

**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
20 January 2015

**IN THE MATTER OF A TRADE MARK APPLICATION BY
IDEA MARKETING SA**

AND

**OPPOSITION THERETO BY
FORMULA ONE LICENSING B.V.**

(RE-HEARD ON 20 JANUARY 2015)

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

Mr Gabriel Ong (Drew & Napier LLC) for Idea Marketing SA

Mr Raymund Anthony (Gateway Law Corporation) for Formula One Licensing B.V.

Cur Adv Vult

GROUND OF DECISION

(PURSUANT TO RE-HEARING ON 20 JANUARY 2015)

Executive Summary

1 The present decision requires me to decide on whether "F1" (referred to as the "**Plain F1 Mark**") is distinctive, and if so, whether it is well-known to the relevant sector of the public in Singapore – not as at the present date, but as at 11 January 2007, which was *before* the commencement of the F1 night races in Singapore. The first night race in Singapore was

held only in 2008. This matter was heard by me previously in *In the Matter of a Trade Mark Application by Idea Marketing SA and Opposition thereto by Formula One Licensing BV [2013] SGIPOS 8* ("**[2013] SGIPOS 8**") and based on the evidence tendered by Formula One Licensing B.V. (the "**Opponents**") then, I had decided that the Plain F1 Mark was not distinctive and therefore not well-known to the relevant sector of the public in Singapore as at 11 January 2007. I noted that Idea Marketing SA (the "**Applicants**") had been using "F1", "FORMULA 1/ONE" interchangeably to describe their powerboating championship event in Singapore prior to 11 January 2007, in 1990, 1993, 2003, 2004 and 2005 respectively (see [9] of [2013] SGIPOS 8), and that "F1" was descriptive of a particular class or standard of sport in both motor racing and powerboat racing, as opposed to "F2" and "F4" (see [60]-[61] of [2013] SGIPOS 8).

2 The Opponents appealed against my decision, and, in the course of the appeal, sought to introduce new evidence which was not before me when I first heard the case on 30 September 2013. The High Court allowed some of this new evidence and directed that it be placed before me, without further cross-examination. The parties agreed that this would essentially mean that I would have to re-hear the case and consider if the new evidence would change my earlier decision. Having re-heard the case as directed (and agreed between the parties), I maintain my decision that the Opponents have failed to show, as at 11 January 2007, that "F1" is distinctive and therefore cannot be a "well-known" mark that could be considered to be an earlier trade mark for the purposes of Section 8(2)(b) and Section 8(4)(b) of the Trade Marks Act (the "**Act**"). Therefore, the Applicants' trade mark should proceed to registration.

3 For the avoidance of doubt, I stress that the Opponents, whilst not having trade mark rights in the Plain F1 Mark, may have rights in other word or composite marks which refer more specifically to their motor racing event(s). In addition, the Opponents may not have had any trade mark rights to the Plain F1 Mark prior to 11 January 2007, but could have attained other rights after this date. This would of course depend on the evidence tendered by the Opponents at that stage. However, such discussion is not relevant for the present case.

Background

4 The Applicants applied to protect the trade mark **F1H2O** in respect of certain goods in Classes 9, 25, 38 and 41 (the "**Application Mark**"). The Opponents filed an opposition action against this application on 9 October 2009. The opposition was heard by me on 30 September 2013 and my Grounds of Decision were released on 19 November 2013. In [2013] SGIPOS 8, I found that the opposition failed on all grounds and that the Application Mark should proceed to registration. In particular, I had found that the Plain F1 Mark and the "FORMULA 1/ONE" marks were not well-known to the relevant sector of the public in Singapore as at the relevant date of 11 January 2007 (see [41]-[76] in [2013] SGIPOS 8).

5 On 17 December 2013, the Opponents filed an appeal against [2013] SGIPOS 8 *via* originating summons in TA 22/2013 (the "**Appeal**"). A copy of the originating summons was served on IPOS on the same day.

6 Nothing was heard from either party (or any other person) as regards the pending Appeal until the Applicants' letter of 14 October 2014, which reads as follows:

"In the Matter of a Trade Mark Application by Idea Marketing SA and Opposition thereto by Formula One Licensing BV [2013] SGIPOS 8

FORMULA ONE LICENSING BV v IDEA MARKETING SA
TA 22/2013
SUM 2188/2014

1. We refer to the abovecaptioned matters. We act for Idea Marketing SA. Gateway Law Corporation acts for Formula One Licensing BV.
2. Enclosed, by way of service, is a copy of the Order of Court ORC 6760/2014 dated 22 September 2014.
3. By way of background, in the High Court, Formula One Licensing BV applied (vide SUM 2188/2014) to adduce further evidence on appeal. After hearing the application, the Honourable Justice Tay Yong Kwang allowed certain documents in the Affidavit of Sean Joseph Corbett to be admitted, while disallowing others (please see ORC 6760/2014). His Honour has allowed the whole of Idea Marketing's joint (reply) Affidavit of Nicolo' Costa and Jean Menthonnex to be admitted.
4. The practical effect of the said Order is that the same Hearing Officer should rehear the matter, with the additional evidence that has been admitted. There is to be written submissions without any cross-examination.
5. We now enclose a copy of the joint (reply) Affidavit of Nicolo' Costa and Jean Menthonnex. The original has been filed in the High Court. We trust that Gateway Law Corporation will be filing a copy of the Affidavit of Sean Joseph Corbett with the Registry at the earliest opportunity.
6. We look forward to receiving an urgent hearing date for this matter, together with any further directions from the Registrar.

Yours faithfully
[Signature]"

7 The said Order of Court ORC 6760/2014 (the "**Order**") attached to the Applicants' letter reads as follows:

"Upon the application of Formula One Licensing B.V. (Netherlands Registration No. 241G8235) the Plaintiff in this action coming on for hearing this day and upon hearing counsel for the Plaintiff and counsel for the Defendant,

It is ordered that:

1. Further evidence by way of the newspaper articles and ESPN Agreement dated 16 September 2005 exhibited in the Affidavit of Sean Joseph Corbett filed on 30 April 2014 is allowed.
2. The further evidence will be placed before the Registrar of Trade Marks by way of written submissions with no cross-examination.
3. The foreign decisions exhibited in the Affidavit of Sean Joseph Corbett may be placed before the Registrar of Trade Marks by way of written submissions and not as further evidence (as agreed by the Defendant).

4. The remaining portions of Ian De Cotta's book which the Plaintiff is seeking to admit is disallowed.

5. The Plaintiff's affidavit of Sean Joseph Corbett and the Defendant's joint Affidavit of Nicolo' Costa and Jean Menthonnex are to be admitted and placed before the Registrar of Trade Marks.

6. Costs of this hearing are fixed at \$5000 with reasonable disbursements to be paid by the Plaintiff to the Defendant.

7. Costs of the further hearings to be reserved for the Registrar of Trade Marks."

8 On 28 October 2014, I wrote to the parties requesting them to attend before me to clarify some matters in relation to the Order ("**Clarification Proceedings**"). This date was re-fixed to 17 November 2014 due to the Opponents' scheduling constraints. After the Clarification Proceedings, I wrote to the parties on 18 November 2014 seeking confirmation of our mutual understanding of the Order and the circumstances surrounding the same. Both parties wrote several letters on 25 November 2014 in response to this letter, and to each other. The main issue in contention between them was the calling of one Mr Ian De Cotta as a witness to the proceedings (which will be discussed later). However, the parties were in agreement as to the following:

- a) The present status of the Appeal was that it remains in the High Court and is not dismissed. The judge said that the matter is to be remitted back to the Registry for a rehearing;
- b) There is nothing else that is relevant for the Registrar to take into consideration (eg. documents / notes of hearing(s) before the High Court in the Appeal and SUM 2188/2014) save for the affidavit of Sean Joseph Corbett dated 30 April 2014 ("**Corbett Affidavit**") and the joint Affidavit of Nicolo' Costa and Jean Menthonnex dated 27 May 2014 ("**Joint Affidavit**");
- c) The effect of the Order is that the same hearing officer (who heard [2013] SGIPOS 8) should rehear the matter, with the additional evidence that has been admitted. No further reasons were given by the High Court judge.
- d) **Parties do not intend to raise any jurisdictional or procedural issues before the rehearing of the matter by the Registrar. Parties also agree that the Registrar has jurisdiction to re-hear the matter** (Emphasis added)

9 As for the scope of the Order, the parties agreed as follows:

- a) Order 1: The further evidence allowed in the Corbett Affidavit is limited to the exhibits SJC-1 to SJC-8, SJC-10, SJC-11 and SJC-16;
- b) Order 2: (*Discussed below at [10]*)
- c) Order 3: The foreign decisions in the Corbett Affidavit are to be treated as legal authorities tendered for the purpose of submission but not as evidence of the facts stated therein;

- d) Order 4: This refers to Exhibit SJC-9 of the Corbett Affidavit;
- e) Order 5:
 - i) The Joint Affidavit is reply evidence to the Corbett Affidavit in SUM 2188/2014. Therefore, it is to be treated as evidence, and not submissions;
 - ii) Parties confirm that the previous orders (ie. Orders 1, 2, 3 and 4) will decide the status of the Corbett Affidavit. For example, the parts that are not admissible will not be considered. The Plaintiff confirms that there is nothing other than what is mentioned in these previous orders in the Corbett Affidavit; and
 - iii) Parties confirm that both affidavits are to be treated as Statutory Declarations in IPOS proceedings for the purpose of the re-hearing. This includes the text portions of both affidavits.

Scope of Order 2 and calling Ian De Cotta as a witness

10 There was initially some disagreement between the parties as to whether Mr Ian De Cotta could be called as a witness to the proceedings. The Opponents had initially said in their letter of 25 November 2014 that despite Order 4 (stating that the remaining portions of Ian De Cotta's book which they were seeking to admit are disallowed), they were "prepared to call the author as a witness to these proceedings, should the Registry wish to otherwise raise technical objections to the evidence, such as hearsay." The Applicants replied, on the same day, that this was an attempt by the Opponents to "have a further bite at the cherry, when nothing in [the Order] gives the [Opponents] this right." The Applicants pointed out in their letter that the Opponents did not call Ian De Cotta in the earlier proceedings in [2013] SGIPOS 8 and should therefore stand by their decision. Furthermore, nothing in the Order gave the Opponents the right to call the author to testify on existing evidence. The Order also stated that there would be "no cross-examination" and that it should follow that the Opponents would not be able to call any witnesses. They also submitted that this point was never before the High Court. The Opponents replied on 3 December 2014 as follows (relevant parts extracted):

...In our 25 November 2014 letter to the Registry, we mentioned that we were prepared to call Ian De Cotta to give evidence in these proceedings, should the Registry wish to otherwise raise technical objections to the evidence, such as hearsay. However, we did not specifically state that we would be calling Ian De Cotta as a witness, unless the Registry so requires his presence at these proceedings.

We have, however, considered the matter and would inform the Registry that we would not be calling Ian De Cotta, unless the Registry requires his testimony.

11 The Applicants replied on 5 December 2014 noting that the Opponents "would not be calling Ian De Cotta" as a witness, and that their clients do not have any further objections at that stage. On 18 December 2014, the Registrar wrote to both parties noting the Applicants' position. No further objections were tendered in writing by parties up till the date of the re-hearing on 20 January 2015.

12 At the hearing, the Opponents submitted that the parts of the Ian De Cotta book that were admitted before me previously in [2013] SGIPOS 8 should be reconsidered. The Applicants submitted that this has already been addressed in the correspondence (referred to above) and that the remaining portions (ie. in SJC-9 of the Corbett Affidavit) were not

relevant, as ordered by the High Court judge. However, the Opponents also confirmed at the hearing before me that the contents of SJC-9 in the Corbett Affidavit were the remaining parts of the Ian De Cotta book. If so, the entire Corbett Affidavit does not contain the parts of the Ian De Cotta book that were before me previously. Order 4 of the Order of Court states that "[t]he remaining portions of Ian De Cotta's book which the Plaintiff is seeking to admit is disallowed." In addition, parties had agreed that Order 4 referred specifically to SJC-9 of the Corbett Affidavit and that there was nothing else that is relevant for me to take into consideration save for the Corbett Affidavit and the Joint Affidavit (see [8(b)], [9(d)] above). As such, I do not see any reason to reconsider the parts of the Ian De Cotta book that were before me previously, if they were not even part of the Corbett Affidavit to begin with.

Scope of the present hearing

13 In written submissions, the Applicants submitted that this hearing was not an appeal against my decision in [2013] SGIPOS 8, and that the ultimate question was whether I would, having regard to the further evidence allowed by the High Court judge, change any of the findings or holdings in my decision. The Opponents did not challenge this submission. Accordingly, I will take this to be the scope of the present hearing.

Further evidence to be considered

14 To recap, the further evidence that I will consider (in light of the Order and the discussion above) is as follows:

- a) Corbett Affidavit: Body of affidavit, including exhibits SJC-1 to SJC-8, SJC-10, SJC-11 and SJC-16
- b) Joint Affidavit: Entirety of affidavit (Body of affidavit and all exhibits thereto)

15 In addition to the Corbett Affidavit, the Opponents also tendered another volume titled "Opponent's Bundle of Documents" before me. At the hearing, the Opponents clarified that the documents here were essentially the same as that in the Corbett Affidavit. The Applicants said that they were unable to locate Tab 20 of the Opponent's Bundle of Documents in the Corbett Affidavit. The Opponents agreed that it was not in the Corbett Affidavit. Accordingly, I will disregard this reference. For convenience, I will use the references in the Corbett Affidavit, rather than the Opponent's Bundle of Documents.

Threshold Issue: Whether the Plain F1 Mark was "well-known"

16 At the hearing on 20 January 2015, the parties agreed that the threshold issue for me to consider was whether the Plain F1 Mark was "well known" prior to the relevant date of 11 January 2007 (the date on which the Application Mark was registered), such that it qualified as an "earlier trade mark" for the purpose of Section 2 of the Trade Marks Act (the "Act") in light of this further evidence. For reasons explained at [25]-[27] below, the first question is whether the Plain F1 Mark qualifies as a "trade mark" in that it is capable of distinguishing goods or services as set out in Section 2(1) of the Act.

17 The definition of a "trade mark" and an "earlier trade mark" is found in Section 2(1) of the Act:

“**trade mark**” means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

“**earlier trade mark**” means —

(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;

“**well known trade mark**” means —

(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;

18 The factors to take into account in deciding whether a trade mark is "well known in Singapore" are listed in Sections 2(7) to 2(9) of the Act:

(7) 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.

(8) Where 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.

(9) In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

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

(b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;

(c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

19 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.

20 Section 8(4)(b) 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 —

...(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.

(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.

21 The Act does not differentiate between the criteria for an "earlier trade mark" for Section 8(2)(b) and Section 8(4)(b), and therefore my finding in relation to whether the Plain F1 Mark is an "earlier trade mark" would be relevant to both sections. For the record, the Applicants submitted that the further evidence would not affect my ruling under Section 8(2)(b) (because the evidence did not pertain to similarity of marks) and stated that they would not present further submissions in relation to this ground. The Opponents did not specify if they were seeking to change my findings in relation to Section 8(2)(b) or Section

8(4)(b), although from their written submissions their focus seemed to be on the latter, given their allegations of tarnishment and free-riding by the Applicants (see [43] and [58] of the Opponents' written submissions respectively).

"Relevant date" and "Relevant Sector of the Public"

22 The "relevant date" of 11 January 2007 is not contested by the parties, and is in fact referred to as such in the Opponents' written submissions. This matter has also been considered and decided upon in [2013] SGIPOS 8 (see [28], [41], [42]). As for the issue of the "relevant sector of the public", this was not contested by the parties as well. In [2013] SGIPOS 8, I held that the "relevant sector of the public" could minimally include the Singaporean fans who visit the Sepang Circuit to watch the Malaysia leg of the Opponents' motor races. A broader view of 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 (see [57] of [2013] SGIPOS 8). The issue of who the "relevant sector of the public" comprised of was not raised by either party at the hearing. Notably, the Opponents did not make any distinction between the various possible relevant sector(s) of the public, as discussed above.

Parties' submissions

23 The Opponents have classified the new evidence into two general categories, namely "(1) relevant local newspaper articles generally pre-dating 11 January 2007, proving that the Opponent has gained goodwill in Singapore" and "(2) relevant contracts between a Singapore broadcasting company and the Opponent prior to 11 January 2007, indicating that the Opponent's "F1" mark is well-known" (see Opponents' written submissions at [11]). At the hearing, the Opponents focused more on the latter category, and also spent some time highlighting various decisions from other jurisdictions. In relation to the point on distinctiveness, the Opponents simply submitted that the Plain F1 Mark was creative and original and enjoys a strong connection with the FIA. In relation to the newspaper articles, the Opponents submitted that some of them show that the Plain F1 Mark applied to various types of merchandise, which the Opponents had licensed, whilst others show that the Plain F1 Mark was used by itself to refer to the FIA Formula One World Championship (the "**Championship**") (see Opponents' written submissions at [12]-[13], [16]). They also submitted that in the years prior to the Championship, the Opponents' business presence in Malaysia through the Sepang races had attracted about 20,000 Singaporeans and caused event organizers to create tour packages around these races. They also rely on various newspaper articles to show that they have "support and allegiance" of Singaporean fans and how the results of motor races affect car sales. They also make reference to their Championship and the Plain F1 Mark having such "popularity" and "prestige" that certain individuals would campaign hard to bring the Championship to Singapore.

24 The Applicants' submissions, on the other hand, focused on the legal requirements of "distinctiveness" of the Plain F1 Mark. They considered whether the Plain F1 Mark had attained acquired distinctiveness or secondary meaning as a result of the new evidence. They also reiterated a point that was made in [2013] SGIPOS 8, that the Applicants had already used the Plain F1 Mark in the context of powerboat racing in Singapore prior to the relevant date. They referred to the evidence in the Joint Affidavit, which showed the Plain F1 Mark

being used in a variety of contexts, such as for air racing, stockcar racing, powerboat racing, water ski racing and ice yatching. They also tendered a video recording of the UIM F1 World Championship powerboat race in Singapore in 2005 and a copy of a yearbook with the same title that was released in conjunction with the race. The Applicants then turned to address the Opponents' new evidence, submitting that the Plain F1 Mark was used in a descriptive manner, referring to a class of motor sport. In particular, the Applicants drew my attention to a number of articles, including an article in Wikipedia explaining the various tiers of racing in Formula Two (abbreviated to F2) and Formula Three (abbreviated to F3), an article in the Straits Times in 2002 that describes how drivers move up various rungs from Formula Three (F3) onwards and another Straits Times article in 2003 about how Mark Webber climbed the motorsports ladder, from karting, Formula Ford, Sportscars, F3 and F3000 and a year of testing for Benetton-Renault. In relation to the Sepang races attended by Singaporeans, the Applicants submit that the newspaper articles are hearsay evidence, or in the alternative, that they were relatively isolated events that cannot contribute towards the Plain F1 Mark being well-known or having any goodwill in Singapore. In addition, they reiterate their submission that the Plain F1 Mark was not used in a trade mark sense.

Importance of distinctiveness to the threshold issue

25 I first consider the distinctiveness of the Plain F1 Mark in light of the further evidence. There are competing considerations as to whether a mark that is not distinctive should be granted well-known mark protection. These were noted in [2013] SGIPOS 8 at [49], citing the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [143]-[144]. To reiterate, the Court of Appeal held that:

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.

26 In the recent case of *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 ("*Staywell*") (decided after the decision in [2013]

SGIPOS 8), the Court of Appeal held at [25] that "technical distinctiveness is an integral factor in the marks-similarity enquiry; a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (references omitted)." The Court of Appeal explained that "[d]istinctiveness in the technical sense stands in contradistinction to descriptiveness" (*Staywell* at [24]). This paragraph appears to refer to the distinctiveness enquiry typically undertaken under Section 7 of the Act, as the decision in *Staywell* makes reference to cases decided under this provision, namely, *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huber and Franz Attenberger* [1999] ETMR 585 (ECJ), *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 – and also to *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 ("*Hai Tong*") at [32]-[33]. These paragraphs in *Hai Tong* discuss distinctiveness under Section 7, and also acquired distinctiveness through use (referring to the High Court decision in *Doctor's Associates Inc v Lim Eng Wah (trading as Subway Niche)* [2012] 3 SLR 193). In another decision (*Taylor's Wines Pty Ltd v Taylor, Fladgate & Yeatman Limited* [2014] SGIPOS 11 at [45]), I raised a question as to whether there are different levels of distinctiveness for trade marks in Singapore which give rise to different consequences, but that is a discussion that is neither necessary nor appropriate in the present context (as it also was in that case).

27 For the present, distinctiveness – whether "inherent" or "acquired"— would therefore have an important role to play in determining whether the Plain F1 Mark can be considered a "trade mark". In order to qualify as a trade mark, the Plain F1 Mark must be "capable of distinguishing goods or services" (see definition of "trade mark" in Section 2 of the Act, at [19] above), ie. the Plain F1 Mark must be capable of distinguishing the Opponents' motor races. The issue of whether the Plain F1 Mark was distinctive was discussed in [2013] SGIPOS 8 at [60]-[63], where I concluded that 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, as compared to F2 and F4. If the Plain F1 Mark can be considered to be a "trade mark", the next question is whether it is a "well-known trade mark" that will qualify as an "earlier trade mark" under Section 2 of the Act (see [17] above).

SJC-1 to SJC-8, SJC-10, SJC-11, SJC-16

28 I turn to the first category of documents in the Opponents' Corbett Affidavit, ie. the newspaper articles. SJC-1 is a collection of newspaper articles from The Business Times, TODAY Newspaper and The Straits Times, dated between December 2001 to March 2005, which show the use of the Plain F1 Mark:

- a) An advertisement titled "*Sonic Boom*", with the opening lines: "*Tag McLaren Audio F1 Avantgarde Speakers (S\$38,999) are a sensible way to kill two birds with one stone, especially if you're both an audiophile and a Formula One fan. Produced by an affiliated company to the McLaren F1 team, these loudspeakers offer both excellence in design and high quality sound*" (p 11);
- b) In an article categorized under "*motor racing*", the first line reads, "*Ferrari's Michael Schumacher is determined to win Sunday's British Formula One Grand Prix after a week of celebration for his Brazilian team-mate Rubens Barichello*" (p 12);
- c) A thumbnail article headlined "*F1 contest*", where readers are encouraged to predict the winner of the motor race, for a chance to win a TAG Heuer watch (p 12);

- d) In an article categorized under "*motor racing*", which reads, *inter alia*, "*Meanwhile, the ailing Arrows Formula One team made its return to the track yesterday at the Belgian Grand Prix*", "*The return of Arrows to F-1 came after director Tom Walkinshaw agreed to sell the outfit to a mystery American buyer on Wednesday*" (coupled with another "*F1 contest*") (p 13);
- e) The copy of the newspaper article on p 14 is not visible; in any event, nothing turns on this evidence alone;
- f) In a small box at the bottom right hand corner sub-titled "*Events and Promotions*" at Funan IT Mall, stating that "*Motorsports Model Collectibles is having its annual Chequered Flag Sale this festive season. Get your F1 model cars, Ferrari apparel, caps and other F-1 merchandise at 10-30 percent off.*" (p 15);
- g) In a small box at the bottom middle portion sub-titled "*F1 collection from Mattel*", an advertisement stating that "*Toy maker Mattel has released its Hot Wheels Grand Prix collection, Formula One replicas from five teams...*" (p 16);
- h) In an advertisement at the bottom left hand corner titled "*Gear up for an ultimate F1 experience*", the reader is told that a purchase of TAG Heuer Kirium F1 or TAG Heuer 2000 multigraph will allow him/her to receive a limited edition TAG Heuer F1 shirt. The strapline above the advertisement reads, "*Official Timekeeper of the FIA Formula One World Championship*" (p 17);
- i) At the bottom right hand corner of an article on gadgets, sub-titled "*Hot Buy!*", "*Attention Formula One Grand Prix fans! HP has unveiled a limited edition Photosmart BMW Williams F1 digital camera...*" (p 18).

29 SJC-2 contains a collection of newspaper television listings showing the timings and channels where the FIA Formula One World Championship (the "**Championship**") was broadcast. This takes the form of a table at the right hand corner of the newspaper page, where there are three columns, the first stating the timing of the programme, the second showing the type of event (eg. "tennis", "golf", "basketball"), and the third showing the details. In the second and third columns, the Championship is shown as "F1", followed by "Italian Grand Prix, Ch 24." There are six time slots for the Championship, three per weekend, on Sept 3-4, 2005 and May 27-28, 2006 respectively.

30 SJC-3 contains a number of newspaper articles as follows:

- a) Article titled "*Appeal for F1 licence*", a thumbnail article at the right hand column of the newspaper which talks about a Japanese driver being refused an F1 licence dated 31 January 1992;
- b) Half-page article titled "*A winner, says Mika Hakkinen*", which talks about Malaysia's Sepang F1 circuit, and how it will drive up F1's global viewership and demand 7 August 1999;
- c) Full-page article titled "*An irresistible Temple of Speed*", which describes the Sepang stadium, with references such as "maiden F1 race", "Sepang F1 circuit" dated 9 September 1999;
- d) Full-page article titled "*All the F1 thrills and spills – on the Web*", informing the reader about various websites where they can follow the F1 race in Sepang or Suzuka dated 23 September 1999;
- e) Full page of two articles, titled "*What do Formula One's owners want?*" and another titled "*Are women man enough for F1?*", as well as a right hand column of smaller articles on happenings in the various F1 races dated 28 August 2002;

- f) Full-page article titled "*Be still, my Inner Chicken*", describing the experience of some Singaporeans spending some time at a Formula One driving school, dated 20 November 2004;
- g) Full-page article titled "*F1 fever*", where a Business Times reporter describes her experience at "*the F1 championship*" in Bahrain (a sponsored trip) dated 11-12 March 2006.

31 SJC-4 and SJC-5 contain a number of articles relating to the races in Sepang, Malaysia, between 2001 to 2003, as follows:

- a) Article titled "*GP tickets at Modesto's*" which states that Formula One fans can buy tickets for the Petronas Malaysian Grand Prix in Sepang on October 20-22 from Modesto's in Orchard Parade Hotel, and that "*20,000 Singaporeans were in Sepang to witness last year's Grand Prix*" dated 3 October 2000;
- b) Article titled "*Wanted: 15,000 S'porean fans to fill Sepang seats*", which describes a push by "*GP organisers*" to make more Singaporeans travel to see the "*Malaysian Grand Prix*", that "*around 10,000 people from the Republic made the trip to Sepang*", and that "*Singaporeans already comprise around 15 per cent of the international audience at the Malaysian Grand Prix*", and "*Thirteen travel agents have been enlisted in Singapore to handle packages and ticket sales for this year's Grand Prix*" dated 9 February 2002;
- c) A thumbnail advertisement in the Business Times, where an entity called "*Wheels For Fun Pte Ltd*" is shown as the "*Official Ticketing Agent*" for those wanting to "*Catch F1 live!*", dated 28 February 2001;
- d) A thumbnail article in the Business Times, which is actually another advertisement for "*Motorcade packages to Sepang*", describing the event as "*Sepang Grand Prix*" and also describing packages including "*two-day F1 passes*", dated 7 March 2001;
- e) A thumbnail article about "*Early bird discounts for F1 tickets*" which describes an event called "*Malaysia Formula One*" and that tickets can be bought locally from an entity called Ticketcharge, dated 18 January 2003.

32 SJC-6, SJC-7, and SJC-8 are three separate articles, which the Opponents claim describe the impact of the Opponents' races in Singapore, in terms of public opinion and car sales:

- a) A thumbnail article in the Straits Times about how a new "*Formula One-themed timepiece from Swiss watchmaker Tag Heuer has been sold for \$2,750 on auction website eBay Singapore*" and the money donated to Action for Aids, dated 5 March 2005;
- b) A nearly full-page article in the "*Voices*" section of Today newspaper titled "*Grab the F1 chance before it zooms away*", where an "F1 fan" wrote in about the economic benefits of bringing the "F1 championship" to Singapore, dated 31 March 2006;
- c) A half-page article dated 18 March 2005 in the Business Times titled "*Renault's F1 wins spur sales*", where the executive director of one Exklusiv Auto Services says he believes that racing success in F1 helps car sales accelerate. The article makes references such as "*F1 team's performance*" and "*Formula One racing is a strategic platform for Toyota*", "*F1 influence*". The executive director is quoted as saying that Formula One is the "*pinnacle of all motor sports.*"

33 SJC-10 is a magazine article dated October 2008, titled "Sunday Night Fever", which features Mr Colin Syn, deputy chairman of the "Singapore GP", talking about his efforts to bring in a "Singapore Grand Prix" some 19 years ago, and the build up towards Singapore's first night race. Much of the article talks about the technical details that had to be carefully planned because of the novelty of a night race in Singapore. Mr Syn reveals that he mooted the idea in 1989 to Bernie Ecclestone, but at that stage the Singapore government was not ready to host a grand prix. Another interviewee, a resident engineer for the "Singapore GP", Shahul Hameed, states that the ground-breaking for the pit building took place on 31 August last year (ie. 2007) and that the "first significant concrete was poured on October 15". The final circuit surface was laid on the pitlane on 6 June 2008.

34 SJC-10 is dated more than a year after the relevant date. The Opponents have not made any submissions as to why I should take this evidence into account as statements of past events. The Opponents submit, in a few lines, that because of this article it can be "undoubtedly [said that] the Championship and the "F1" mark associated with it was well-known among certain Singaporeans and that they would spend many years campaigning to bring the Championship to Singapore" (see [26] of the Opponents' written submissions). Even if I were to accept that this article is admissible, it would show, at best, that just a few individuals (Mr Syn and perhaps Mr Shahul Hameed) knew about the Championship and the F1 mark during that time. I agree with the Applicants' assessment that if this small group of individuals spent many years (prior to the relevant date) trying to bring the Championship to Singapore, it is unlikely that the relevant sector of the public would have any exposure to the Plain F1 Mark, let alone recognize that it is distinctive of the Opponents.

35 SJC-11 contains two articles that the Opponents claim show that politicians in Malaysia and Singapore recognized the popularity of the Plain F1 Mark in Singapore. In the first article, from the Business Times "Malaysia news" section, dated 16 October 1999, the then-Prime Minister of Malaysia Dr Mahathir Muhammad was quoted as saying that "Previously Malaysia was not known to many...but holding the motor race...here the world knows where our country is and there will be greater interest to visit and spend money in Malaysia." In the second article, dated 16-17 April 2005, the then-Minister Mentor Lee Kuan Yew was quoted as saying that not building a Formula 1 circuit in Singapore was a "mistake" that had cost the country money. In this regard, the Opponents appear to be confusing the notion of "popularity" with the technical meaning of what is "well known".

36 SJC-16 is a newspaper article at the last page of the Corbett Affidavit dated 19 August 2007 titled "*A big splash on the Bay?*", with the by-line "*Singapore on the brink of sealing F1 Powerboat deal for the next three years.*" The Opponents submit that the article describes how the Applicants "generated negative publicity when the events management company they hired failed to pay its auditors" (Applicants' Written Submissions at [44]). However, this evidence is beyond the relevant date and in any event only goes to show that the Plain F1 Mark was also used in relation to the Applicants' powerboating event as well.

37 I now turn to what the Opponents refer to as the second category of documents, ie. relevant contracts that they claim the Opponents have entered into. These are found in Exhibit SJC-2 of the Corbett Affidavit. The first is a document dated 16 September 2005 titled "Television Rights Agreement in respect of the 2006-2010 FIA Formula One World Championship Asia", (the "**Television Rights Agreement**") made between Formula One Administration Limited ("**FOAL**") and ESPN Star Sports ("**ESPN**"). There appears to be a number of missing pages in this document. The other document also dated 16 September

2005 is a letter from ESPN to FOAL, on the use of the "FIA FORMULA ONE WORLD CHAMPIONSHIP LOGO and TITLE MECHANISM(S)" (the "**Letter**"). The relevant schedules (Schedule 1 and 2) are composite marks which contain the entire title "FIA Formula 1 World Championship" with a highly stylized device. Essentially, this letter records the terms and conditions under which FOAL was willing to grant a royalty-free, non-exclusive, non-transferable licence to ESPN to use the said logo and title mechanisms.

38 In my opinion, the agreements described above do not assist the Opponents. Firstly, it was not even entered into by the Opponents, but between FOAL and ESPN. The address of the Opponents is listed as being in the Netherlands. However, the agreements have been made by FOAL, *via* their "agent and business manager" Formula One Management Limited, which, according to the agreements, has an address in London. There is no submission as to how FOAL is linked to the Opponents. The only link to the Opponents is provided in the trade mark notice in the Letter itself. Secondly, it is not clear what the terms of the trade mark licence between FOAL and ESPN are because of the missing pages in the Television Rights Agreement. To illustrate, on p 24 of the Corbett Affidavit, Clause 3 titled "Licence Grant" reads:

In consideration of the undertakings given by Licensee [ESPN] in this Agreement, subject to Clause 3.5 and 3.6 and subject to and conditional upon the full and timely performance and observance by the Licensee of all its obligations under this Agreement and subject to the maximum Number of Transmissions, Licensor grants Licensee the Core Television Rights (and where stated, the right to produce the specified Event Programmes) for exercise solely on the specified Channel at the designated Transmission Time by Cable Television and/or Satellite Television on a Subscription basis in the Territory with voice-over commentary in [*cut off*]

39 On p 25 of the Corbett Affidavit, however, there is no continuation as to Clause 3. It simply cuts abruptly to Clause 3.8.2 onwards. From the numbering at the bottom of the Corbett Affidavit, which appears to indicate the page numbers of the original document, a number of pages have been omitted in between Clause 3 and Clause 3.8.2. As a result, the scope of the agreement as to the licence grant is uncertain.

40 Clause 3.8.2 and 3.8.3 on p 25 of the Corbett Affidavit read:

3.8.2 use and reproduce in FORMULA ONE™ Programming the Marks insofar as and in the manner such Marks appear incidentally in the International Feed;

3.8.3 exercise the rights to use the Marks to promote the coverage of the Championship by Licensee as more particularly set out in the Trade Mark License;

41 The term "Marks" is defined further down the document as follows (p 28, Corbett Affidavit):

"Marks" means the names and marks *associated* with the Championship (including FORMULA ONE™, FORMULA 1™, F1™, FIA FORMULA ONE WORLD CHAMPIONSHIP™, all derivatives and non-English translations of the aforementioned names and marks, F1-FIA FORMULA ONE WORLD CHAMPIONSHIP™ and device and FI FORMULA 1 and device™ and Mark means any one of them.

(Emphasis added)

42 It is interesting that this definition only makes reference to "the names and marks *associated* with the Championship" rather than including a trade mark registration number or stating categorically that these are the Opponents' trade marks.

43 The Letter contains a clause titled "Trademark acknowledgement" which reads:

The Licensee [ESPN] acknowledges and accepts that the names and marks *associated* with the FIA FORMULA ONE WORLD CHAMPIONSHIP and the Events (including FORMULA ONE, FORMULA 1, F1, FIA FORMULA ONE WORLD CHAMPIONSHIP, all derivatives and non-English translations of the aforementioned names and marks, the CHAMPIONSHIP LOGO, the EVENT TITLE(S), the TITLE MECHANISM(S) and the F1 FORMULA 1 and device ("the Marks") are, *as between the Licensor [FOAL] and Licensee [ESPN], the exclusive property of the Licensor and its Affiliated Companies*. For the avoidance of doubt, the Licensee shall not acquire any proprietary rights in the Marks by reason of this Letter of Agreement or otherwise.

(Emphasis added)

44 In another sub-section titled "Further Agreed Conditions", there is a clause (Clause 4) which reads:

The Licensee [ESPN] undertakes that the Printed Materials and an agreed location on the Licensee's [ESPN's] Website will display the following trade mark notice:

"FORMULA 1, F1, the F1 Formula 1 and device, the FIA FORMULA ONE WORLD CHAMPIONSHIP and device and the FORMULA 1 Title Mechanisms and designs are the trade marks of [the Opponents] a FORMULA ONE Group Company and are used under license. All rights reserved."

45 The Opponents placed some emphasis on this trade mark notice (extracted at [43] above) at the hearing whilst the Applicants responded that this is "merely a trade mark notice" and that the actual schedules to the agreement do not list the Plain F1 Mark, and that in any event it is insufficient to conclude from these agreements that it was distinctive of the Opponents. No submissions were made as to the legal effect of a trade mark notice.

46 Without the benefit of legal submissions before me, my preliminary observation is that the Television Rights Agreement and the Letter are essentially private contracts between two parties that cannot confer trade mark rights on the Opponents. Trade mark rights are obtained either by registration in the relevant country of choice, or asserted as a common law right by proof of use in a trade mark sense in that country. It cannot be the "exclusive property" of the Opponents just because a clause in the contract (between two other parties) says that it is. It is a species of property right enforceable as against the whole world, as opposed to a personal right as between two parties.

47 However, the first category of evidence tendered by the Opponents, ie. the newspaper articles prior to the relevant date, show that the Singapore public is likely to have associated the Plain F1 Mark with motor racing prior to the relevant date (11 January 2007) for the following reasons:

- a) the Plain F1 Mark was used in relation to the sub-headline "motor racing" or "motoring" on several occasions:

- i) an article categorized under "**motor racing**", which reads, "*Ferrari's Michael Schumacher is determined to win Sunday's British **Formula One** Grand Prix after a week of celebration for his Brazilian team-mate Rubens Barichello*" (see paragraph [28(b)] above);
 - ii) an article categorized under "**motor racing**", which reads, *inter alia*, "*Meanwhile, the ailing Arrows **Formula One** team made its return to the track yesterday at the Belgian Grand Prix*", "*The return of Arrows to **F-1** came after director Tom Walkinshaw agreed to sell the outfit to a mystery American buyer on Wednesday*" (coupled with another "*F1 contest*") (see [28(d)] above)
 - iii) a small box at the bottom right hand corner sub-titled "*Events and Promotions*" at Funan IT Mall, stating that "***Motorsports Model Collectibles** is having its annual Chequered Flag Sale this festive season. Get your **F1** model cars, Ferrari apparel, caps and other **F-1** merchandise at 10-30 percent off.*" (see [28(f)] above)
- b) the Plain F1 Mark was used as a sub-category of sport, in relation to television listings of sports programmes in 2005 and 2006 (see [29]);
- c) general news articles that use the Plain F1 Mark in the context of motor racing events around the world (see generally [30] above), in particular:
- i) Half-page article titled "*A winner, says Mika Hakkinen*", which talks about Malaysia's Sepang F1 circuit, and how it will drive up F1's global viewership and demand 7 August 1999;
 - ii) Full-page article titled "*An irresistible Temple of Speed*", which describes the Sepang stadium, with references such as "maiden F1 race", "Sepang F1 circuit" dated 9 September 1999;
 - iii) Full page of two articles, titled "*What do Formula One's owners want?*" and another titled "*Are women man enough for F1?*" , as well as a right hand column of smaller articles on happenings in the various F1 races dated 28 August 2002;
 - iv) Full-page article titled "*F1 fever*", where a Business Times reporter describes her experience at "*the F1 championship*" in Bahrain (a sponsored trip) dated 11-12 March 2006.
- d) There was also some press pertaining to the motor races in Sepang, Malaysia, between 2001 to 2003, as described above (see [30(b), (c)] and [26] above). These articles had appeared in Singaporean newspapers such as Business Times and The Straits Times and contained references to the Plain F1 Mark within each article. For example:
- i) In the article titled "*GP tickets at Modesto's*", the article refers to the fans of the Petronas Malaysian F1 Grand Prix in Sepang as "F1 fans" (p 54, Corbett Affidavit);
 - ii) In the article titled "*A winner, says Mika Hakkinen*", the article uses the Plain F1 Mark as a shorthand reference to the FIA-organized series of motor races generally, such as "With F1 viewership at two billion globally...", "From conception to execution, the plans to bring F1 to the region have been carried out with speed that is worthy of well, F1" (p 47, Corbett Affidavit).

48 All the evidence tendered above relates to the time period between 1992 to 1999 and 2001-2006. However, *during the same period*, there was evidence of the Applicants' use of

the Plain F1 Mark in relation to their own powerboating championship races in Singapore, which were held in 1993, 2003, 2004 and 2005. Evidence of the same was tendered before me in the opposition proceedings in [2013] SGIPOS 8 and has been discussed at [12], [13], [61]-[62]. In relation to this evidence, I concluded at [60] that 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.

49 The Applicants have tendered further evidence that corroborates their previous evidence of the powerboating championships held in Singapore. In MC-3 in the Joint Affidavit, the Applicants enclosed three compact discs which are essentially video recordings of its UIM F1 World Championship powerboat race in Singapore in 2005. In MC-4, the Applicants also enclose a copy of its UIM F1 World Championship Yearbook 2005 which was released in conjunction with the 2005 F1 Powerboat Championship. In MC-5, several newspaper articles in relation to the Applicants' F1H2O Nations Cup powerboat race in 2011 were tendered.

50 For the purposes of the present proceedings, the newspaper articles in MC-5 are not relevant as they are beyond the relevant date of 11 January 2007. The video recordings in MC-3 on the other hand are useful as a documentary record of the powerboating championships held by the Applicants in 2005. Two of these videos are over two hours in length, whilst the third is about 28 minutes in length. At the hearing, the Applicants confirmed that they did not have any part of the videos to highlight in particular. After watching some of the footage in each of these videos, I make the following observations:

- a) The event was held in the Marina Bay area, which is essentially a waterfront area overlooking the Central Business District (CBD);
- b) The powerboat race was attended by a crowd of people who sat along the sides of the river;
- c) The voice-over to these videos refers to the event as "the 6th annual grand prix of Singapore" (at 42:43-42:38 of MC-3A);
- d) The banners to this event on the video screen refer to it as "F1 UIM World Championship" and "GP of Singapore";
- e) The Plain F1 Mark appears on one of the boats in the competition, on the back of a person's t-shirt (in a prominent location), on the commentator's microphone on the video screen, on the victory podium ("F1 World Championship 2005").

51 The Opponents have not raised any objections to this evidence at MC-3 and MC-4 of the Joint Affidavit and it was not discussed further at the hearing. What is apparent from this documentary record is that a crowd of people in Singapore would have at least heard or seen the Applicants' powerboat race at that time. The Plain F1 Mark also appeared in relation to the Applicants' powerboat race on banners, powerboats, t-shirts, commentator's microphone, victory podium. It would be reasonable to conclude that, in 2005, the relevant sector of the public in Singapore would associate the Plain F1 Mark with the Applicants' powerboat race.

52 As for the UIM F1 World Championship Yearbook 2005 (MC-4), nothing is said about its circulation in Singapore. There is some information about the F1 powerboat drivers, including information about their career through the various types of powerboating (F2, F3, and so on) (see an example at p 124, Joint Affidavit). Under "Race Venues 2005", Singapore is listed as one of them. There is a detailed section on the Singapore race that was "Round 3" and "Round 4" of that year's race, held on 17 and 18 September 2005 (see pp 139-143, Joint Affidavit). One of the pictures of the victory podium in Singapore shows the Plain F1 Mark

used in the headline "UIM F1 POWERBOAT WORLD CHAMPIONSHIP SINGAPORE MARINA BAY GRAND PRIX 2005 16-25 SEPT" (see p 143, Joint Affidavit). The Opponents have not challenged this evidence.

53 Besides the evidence in relation to their own powerboating event(s), the Applicants have also tendered further evidence in support of the submission that the Plain F1 Mark is descriptive and/or generic and is not distinctive of the Opponents in Singapore, as follows.

54 The first category comprises of printouts of marks registered in the Trade Marks Registry, which the Applicants submit contain the Plain F1 Mark and other similar marks (Exhibit MC-6, Joint Affidavit). Some of these printouts pertain to trade marks that are beyond the relevant date (T1005458B, T1114986B). As for those within the relevant date, two of them refer to the same composite mark comprising of other elements such as a large number "1", "TOP" with the words "Formula 1" sitting inside the space of the large number "1". The dominant elements are the large number "1" and the stylized word "TOP", rather than the words "Formula 1". Another is an highly stylized "F1", which looks almost like a letter "A" or a rectangular block that has some negative spaces within it. The other two marks are "FIRECUT F-1" and "SYNERGY F-1", the former registered for fireproof paints and the like, and the latter registered for gasoline. However, none of these marks are registered for the Plain F1 Mark *per se*; it is difficult to see how these registrations support the contention that it is descriptive and/or generic.

55 The second category comprises of copies of printouts of company profile searches from the Accounting and Corporate Regulatory Authority ("ACRA") (Exhibit MC-7, Joint Affidavit). This evidence suffers from the same issues as the first category, in that some of the companies are registered beyond the relevant date and the names of these companies do not reflect the Plain F1 Mark *per se*. More significantly, the criteria for registering business names is subject to a different regime and not comparable to the criteria for registering trade marks. No submissions have been made on this point and I will therefore not go further into it.

56 The third category of evidence relates to the use of the Plain F1 Mark in relation to various types of sports. The exhibits in MC-8, 9 and 10 of the Joint Affidavit are submitted to show that the Plain F1 Mark has been used in the context of airplane racing. However, much of this evidence is dated beyond the relevant date of 11 January 2007. In particular, the references in relation to Singapore are beyond the relevant date: a Straits Times newspaper article referring to "F1" in the context of airplane racing is dated March 2, 2014 and another article featured on Asiaone News website about such racing in Singapore is dated 5 November 2009. The other articles referred to by the Applicants talk about airplane racing in other countries, such as Abu Dhabi (p 228), London (p 230), Australia (p 232), Spain (p 237), amongst others (all references in the Joint Affidavit). There is also a Wikipedia entry on "Formula One Air Racing" that describes it as "an American motorsport". According to the article, the Wikipedia page was modified on 26 March 2014. Not only is it beyond the relevant date, it may not be of any application to Singapore. In a subsequent article titled "Formula 1 air racing", it is described as an "all-American spectator sport" which came to Europe in 1970. Again, there is no indication that it was in Singapore until after the relevant date (see first two articles). The final article in this category, an article on <<http://airracef1.com/the-race>> has no date, although the date of the search appears to be on 9 May 2014. In addition, the article describes the history of air racing, tracing it back to France

before becoming a "global phenomenon". There is no indication that it arrived on Singapore's shores, and if so, whether it was prior to the relevant date.

57 Exhibit MC-11 contains documents referring to "Formula One" or "F1" being descriptive and/or generic in relation to motorcycle racing. It is dated on 10 March 2012 and refers to motor racing in Austin, in the United States. Similar to the evidence in relation to air racing, I find that it is beyond the relevant date, and in any event, describes events outside of Singapore.

58 Exhibits MC-12 to MC-17 similarly describe events that occurred outside of Singapore. For example, the reference in MC-12 to "BriSCA F1 Stock Cars" is another Wikipedia entry which describes it as "a class of single-seat auto racing in the UK." Another article on <<http://brisca.com/welcome/>> explains that BriSCA stands for British Stock Car Association and that it is present in venues throughout the UK with an affiliate venue in the Netherlands. In MC-13, an online article refers to the "US F1 Powerboat Tour" at various places in the US and Canada. In MC-14, an online article describes how Formula Powerboat racing commenced in Australia in 1988, and in 1997, formed the "Australian F1 Superboat Series." In MC-15, an online article describes how an event called the "World Water Ski Racing" will be based in Lake Rotorua (New Zealand) in 2007, and will attract 350 competitors from Australia, Great Britain, US, Italy, Canada, Austria, Belgium and Spain. Another online article describes how New Zealand will host the same championship again in 2015. The competitors come from the same countries. In MC-16, an online article on <<http://www.iceboat.org/faqiceboat.html>> describes an ice boat club in Madison, Wisconsin (in the US). In MC-17, an online article on <<http://www.yachtand yachting.com/news...>> describes the "Hunter Formula One National Championships at Rutland Sailing Club." There is no indication as to which part of the world the Rutland Sailing Club is, but there is no indication that this is in Singapore. Neither are there any submissions as to why I should take it into account despite the fact that they do not pertain to the Singapore market.

59 The fourth category of evidence relates to motor racing, and was tendered to support the Applicants' point that the Plain F1 Mark, "Formula 1" and "Formula One" are descriptive of a class of sport. In particular, the Applicants refer to two Wikipedia articles, one on "Formula One" which describes the term as referring to "the highest class of single-seater auto racing", and another article on "Formula racing", which explains that "formula racing" refers to any of several forms of open-wheeled single-seater motorsport (Exhibit MC-19, Joint Affidavit). The article indicates that the origin of the term lies in the nomenclature that was adopted by the FIA for all its post-World War II single seater regulations, or formulae. There are other types of formula racing such as "Formula Two", "Formula Three" and an older version "Formula 3000".

60 Similar Wikipedia evidence was considered to be of some relevance in opposition proceedings in the UK in the matter of *Application No 2277746C by Formula One Licensing BV and Opposition thereto by Racing-Live (Société Anonyme à Directoire) O/169/07*. RACING-LIVE had opposed the registration of "F1" in the UK in Class 41 on the basis that it lacked the necessary distinctiveness, being a recognized abbreviation for Formula One, and could not have distinctive character for services relating to Formula One racing. In that case, the UK Trade Marks Registry accepted the use of evidence from Wikipedia that contained the history and background of F1 racing. The registrar noted that no challenge was made to this evidence and held that, despite Wikipedia "suffer[ing] from the self-editing that is intrinsic to it", it could be taken "at face value", given that it is not any less likely to be true

that what is published in a book or on the websites of news organizations (see [29] of decision). The registrar later referred to the comments in Wikipedia on F1 being the "highest class of sing[le]-seat open-wheel formula auto racing" (see [34] of decision).

61 In the present case, the Opponents had no objection to this evidence from Wikipedia. As such, I am inclined to agree that this evidence can be taken at face value. However, I would not place too much weight on it, since it is essentially information that anyone can edit. The Wikipedia article states that:

- a) the Plain F1 Mark represents a type of single-seat auto racing sanctioned by the FIA;
- b) the Plain F1 Mark refers to a set of rules that motor cars must comply with in order to compete in the Opponents' motor racing championship; and
- c) there are various tiers of racing such as Formula Two (abbreviated to F2), Formula Three (abbreviated to F3), and Formula 3000.

62 The Applicants also refer to three other articles, one from The New Straits Times in Malaysia, and the other two from The Straits Times in Singapore. The first carries the date 26 October 2000 and describes the various tiers of racing such as Formula One, Formula Three, and F2000, although this refers to the Malaysian market (Exhibit MC-18, pp 341-346) and is therefore not directly relevant to the issues in this case. The second article (titled "*So you want to be an F1 driver?*") is relevant as it pertains to the Singapore market, and is dated 24 August 2002 (prior to the relevant date). The third article (titled "Mark his progress on the F1 track") discusses how Australian driver Mark Webber scaled the different tiers of motor sports races, from "Formula Ford", "Sportscars", "F3" and "F3000". The second and third articles corroborate the point made in the Wikipedia article that there are various tiers of racing, such as "Formula 3 (abbreviated to F3)", "Formula 3000", "Formula Ford" and "Formula Renault", in addition to "Formula 1 (abbreviated to F1)". These articles appear to corroborate the conclusion in the Wikipedia article, that the Plain F1 Mark represents a particular standard for motor car racing.

The law in relation to establishing distinctiveness

63 The law in relation to the distinctiveness of a trade mark has been recently discussed in the High Court decision of *Societe Des Produits Nestlé SA and another v Petra Foods Ltd and another* [2014] SGHC 252 ("*Nestle*") (see [163]-[216]). In *Nestle* at [169]-[170], it was held that mere association with a sign is not sufficient to show distinctiveness of the sign, but that something more is required to show that the sign serves a trade mark function of denoting the origin of the goods and/or services as originating from one particular trader, and no other:

169 Having considered the relevant authorities and having regard to the fact that the essential function of a trade mark is to act as guarantee of trade origin, **I find that it is not sufficient to show that the average consumer associates the shape of the good with a particular manufacturer. Something more than mere association is necessary before the trade mark can effectively and immediately serve its essential function**, which is, as I stated in *Love & Co* at [36], **to allow the average discerning consumer to immediately and readily perceive, recognise or identify the goods or services in question to originate from a particular trader and from no other.**

170 What more must be shown? The defendants submit that the test is this: **It must be established that a significant proportion of the relevant class of persons rely**

upon the trade mark (as opposed to any other trade marks which may also be present) as indicating the origin of the goods. While it is not essential for the trader to have explicitly promoted the sign in question as a trade mark, what the reader must show is that he has used the sign in such a way that consumers have in fact come to rely on it as indicating the origin of the goods. This is essentially what was proposed by Arnold J in *Vibe* at [90] (and repeated in *Nestle v Cadbury (HC)* at [55]). **I will therefore refer to it as Arnold J's test.** (Emphasis added)

64 The High Court in *Nestle* at [185] accepted that this test was the right one, and that it would apply equally to all trade marks, whether conventional or unconventional, as it would be wrong in principle to impose stricter criteria for the registration of shape marks:

Having thought through the matter carefully, I accept Arnold J's test as the correct one. I also do not have much more to add to Jacob LJ's judgments in *Unilever* and *Bongrain*. What I will say is this. If this is a matter in relation to a more conventional trade mark, such as a word or a device, or even a three-dimensional shape that does not consist of the shape of the goods in themselves, I do not think that the requirements posted by Arnold J and Jacob LJ would be considered unfair or unreasonable. **Clearly, Arnold J's test must apply to all trade marks, whether conventional or unconventional.** It would be wrong in principle to impose stricter criteria for the registration of shape-of-product signs. The converse is also true. It would also be wrong to relax the standard required merely because the sign to be registered as a trade mark is a product shape. (Emphasis added)

65 In *Kerly's Law of Trade Marks and Trade Names (15th Ed, 2011)* ("*Kerly's*") at [8-027] (cited by the High Court in *Nestle* at [165]), the authors suggested that the Court of Justice would affirm what they said in the case of *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd (Case C-299/99) [2003] 1 Ch 159* ("*Philips*") at [65], summarized into the following points below:

- (1) Mere association with a particular manufacturer is not enough;
- (2) The use of a sign must establish, in the perception of the average consumer, that the product originates from a particular undertaking;
- (3) That perception must result from the use of the sign as a trade mark—in other words, the proprietor must have done something in his use to identify the sign as being a trade mark, and mere extensive use during a period of monopoly, without more, is most unlikely to have achieved this.

66 The extract from *Philips* at [65] is reproduced below:

In the light of those considerations, the answer to the third question must be that, **where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods may be sufficient to give the sign a distinctive character** for the purposes of article 3(3) of the Directive [*similar to Section 7 of our Act*] **in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with that trader and no other undertaking or believes that goods of that shape come from that trader.** However, it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of specific and reliable data; that the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and

reasonably observant and circumspect, are taken into account, and that the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark as a trade mark. (Emphasis added)

67 From the authorities cited above, a sign meets the distinctiveness criteria only when it is able to perform the function of denoting trade origin in the sense that it allows customers to readily perceive, recognize or identify the goods or services as coming from one source and no other (see *Nestle*, at [169]). This was echoed in *Philips* at [65], where the court noted that it is only where the trader has been the *only* supplier of goods to the market, that extensive use of the sign may be sufficient to give it distinctive character. The key here is that this "extensive use" must enable the court to conclude that *a substantial proportion* of the relevant persons associate the sign with that trader *and no other undertaking*.

68 In relation to Section 8(4)(b) of the Act, the High Court in *Nestle* at [240] addressed the specific issue of whether a sign must be distinctive in order to be well known. The High Court was addressing the defendant's submission that without trade mark use in Singapore, the mark cannot be well known in Singapore. The High Court disagreed with the defendant's proposition, but reframed the position in the context of distinctiveness, as follows:

So, if the trade mark is inherently distinctive or *de facto* distinctive through acquisition of distinctiveness, a requirement of use cannot be read as a requirement before making the finding that it is well known. However, I think what the defendants mean is that a mark, not inherently distinctive, but capable of distinguishing a trader's goods or services as originating from that trader must first be factually distinctive through acquisition of a distinctive character under s 7(2) before it can be considered to be well known. If the mark is not inherently distinctive it can only acquire distinctiveness through use. So if there is no evidence of trade mark use for such marks to be at least distinctive enough to be registrable in Singapore as a trade mark, then the question of whether they are well known cannot arise. This I will accept.

69 In this case, however, the further evidence shows that there are at least *two* possible undertakings that the relevant sector of the public would *associate* with the Plain F1 Mark, and therefore, it is not distinctive of the Opponents alone. In addition, the Applicants' evidence in the Joint Affidavit also shows that the Plain F1 Mark is simply a standard that is associated with powerboating. In addition, the video evidence in Exhibit MC-3 shows that the general public is likely to associate the Plain F1 Mark with the Applicants' powerboating race in 2005. The Opponents' evidence shows that the general public may have associated the Plain F1 Mark with motor racing, or perhaps with more specific events such as the FIA Formula One World Championship or the Sepang Grand Prix. However, at around the same time, the relevant sector of the public would also associate the Plain F1 Mark with the Applicants' powerboating event. To give a specific example, the Opponents' evidence shows that the Championship was broadcast over the weekends of 3-4 September 2005 and 27-28 May 2006 (see [29] above). There are also other newspaper articles in 2005 that make reference to the Plain F1 Mark in relation to the Opponents' motor races (see [28], [32] above). Within the same year, ie. 2005, the Applicants also held their powerboating races on 17 and 18 September 2005 (and possibly up to 25 September 2005) (see [52] above). In fact, the Opponents' Championship broadcast (3-4 September 2005) and the Applicants' 2005 powerboat race (17-18 September 2005) were actually held in the same month, in September 2005.

70 The case of *Han's (F & B) Pte Ltd v Gusttino World Pte Ltd* [2015] SGHC 39 (see [52]-[98]), which was published on 10 February 2015 as I was writing this decision, also addresses the issue of distinctiveness substantively, in relation to the Plaintiffs' various "Han's" trade marks and the Defendants' "Han" sign. It was held that the Plaintiffs' "Han's" word marks were not inherently distinctive, but had gained distinctiveness through use, and therefore, there was no ground for invalidating their registrations under Section 23 of the Act. The court, in stating the principles on which a mark may be found to be distinctive, held at [57] that

Nevertheless, whatever the outer limits of trade mark function are, few will doubt that the most basic function of a trade mark is to enable a trader to distinguish his goods or services from those of his competitors in the marketplace. That is the plank on which all else stands. The law, by protecting the origin function of a trade mark, helps to promote inter-brand competition. By doing this, the law also assists consumer choice between alternative products and services in the marketplace. It follows that the threshold requirement that the sign must be capable of distinguishing goods or services of rival traders in the market is nothing more than an expression of the underlying policy behind trade mark protection.

71 And at [65]

Allowing a trader to register and obtain a monopoly on words and phrases which other traders may wish to use in respect of their goods and services for entirely legitimate purposes (including competition) is clearly not in the public interest. For example, under the Trade Marks Act 1938 (c 22) (UK) ("UK TMA 1938"), Gibson J held in *Smith Kline & French Laboratories Ltd's Cimetidine Trade Mark* [1991] RPC 17 at 34 that in deciding whether a claimed trade mark was inherently adapted to distinguish:

[T]he court takes account of the likelihood that other traders may, without improper motive, desire to use the trade mark in relation to their own goods. On grounds of public policy a trader will not be allowed to obtain by a trade mark registration, a monopoly in what other traders may legitimately wish to use ...

While these observations were in relation to the now repealed UK TMA 1938, the general sentiments expressed by Gibson J remain relevant.

72 As the parties have not had the opportunity to make submissions on this case, I will not delve into it in detail, save to note that my decision in the present case appears consistent with the principles cited by the High Court. In view of the evidence, the Plain F1 Mark is not able to perform the basic function of "distinguish[ing] his goods or services from those of his competitors in the marketplace". It would therefore not be in the public interest to allow the Opponents to "register and obtain a monopoly on words and phrases which other traders may wish to use in respect of their goods and services for entirely legitimate purposes (including competition)."

73 In view of the foregoing, I find that the Plain F1 Mark cannot be distinctive of the Opponents' goods and/or services alone. There is also evidence that the Plain F1 Mark simply refers to a certain standard associated with motor sport or powerboating. As such, it has not been used as a trade mark and does not satisfy the definition in Section 2 of the Act. Consequently, I will not have to consider whether the Plain F1 Mark is a "well known" trade mark under Section 2 of the Act. The Plain F1 Mark would therefore not be regarded as an

"earlier trade mark" under Section 2 of the Act, and does not qualify for consideration under Section 8(2)(b) or Section 8(4)(b) of the Act.

Observations

74 In the present case, the Plain F1 Mark did not qualify as a "trade mark", and therefore, there was no need to go on and consider whether it was a "well known trade mark" for the purpose of Section 8(2)(b) or Section 8(4)(b). However, *if* there was a need to consider whether it was a "well known trade mark" for the purposes of Section 8(2)(b), a question that remains is whether the threshold should be set so low so as to block legitimate traders from obtaining registration when the "earlier trade mark" was only well known to a small, niche segment of the market (for example, the Singaporeans who attended the Sepang Grand Prix). It should be borne in mind that under Section 8(2)(b), the opponent only needs to show that there is a *likelihood of confusion* on the part of the public, whilst under Section 8(4)(b), the opponent needs to show that there is either *likelihood of damage* or *dilution and/or unfair advantage* of the distinctive character of the earlier trade mark. Given the applicability of the "earlier trade mark" definition in Section 2(1) to both Section 8(2)(b) and Section 8(4)(b), it may be preferable that the threshold for a well known mark not be set too low, and be reserved for marks which "perform crucial signalling, symbolic and even myth-making roles in society" (see *Amanresorts* at [143], cited above at [25]). These concerns were first expressed in a recent IPOS decision in *Alphasonics (Ultrasonic Cleaning Systems) Ltd. v. Alphasonics (Pte) Ltd* [2013] SGIPOS 6 (see [41]-[46]).

Goodwill

75 I turn to address the question of goodwill. The Opponents' submissions in relation to goodwill were scant, being just two paragraphs that made a brief reference to establishing goodwill in Singapore as a result of (i) the broadcast of the Championship on Singapore television and (ii) their business presence in Malaysia through the Sepang Grand Prix (see [15] and [17] of their written submissions). The Applicants' submissions in this regard were more detailed. They submitted that since the Opponents' first race only took place in 2008, any goodwill that they might have should be in the form of pre-trading activity. In this regard, the use of the Plain F1 Mark could not have contributed to this pre-trading activity because it was not directed at generating demand in Singapore, but directed at the Sepang Grand Prix. The Plain F1 Mark was also always used in a descriptive sense and not as a trade mark.

76 In order for goodwill to be established, one of the key requirements is that the Opponents must have business in the jurisdiction (ie. Singapore). However, certain types of pre-trading activity will also be recognized. In this regard, the Court of Appeal gave the following guidance in *Staywell* at [141]-[143]:

141 First, pre-trading activity need not be revenue-generating. This stems from the understanding that goodwill does not focus on the income of the trader *per se* but the response of the consumer. The fact that income is generated is only a proxy for the attractive force of the business. This court's holding in *CDL Hotels* acknowledged that valuable demand may be created in a product or business prior to its being monetized.

142 Second, the relevant pre-trading or pre-business activities should unequivocally evince the intention of the trader to enter into the Singapore market. This is consistent with the cases which have enlarged our understanding of how and for what purpose

goodwill can be created. In *WH Allen, BBC and Windmere Corp*, the advertising activity conducted was not of the sort that created brand awareness in general, but was geared toward creating tangible demand for an upcoming product. This court in *CDL Hotels* also had in mind such ‘pre-launch’ advertising when it recognised (at [58]) that “promoters of businesses usually embark on massive advertising campaigns *before the commencement of trading to familiarise the public with the service or product*” (emphasis added). The fact that the traders in *CDL Hotels, WH Allen, BBC and Windmere Corp* had proceeded with administrative arrangements such as entering into operating agreements for the soon-to-be-opened hotel, or printing and manufacturing the advertised products in preparation for sale, left no doubt that the demand created by the advertising would eventually be satisfied. This distinguishes the situation from that in *Anheuser-Busch*, where any demand created would not be met due to the unavailability of the product within the jurisdiction.

143 More recently in *Starbucks (UK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3974 (Ch), Arnold J held that although advance advertising could create protectable goodwill, the activities relied on by the foreign plaintiff to establish goodwill in the UK “d[id] not take the form of advertising or promotion for a forthcoming product or service”. Instead, the advertisements were primarily aimed at promoting its home business in Hong Kong (at [151]–[152]). The Australian position on pre-trading activity is also consistent with this approach. In *Turner v General Motors (Australia) Pty Ltd* [1929] 42 CLR 352, Dixon J found that protectable goodwill in General Motors (Australia) was created through widespread and prolonged advertising in Australia of the plaintiff’s intention to set up its Australian undertaking. The plaintiff also secured offices and commenced the erection of works at the site. It was found that due to the advertising, the Australian public came to associate the term “General Motors” specifically with the upcoming Australian undertaking. This approach is also recognised in *The Law of Passing-off* at 3-063, which states that:

Despite these reservations [as to whether pre-trade activity can generate goodwill], it is suggested that advertising directed at a specific market in actual preparation for trading does generate sufficient goodwill to support the action. Lord MacNaughten’s description of goodwill as “the attractive force which brings in custom” is consistent with goodwill existing because advertising has created a demand of the claimant’s business before it commences...

77 To summarize the position taken in *Staywell*, in order for pre-trading activity to qualify as “goodwill”, it need not be “revenue generating” but needs to create a demand *which could eventually be satisfied*. The Court of Appeal made a distinction between the cases where the pre-trading activity eventually led to a tangible business presence within the relevant jurisdiction and cases such as *Anheuser-Busch v Budejovicky Budvar NP* [1984] FSR 413 (where any demand created would not be met due to the unavailability of the product within the jurisdiction) and *Starbucks (UK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3974 (Ch), where the pre-trading activity was not generated to generate demand for a forthcoming product or service in the relevant jurisdiction (UK), but was primarily aimed at promoting its home business in Hong Kong.

78 In the present case, the Opponents rely on their television broadcasts as relevant pre-trading activity and the promotion and marketing of “F1 merchandise” as showing that there was goodwill prior to the relevant date. In view of *Staywell*, this evidence does not meet the criteria for pre-trading activity that is sufficient to constitute goodwill. The television broadcasts were held in 2005 and 2006 (see [29] above). These broadcasts were labelled as

"Italian Grand Prix" and "Monaco Grand Prix" and there is no indication that it was intended to generate demand *in Singapore* for the Opponents' goods and services. As for the "promotion and marketing of "F1" merchandise", the Opponents do not make any specific reference to this in their written submissions. There are some newspaper advertisements that appear to be advertisements for "Tag McLaren Audio F1 Avantgarde Speakers" an "F1 collection from Mattel", "TAG Heuer Kirium F1" watch, a "limited edition Photosmart BMW Williams F1 digital camera", amongst others (see [23] above). However, these products do not appear to be the Opponents' products but are those of other parties. Therefore, these advertisements do not generate demand for the Opponents' products, but for other parties' products:

- a) the newspaper article advertising the "Tag McLaren Audio F1 Avantgarde Speakers" informs the reader that the speakers are "*produced by an affiliated company to the McLaren F1 team*";
- b) the newspaper article advertising the "F1 collection from Mattel" informs the reader that "*Toy-maker Mattel has released its Hot Wheels Grand Prix collection*";
- c) the newspaper article advertising the "TAG Heuer Kirium F1" watch includes a "Tag Heuer" logo in a relatively prominent location at the bottom right hand portion of the article and also informs the reader that Tag Heuer is the official timekeeper for the FIA Formula One World Championship; and
- d) the newspaper article advertising the "limited edition Photosmart BMW Williams F1 digital camera" informs the reader that "HP" (presumably, "Hewlett-Packard") is the producer of the said camera.

79 The other newspaper articles in the Opponents' evidence refer to, *inter alia*, the Opponents' races overseas (see [28(b)] (British Formula One Grand Prix), [28(d)] (Belgian Grand Prix), [30(b), (c), (d), 31(a), (b)] (Sepang Grand Prix)), several articles about Singaporeans dabbling with driving a Formula One car, attending an FIA-sponsored trip to Bahrain, a letter by a fan writing in about the economic benefits of bringing the motor race to Singapore, and several articles about the possibility of increase in car sales being tied to performance in these races. These articles, whilst possibly developing the Opponents' *reputation* in Singapore for motor races, do not translate into *goodwill* for the Opponents. Any demand created by these advertisements would not be met due to the unavailability of the product within the jurisdiction by the relevant date. Specifically in relation to the Sepang Grand Prix, the activities relied on by the Opponents were not generating demand internally (within Singapore) but primarily aimed at promoting their business in Sepang, Malaysia. The newspaper articles are also, strictly speaking, not pre-trading activity because they were not conducted by the Opponents, but a third party (ie. the newspaper itself). There is some doubt that the Opponents' use of these articles can be considered to be "pre-trading activity", given that this "activity" was not something that was undertaken by the Opponents themselves. However, even if they could be considered to be pre-trading activity, it would fail the test set out in *Staywell*, because this activity was not targeted at generating demand in Singapore that could be eventually satisfied, by the Opponents' arrival in Singapore before the relevant date on 11 January 2007.

80 At this point, I pause to consider the case of *Amanresorts*, where the Court of Appeal concluded that the respondents had goodwill in the "Aman" names in Singapore despite their resorts being outside of Singapore (although this goodwill was limited to certain categories of guests who had been exposed to the respondents' selective marketing, and amongst those in the high end travel and resort industry (see *Amanresorts* at [66])). This case can be

distinguished on two grounds. Firstly, the distinctiveness of the "Aman" names was not contested in that case and the "Aman" names were considered to be capable of being the vessels of goodwill (see *Amanresorts* at [40]). Secondly, whilst the respondents did not have any resorts in Singapore, they did have two offices in Singapore; their headquarters was located in Singapore and they had "an actual customer base" in Singapore (see *Amanresorts* at [68]). In the present case, the Plain F1 Mark is not distinctive of the Opponents' motor races (see conclusion at [73] above) and there is no evidence that they had any sort of presence in Singapore as at the relevant date – in fact, the Opponents' evidence points towards the opposite conclusion (see [33]-[34] above and [81] below). Thus, whilst in *Amanresorts*, the trading activity (via their headquarters or offices) had already begun, in the present case, it had not, and the Opponents would have had to rely on any relevant pre-trading activity to establish a case for goodwill in Singapore.

81 The last category of evidence that I will consider as regards goodwill is a magazine article dated October 2008, titled "Sunday Night Fever" (see [33] above). There is the preliminary issue about whether this article should be admissible because it is beyond the relevant date. Even if it is relevant, I do not think it assists the Opponents. The article only serves to confirm that the administrative arrangements made in preparation for the Opponents' first night race in Singapore were made after the relevant date. The resident engineer for the "Singapore Grand Prix" was quoted in this article as saying (at p 347, Corbett Affidavit) that

The ground-breaking for the pit building took place on August 31 last year [i.e. 2007] and the first significant concrete was poured on October 15. The final circuit surface was laid on the pitlane on June 6 2008.

82 In view of the above I conclude that there is no pre-trading activity that is sufficient to constitute goodwill for the purpose of Section 8(7)(a) of the Act on the basis of the new evidence that has been tendered.

Foreign decisions

83 The Opponents referred to a number of foreign decisions in the Corbett Affidavit, which for the purpose of the present hearing were to be treated as submissions, not as evidence of the facts stated therein. At the hearing, the Opponents spent a considerable amount of time on this part of the Corbett Affidavit. The Applicants tendered Reply Submissions mainly to address these decisions.

84 These foreign decisions are not binding on IPOS, since trade mark rights are essentially territorial in nature. The principles applied in deciding trade mark rights may vary from one jurisdiction to another. However, the foreign decisions may be persuasive, if their laws are similar to that of Singapore, if the sign or mark at issue is the same and/or if the parties are the same.

85 In the present case the Opponents tendered decisions from various trade mark registries in China, Turkey, Rome, Canada and Romania. The Opponents also tendered two decisions from the World Intellectual Property Office (WIPO) Arbitration and Mediation Center Administrative Panel Decision pertaining to the domain names <f1rocks.com> (first decision) and <f1showcar.com>, <f1showcar.net>, <f1showcars.com> (second decision).

86 The Opponents have not made any submissions as to why these decisions may be particularly persuasive. Generally, I observe that these decisions (except for the Canadian decision) emanate from civil law jurisdictions, rather than common law jurisdictions such as Singapore. Even then, I am unable to see how these decisions assist in determining the threshold issue of whether the Plain F1 Mark is well known to the relevant sector of the public *in Singapore*. The evidence in each of these jurisdictions is bound to be different because it relates to different sectors of the public in different jurisdictions. As stated by the Court of Appeal in *Amanresorts* at [137] and [139], the court is "ordinarily free to disregard any or all of the factors listed in s 2(7) as the case requires", subject to s 2(7)(a), which is the criteria that the mark must be well known to the relevant sector of the public in Singapore (which is "arguably the most crucial factor" in the determination of whether a mark is well-known). I do not see any reason to consider the foreign decisions in the present case.

87 As for the domain name disputes, I agree with the Applicants' submission that these disputes are limited to their own context. These decisions fall within the remit of the Uniform Domain Name Dispute Resolution Policy ("UDRP"). In **Cornish, Llewelyn & Aplin's *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights (8th Ed)*** at [20-94] and [20-95] the learned authors explain the difference between the UDRP and trade marks disputes:

In only three years there have been many thousands of complaints handled through this system [the UDRP] and it has been accepted rapidly by business communities...

This phenomenon—and it deserves that name—is fascinating on two counts. It has generated substantive rules, through its case law, as well as the policy itself. The policy encourages a synthetic approach by empowering panels to apply "any rules and principles of law that it deems applicable." Equally it is built upon procedural arrangements which strive to provide justice which is fair, as well as being rapid and cheap. Three substantive conditions, laid down in the UDRP, define what the complainant must show:

- (i) the domain name must be identical or confusingly similar to a trade mark in which the complainant has rights;
- (ii) the respondent must have no rights or legitimate interests in the domain name; and
- (iii) the domain name must have been registered and be used in bad faith.

While these principles are a reflection of a shared approach in most legal systems to deliberately wrongful misrepresentation of indications of source, it does not follow the precise rules of any one legal system. Fundamentally that is because the comparison which has to be made is in essence different. In a dispute over the use of trade marks or names, the claimant is usually concerned to show misrepresentation relating to the defendant's use of the mark on the same or similar goods or services. But a domain name is not tied to trade in anything in particular or indeed to any obligation to use it.

88 In ***Law of Trade Marks and Passing Off in Singapore (3rd Ed, Vol II, 2013)***, Tan Tee Jim S.C. explains at [20.130] that

Thus, it is important to bear in mind that the UDRP is not, and was not designed to be, a substitute for the courts. Its decision has no binding effect other than on the registrar of the domain name in question. It is a set of contractual provisions that are incorporated by reference into registration contracts between ICANN-approved registrars and domain name registrants.

89 I agree with these learned authors that the UDRP is essentially a *sui generis* forum convened to deal with a very specific issue, and that their decisions are generally not applicable to the present matter before me. Therefore, I find that the UDRP decisions are not relevant to deciding the threshold issue of whether the Plain F1 Mark is well known to the relevant public in Singapore.

SJC-16

90 I have discussed the relevance of SJC-16 in relation to whether the Plain F1 Mark is distinctive (see [36] above). In relation to goodwill, I repeat my observation that this newspaper article is beyond the relevant date and does not assist the Opponents.

Observations

91 It should be borne in mind that the present decision was decided *in relation to the Plain F1 Mark only* and *in the context of the perception of the relevant public as at 11 January 2007*. Since then, the Opponents have gone on to organize their motor races for the past six years, ie. 2008 to 2013. Two points may be made. The first is that the Opponents, whilst not having trade mark rights in the Plain F1 Mark, may have rights in other word or composite marks which refer more specifically to their motor racing event(s). The second is that the Opponents may not have had any trade mark rights to the Plain F1 Mark prior to 11 January 2007, but could have attained other rights after this date. This would of course depend on the evidence tendered by the Opponents at that stage. However, this discussion is not relevant for the present case.

Conclusion

92 In conclusion, I find that based on the further evidence in the Corbett Affidavit and the Joint Affidavit as allowed by the High Court in ORC 6760/2014 and as agreed between the parties, the Plain F1 Mark ("F1") is not well known to the relevant sector of the public in Singapore, and is therefore not an earlier trade mark for the purpose of Section 2 of the Act. I also find that the said further evidence does not prove that there is any pre-trading activity sufficient to constitute the necessary goodwill for the purpose of Section 8(7)(a) of the Act.

93 As such, my decision in [2013] SGIPOS 8 as regards Section 8(2)(b), Section 8(4)(b) and Section 8(7)(a) of the Act remains unchanged. The parties have not raised any issue as regards my decision as to Section 7(6) of the Act and accordingly I have not addressed it here.

Dated this 15th day of April 2015.

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