FIA" or the "Formula 1 World Championship" (being the letter or the word elements in the device mark). It may be pronounced as "F-EYE-A" (3 syllables) or "FOR-MIU-LA-ONE-WORLD-CHAM-PION-SHIP" (8 syllables) respectively. F1H2O would simply be pronounced as "F-ONE-H-TWO-OH" (5 syllables). As the number of syllables and the pronunciation of each of the syllables are different, the two marks are not aurally similar.



90 Conceptually, F1H2O refers to a powerboat race on water whilst appears to refer to a motor car race on an international scale, from the graphic of the car contained within the device and the reference to a "world championship". Save for the idea that they both involve types of competitions, the concepts behind each of these marks is different in that they are concerned with two different types of races – one on water (made obvious by the reference to H2O), the other on land (as a motor car would be).

91 Based on the forgoing I find that the Opponents' Earlier Marks are not similar to the Application Mark. In view of this conclusion, I do not need to examine whether the Opponents' goods and/or services are similar to those of the Applicants' goods and/or services or whether there will be a likelihood of confusion between the Opponents' Earlier Marks and the Application Mark. The ground of opposition under Section 8(2)(b) of the Act fails.

Ground of Opposition under Section 8(4)(b)

92 Section 8(4) of the Act reads:

- 8.** — (4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —
- (a) the earlier trade mark is well known in Singapore; and
 - (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or
 - (ii) if the earlier trade mark is well known to the public at large in Singapore —
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

Decision on Section 8(4)(b)

93 Under Section 8(4)(b) of the Act I have to consider whether the whole or an essential part of the Application Mark is identical with or similar to the Opponents' Marks or any "earlier trade mark" under Section 2 of the Act. I have earlier found at [47] to [76] above that the Opponents' Marks and the Plain F1 Mark are **not** "well known" for the purposes of considering whether, in particular, the latter qualifies as an "earlier trade mark" under Section 2 of the Act. The same analysis used to determine whether the Opponents' Marks and the Plain F1 Mark were well known under Section 2 of the Act equally applies to determining whether these marks are well known under Section 8(4) of the Act. I therefore find that the Opponents' Marks are not well known in Singapore under Section 8(4)(a) of the Act, and therefore, the Opponents do not meet the criteria for protection under Section 8(4).

94 The ground of opposition under Section 8(4)(b) of the Act therefore fails.

Ground of Opposition under Section 8(7)(a)

95 Section 8(7)(a) of the Act reads:

- 8.**— (7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —
- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

Goodwill

96 The tort of passing off is concerned with the protection of goodwill. The Court of Appeal in *The Singapore Professional Golfers' Association v Chen Eng Wye [2013] SGCA 18 ("Professional Golfers")* at [20] affirmed the three-stage test for passing off in *Reckitt & Colman Products Ltd v Borden Inc and Others [1990] WLR 491*: that the claimant must prove (1) he has goodwill attached to his product or service (2) a misrepresentation by the defendant that his goods are the claimant's goods or emanate from a source that is economically linked to the claimant and (3) damage to his goodwill as a result of this misrepresentation.

Opponents' Submissions

97 The Opponents submit that the "F1" and "Formula 1" marks were created by the FIA as the world governing body of motor racing under which the championship was held. "F1" and "FORMULA 1" marks have been used by the FIA in respect of their motor racing championship, namely, the "FIA FORMULA ONE WORLD CHAMPIONSHIP", since 1950 as identifiers of this particular series of races and have been in constant use not only to designate the activity of organising these races but for other commercial activities, such as merchandising and licensing. The Opponents submit that they have, over the last 14 years, appointed a company to be their "Promoter", and this Promoter is held to strict standards on the use of the Opponents' marks. The Opponents' marks have been used on many goods and services, including ticketing services, transport for VIPs, branded merchandise articles such as race programmes, computer games, season review videos/DVDs, mobile phones, clothing and souvenirs. The Opponents submit that their motor races have received extraordinary media attention and press coverage since the first night race that was held in 2008 in Singapore.

98 The Opponents further submitted that there could not be any other reason that the Applicants chose to use the prefix "F1" in the Application Mark, other than the success of their motor racing championships and the reputation attached to the "F1" and the "F1 Marks" (the latter is not defined in the Opponents' written submissions). The Opponents' "F1 Marks" have been valid and subsisting in Singapore for many years prior to the Applicants' filing of their Application Mark.

Applicants' Submissions

99 The Applicants submit, firstly, that the relevant date on which the goodwill of the plaintiff in a passing-off action should be considered is the date on which the conduct complained of commences: *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier [2009] SGCA 53 ("City Chain")* at [63] and *CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 1 SLR(R) 975 [1998] SGCA 23 ("CDL Hotels")* at [34], which would be 28 March 2007, the registration date of the Application Mark in Singapore. The Applicants submit that the Opponents have failed to put forward any evidence (save for a few articles in the TODAY newspaper dated prior to 28 March 2007) to support a finding that goodwill has been established in respect of the Opponents' Marks in Singapore.

Decision on goodwill

100 As a preliminary matter, I find that the relevant date on which the Opponents' goodwill should be considered is the date on which the conduct complained of commences, following the case of *City Chain* at [63]. However, I find that this date should take into account the priority given to the Application Mark. The concept behind the claim to priority by a Convention country (as defined in Section 2 of the Act), is to allow the applicant in a Convention country to "claim a right of priority for the registration of the trade mark" (see, generally, Section 10(1) of the Act). As explained succinctly on the website of the World Intellectual Property Organization (WIPO) at <http://www.wipo.int/madrid/en/> (last accessed on 30 October 2013):

Thanks to the international procedural mechanism, the Madrid system offers a trademark owner the possibility to have his trademark protected in several countries by simply filing one application directly with his own national or regional trademark office...An international mark so registered is equivalent to an application or a registration of the same mark effected directly in each of the countries designated by the applicant. **If the trademark office of a designated country does not refuse protection within a specified period, the protection of the mark is the same as if it had been registered by that Office.** (Emphasis added)

101 Since the Application Mark has claimed priority from an earlier registration on 11 January 2007, under the Madrid system, the Application Mark should be treated as having been registered and protected in Singapore as of that date. The date on which the conduct complained of would therefore have commenced on 11 January 2007 and this is the relevant date on which the Opponents' goodwill should be considered.

102 The Court of Appeal in *Professional Golfers* at [21] described goodwill as follows:

Goodwill has been described as "the attractive force which brings in custom": *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217 at 224. It connotes the magnetic quality of the product and its association with the claimant such that customers return and patronise the same business, or purchase the same product or other products from the same brand: *Bently & Sherman* at p 729. The goodwill in question is the integral feature of the relationship between a trader and his customers that the tort of passing off seeks to protect. The action for passing off is not directly concerned with the protection of a mark, logo or get-up of a business. That is more the province of the law of trade marks. Rather, passing off is concerned with protecting the goodwill between a trader and his customers: *CDL Hotels* at [45].

103 A key element in determining whether the claimant has actionable goodwill is whether the goodwill that he has is attached to a business in the jurisdiction. The Court of Appeal in *CDL Hotels* held at [46] that "goodwill does not exist on its own and it attaches to a business", affirming the position taken in an old Privy Council case, *Star Industrial Co Ltd v Yap Kwee Kor [1975-1977] SLR 20* ("Star Industrial"). In *Star Industrial*, the Privy Council found that the plaintiff, a Hong Kong-incorporated

company that no longer had business in Singapore, could not claim to have any goodwill in the get-up of the relevant goods.

104 As regards evidence, the Court of Appeal in *Professional Golfers* held at [22] that typically, goodwill is often proved by evidence, including that of the trader's sales, or the expenses incurred in promoting his goods and services in association with the mark or brand that they bear.

105 In the present case, the Opponents have submitted that it is the FIA that used the Opponents' "F1" and "FORMULA 1" marks (see [11] of the Opponents' written submissions and 1st Heavey at [6.1]) **since 1950**. The Opponents, however, are "Formula One Licensing B.V.", which is part of a group of companies to whom FIA granted the right to organise and commercially exploit "the FIA FORMULA ONE WORLD CHAMPIONSHIP" (1st Heavey at [6.3]), **in 1997**. Any goodwill that was generated from 1950 to 1997 would therefore be attached to the FIA and not the Opponents or the Opponents' group of companies. There is no evidence as to the agreement between the FIA and the Opponents or the Opponents' group, or any evidence as to the Opponents' goodwill during this period.

106 Between 1997 to 11 January 2007, the evidence adduced by the Opponents that is relevant to the proceedings has been described at [32(i)-(iii)] above. Essentially, the Opponents have adduced just **three** newspaper articles that refer to the **possibility** of the Opponents having a motor racing event in Singapore in 2008. There is **no evidence** of the Opponents' sales or the expenses incurred in promoting the Opponents' goods and/or services in Singapore during this period, or at any time. In any event, *even if* there was goodwill (which there is not), the evidence is insufficient to show that the Opponents had any business presence in Singapore at all as at 11 January 2007.

Decision on Section 8(7)(a)

107 As the Opponents have not established that they had the requisite goodwill in Singapore at the relevant time, the first element of the tort of passing off has not been established. I will therefore not go on to consider the other elements of misrepresentation and damage. The ground of opposition under Section 8(7)(a) of the Act fails.

Ground of Opposition under Section 7(6)

108 Section 7(6) of the Act reads:

7.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Opponents' Submissions

109 The Opponents submit that it is settled law that the onus is on the Applicants to show that the application was not made in bad faith, citing *Valentino Globe BV v Pacific*

Rim Industries Inc [2010] 2 SLR 1203 ("*Valentino*"). The Opponents submit that the Applicants had attempted to "hijack" their "F1" mark by taking advantage of the prominence of "F1" not only in the creation of the mark but as to their entire "business model" (Opponents' written submissions at [42]), relying on the case of **Nautical Concept Pte Ltd v Jeffery Mark Richard** [2007] 1 SLR(R) 1071. In addition, the Opponents pointed to a prior application by the Applicants on 28 March 2007 for the

mark  (T0715122Z), which was refused protection by the Registry of Trade

Marks during examination due to the existence of the Opponents' trade mark  (specifically, T9710957J, T9710960J, T9710962G, T9710963E) and eventually withdrawn. The Opponents submit that this showed a pattern of bad faith on the Applicants' part.

Applicants' Submissions

110 The Applicants submit that the allegation of bad faith should not be made unless it can be "fully and properly pleaded and should not be upheld unless it is distinctively proved and this will rarely be possible by a process of inference," citing **MacDonald's Corporation v Future Enterprises Pte Ltd** [2005] 1 SLR(R) 177 (which cited *Royal Enfield Trade Marks* [2002] RPC 24). The Application Mark was coined by the Applicants independently, by combining F1 (from the term F1 Powerboat World Championship) and H2O (a reference to water). The F1 Powerboat World Championship has been in existence since 1981 and is a competition that has captivated Singapore for a good 23 years, since its inception in 1990. The Applicants themselves have sought to build up a sizeable reputation around the term F1 in relation to powerboat racing. Further, a claim on the basis of the alleged reputation and goodwill of the Opponents cannot be sustained, citing UK Trade Marks Registry decision **Jo's the Boss (SRIS O/170/99)** where it was held that "an allegation that the applicants were aware of the use and worldwide reputation of the opponents' trade marks, is not sufficient to sustain an objection to registration under this head. Even where the applicants have done no more than deny the allegation, there remains an onus on the opponent to demonstrate that the applicants have deliberately sought to register a trade mark to which they were not entitled."

Decision on Section 7(6)

111 Contrary to the Opponents' submission, the burden of proving bad faith falls squarely on the Opponents and not the Applicants in this case. This is clear from the following dicta in *Valentino* at [21]:

As was noted by this court in **Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd** [2009] 2 SLR(R) 814 ("*Wing Joo Loong*") at [33]:

It is trite law that the legal burden of proof needed to substantiate an action for revocation and/or invalidation of the registration of the trade mark lies throughout on the plaintiff.

...In our view, whether a case is of opposition to registration under s 7(6) or a case of invalidation under s 23 on the ground of bad faith, it seems to us that there should not be any difference as regards the burden of proof on bad faith in both scenarios. **It is in line with common sense and logic that he who asserts must prove although, depending on the evidence tendered, the evidential burden could shift to the other side. The legal burden of proof required to substantiate a ground to oppose the registration of a trade mark remains throughout on the party making the application**, and this would be the Appellant in the present case. (Emphasis added)

112 This legal burden of proof is not an easy burden to discharge, as described by the Court of Appeal in *Valentino* at [30]:

Furthermore, it is pertinent to note that an allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence (see *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 at [15] which we reproduce below):

An allegation that a trade mark has been applied for in bad faith is a serious one. In *Royal Enfield Trade Marks* [2002] RPC 508, it was held (at [31]) that:

A plea of fraud should not be lightly made ... and if made should **be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts** (see *Davy v. Garrett* [1878] 7 Ch. D. 473 at 489. In my judgment precisely the same considerations apply to an allegation of bad faith made under section 3(6) [of the UK Trade Marks Act 1994]. **It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be a process of inference.**

113 The Opponents appear to have conflated the two issues of whether there is dilution and unfair advantage taken of their earlier marks (under Section 8(4)(b)(ii) of the Act) and whether there is bad faith on part of the Applicants under Section 7(6) of the Act. Although there may be some overlap, the two are distinct issues that should be addressed separately. The ground of bad faith under Section 7(6) of the Act is targeted at morally repugnant behaviour of an applicant, such as the misappropriation of a mark with a strong reputation outside of Singapore, whilst the ground under Section 8(4)(b)(ii) of the Act does not address the **behaviour** of an applicant *per se*, but the possible **effects** of the application on an opponent's mark that is well known to the public at large.

114 As Section 7(6) is an absolute ground of refusal, I am not limited to examining only the Opponents' "earlier trade marks" (as I am under Sections 8(2) and 8(4) of the Act), although, logically, the time at which the Opponents had applied for their trade marks is itself a fact to consider in the overall enquiry.

115 The Opponents have based their submissions on the fact that they are the proprietors of the Plain F1 Mark and that this mark enjoys an "established reputation" and "success and goodwill" (see the Opponents' written submissions at [44]). However, the

Opponents have failed to show that the Plain F1 Mark was well known or that it enjoyed any goodwill in Singapore prior to 11 January 2007 (see [47] to [76] and [100]-[106] above). Even if the Opponents prove that they are the proprietors of the Plain F1 Mark and that this mark enjoys a strong reputation in Singapore and in other jurisdictions, I do not find any evidence to suggest that the Applicants have behaved in such a way that constitutes bad faith.

116 The Applicants have filed substantial evidence in relation to their use of the terms "FORMULA 1/ONE" and "F1" in the context of powerboating, from 1990 to 1992 and subsequently, in 2004 (3rd Renaud, Exhibits D and E respectively). In particular, the Applicants have filed a 150-page media report on their UIM F1 Powerboat Championship event held on 19-20 September 2004 in Marina Bay, Singapore, exhibiting a set of receipts from Mediatech Services Pte Ltd and Mediacorp TV, showing that the Applicants have spent \$192,160 on advertisement and promotion in cinemas and outdoor LED boards as well as \$56,700 on paid spots in local television channels such as Channel 5 and Channel 8, for this event alone.

117 The Applicants have stated in 1st Renaud that the Applicants coined the Application Mark "F1H2O" as it references the F1 Powerboat World Championship and the fact that powerboating is a water sport (H2O being a reference to water). The Opponents do not dispute that H2O is a reference to water. In view of the evidence above, I accept that the Applicants are likely to have derived the mark "F1H2O" on their own, with references to the class of powerboat racing (F1) and water (H2O). The extensive use of the term "F1" in relation to powerboat racing by the Applicants between 1990 and 2004 and the fact that it is a term that relates to a particular class of powerboat racing and not **exclusively** with the Opponents' motor racing events, suggests that the Applicants have not made the present application in bad faith. I note that the Opponents, although claiming to have used the Plain F1 Mark prior to 1990, have not shown any evidence of such use, or how their Plain F1 Mark could have informed the creation of the Application Mark.

118 The Opponents argued that the Applicants made the application in 2007, at a time when they knew that the Opponents were planning to have a night race in Singapore in 2008. This is a bare assertion that is unsupported by the evidence. In any event, this argument is unmeritorious, given that as at 11 January 2007 the Applicants had, at the very least, the *right to register* the Application Mark, and could therefore proceed to do so as they were entitled to. There is no evidence suggesting that the Applicants had knowledge of an **exclusive** proprietary right of the Opponents over the sign "F1" or "FORMULA 1/ONE". I am guided by the words of the Court of Appeal in *Weir Warman Ltd v Research & Development Pty Ltd [2007] SGHC 59 ("Weir Warman")* at [49]:

It appears to me to be an incontrovertible proposition that **if a registrant of a trade mark has proprietorship of that trade mark, or at the very least, the right to register that trade mark, then such registration of the trade mark should fall well within the standards of acceptable commercial behaviour observed by reasonable and experienced persons in the particular trade.** Conversely, where it can be shown that the applicant knew of an *exclusive* proprietary right of another in relation to the trade mark it seeks to furtively register, then any such registration would, almost invariably,

quite clearly fall short of the relevant standards. (Emphasis in italics in judgment; emphasis in bold mine)

119 Finally, I find that the Opponents' contention that the Applicants' withdrawal of T0715122Z (see [109] above) amounted to a "pattern of bad faith" is simply insufficient, without further evidence, to meet the required standard for showing that there has been bad faith. There could be perfectly legitimate business reasons for an applicant to withdraw one mark and proceed with another, which have not been considered or ruled out by the Opponents in this case.

120 In view of the foregoing, the Opponents have failed to meet the required standard of proof required in a case involving an allegation of bad faith. The ground of opposition under Section 7(6) therefore fails.

Observations

121 Despite the Opponents having registered their Plain F1 Mark on 10 May 2007 and having night races in 2008, 2009, 2010 and 2011 respectively, the Opponents did not furnish evidence of any confusion arising from the Applicants' use of "F1H2O" during their most recent powerboating event in November 2011 in Singapore, dubbed the "F1H2O Nations Cup" – also called the "F1H2O World Championship" or the "F1H2O Powerboat Nations Cup." I am therefore of the view that the any adverse effect on the Opponents' business that may be caused by the registration of the Application Mark is likely to be overstated.

Conclusion

122 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, trade mark application number T0715123H shall proceed to registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 19th day of November 2013.

Diyannah Binte Baharudin
Assistant Registrar of Trade Marks
Hearings and Mediation Group
Intellectual Property Office of Singapore