

Intellectual Property Office of Singapore Case Summary: Formula One Licensing B.V. v. Idea Marketing S.A. [2015] SGIPOS 7

Source: <https://www.ipos.gov.sg/resources/hearing-mediation>

Published: 20 April 2015

On 11 January 2007, Idea Marketing SA (the "**Applicants**") applied to register "**F1H2O**" (the "**Application Mark**") in respect of certain goods in Classes 9, 25, 38 and 41. Prior to this date, Formula One Licensing B.V. (the "**Opponents**") had registered the following trade marks in various classes, including Classes 9, 25, 38, 41:



However, the Opponents claimed that they used "F1" (referred to as the "**Plain F1 Mark**") as an "earlier trade mark" prior to 11 January 2007 because the Plain F1 Mark was a "well-known trade mark." They also claimed to have enjoyed goodwill in the Plain F1 Mark prior to 11 January 2007. On this basis, the Opponents sought to prevent the registration of the Application Mark.

It is important to note that the present decision pertains to whether the Plain F1 Mark was well-known to the relevant sector of the public in Singapore in relation to motor races – not as at the present date, but as at 11 January 2007, before the commencement of the F1 night races in Singapore. The first night race was held in Singapore in 2008.

The present case was previously heard by the Registrar in *In the Matter of a Trade Mark Application by Idea Marketing S.A. and Opposition thereto by Formula One Licensing B.V.* [2013] SGIPOS 8 ("**[2013] SGIPOS 8**"). It then went on appeal to the High Court, in *Formula One Licensing B.V. v Idea Marketing S.A.* ("**TA 22/2013**"). During the course of the appeal, the Opponents sought to introduce new evidence which was not before the Registrar when the case was first heard on 30 September 2013. The High Court allowed some of this new evidence and ordered that it be placed before the Registrar, without further cross-examination. The parties agreed that this would essentially mean that the hearing officer would have to re-hear the case and consider if the new evidence would change her earlier decision. The parties agreed that they did not intend to raise any jurisdictional or procedural issues regarding the re-hearing of the matter and also agreed that the Registrar had jurisdiction to re-hear the matter.

Having re-heard the case as ordered (and agreed between the parties), the hearing officer maintained her decision that the Opponents have failed to show, as at 11 January 2007, that the Plain F1 Mark was "distinctive" and therefore, it cannot be a "well-known" mark that could be considered to be an "earlier trade mark" as defined in Section 2 of the Trade Marks Act (the "**Act**").

The further evidence showed that whilst the relevant sector of the public would associate the Plain F1 Mark with the Opponents' motor races, they would have been exposed to the use of the Plain F1 Mark in respect of *both* the Applicants' powerboat races *and* the Opponents' motor races in other countries *at around the same time*. In particular, the Opponents' motor races that were held outside of Singapore were televised to the Singapore audience in September 2005, the same month and year in which the Applicants had held one of their powerboat races in Singapore (see [69]). The High Court in *Societe Des Produits Nestlé SA and another v Petra Foods Ltd and another* [2014] SGHC 252 held that *mere association* with the sign is not sufficient to show distinctiveness (as a trade mark) and that something more must be shown 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* (see [66]). In this case, the relevant sector of the public could associate the Plain F1 Mark with *either* the Opponents or the Applicants. In addition, the further evidence showed that the Plain F1 Mark referred to a standard associated with either motor sport or powerboating. Several news articles referred to the different tiers of motor sports races, including "F2", "F3" and "Formula 3000" (see [59]-[62]).

Another issue was whether the Opponents had goodwill in Singapore through their use of the Plain F1 Mark. The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 held that a requirement to establishing goodwill is that the Opponents must have business in the jurisdiction (ie. Singapore). However, certain types of pre-trading activity will also be recognized. In order for this pre-trading activity to qualify as goodwill, it must unequivocally evince the intention of the trader to enter into the Singapore market, for example, creating a demand for their goods and/or services in Singapore which could eventually be satisfied (see [76]-[77]). The Opponents did not have any business in Singapore as at 11 January 2007 and its activities prior to 11 January 2007 were targeted at generating demand *outside Singapore* for their motor races. There was some evidence of goods

bearing the Plain F1 Mark that were advertised prior to this date, but these advertisements were directed at generating demand for other parties' goods, not the Opponents' goods (see [78]).

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.