

O-286-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2331374
BY MARCH HOLDINGS LTD TO REGISTER
THE TRADE MARK MARCH FORMULA ONE
IN CLASSES 9, 16, 25 AND 35**

AND

**IN THE MATTER OF OPPOSITION No. 93287
BY FORMULA ONE LICENSING B.V.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2331374
by March Holdings Ltd to register the Trade Mark
MARCH FORMULA ONE in Classes 9, 16, 25 and 35**

and

**IN THE MATTER OF Opposition No. 93287
by Formula One Licensing B.V.**

BACKGROUND

1. On 7 May 2003 March Holdings Ltd applied to register the mark MARCH FORMULA ONE for the following goods and services:

Class 09:

Photographic, cinematographic computer software and games relating to transmitting and reproducing the sound and images of motor vehicles, racing cars, motor cycles and land, sea and air locomotives.

Class 16:

Paper, cardboard and goods made from these materials, printed matter, photographs, printed publications.

Class 25:

Clothing, footwear and headgear.

Class 35:

Advertising; business management; business administration; office functions; all of the aforesaid relating to the creation of sporting and motoring teams.

2. On 17 March 2005 Formula One Licensing B.V. filed notice of opposition against this application citing grounds under Section 3(6), 5(2)(b), 5(3), 5(4) and 56.

3. In relation to Section 3(6) the objection is said to be that “the applicant is using the Opponent’s earlier mark, FORMULA ONE, within its sign MARCH FORMULA ONE to take advantage of the goodwill and well-known nature of the Opponent’s mark FORMULA ONE”.

4. The objections under Section 5(2)(b) and 5(3) are based on the marks brief details of which are shown in the Annex to this decision. In relation to Section 5(3) the opponent says:

“The earlier marks of the Opponent FORUMLA ONE is of a distinctive character and the use has been closely regulated to maintain the distinctiveness of the mark as well as its use on the goods and services for which it represents. The use or registration of the mark MARCH FORMULA ONE is taking unfair

advantage of the Opponent's goodwill and reputation in its mark FORMULA ONE. Further the race season for this distinguished motoring event begins, predominantly, in the month of March since at least as early as 1980s and consistently in the month of March since 1990. Therefore the use or registration of the sign MARCH FORMULA ONE is a deliberate effort to take unfair advantage of the Opponent's goodwill and reputation in its mark. The use and registration of the sign MARCH FORMULA ONE will have a detrimental effect on the Opponent's goodwill in the mark FORMULA ONE."

5. In relation to Section 5(4) it says:

"The word mark FORMULA ONE [is] used on organising and staging motor races, televising and broadcasting motor races, provision of information regarding such races, sale of publications, videos, computer programmes and games, video games, as well as merchandise advertising promotion and sponsorship services. The mark has also been used on all the goods and services detailed under Schedule 1."

and

"The first race bearing the name FORMULA ONE was held in 1950. This we claim as the first use of the unregistered mark FORMULA ONE."

6. In relation to the well known mark claim under Section 56 it says:

"The FORMULA ONE brand and image is synonymous with the GRAND PRIX motor racing industry. The goods and services which are associated to FORMULA ONE are authorised for use by the Opponent as a result of arrangements between Formula One Administration Ltd, the Federation Internationale de L'Automobile (the international governing body of motorsport) and the Opponent. The well-known nature of the Opponent's mark can be shown, for example, by the worldwide live coverage, of the race events when marketed and known as the FORMULA ONE. The mark FORMULA ONE of the Opponent is an earlier well known mark which should be protected. The mark applied for, MARCH FORMULA ONE should be refused registration under section 56 and 6(1) of the Trade Marks Act 1994.

The mark applied for is visually, phonetically and conceptually similar to the earlier marks of the Opponent. All the goods and services of the mark applied for are identical or similar to those for which the Opponent's well known mark is both registered and used."

7. The objection in each case is to all the goods and services of the application.

8. The applicant filed a counterstatement denying each of the grounds. It explains that March is the name of a racing team that was predominantly involved in Formula 1 racing in the 1960s through to the mid 1980s. The mark applied for is owned by a subsidiary of the successor racing company. The name MARCH is an acronym of the founding members of the early team.

9. I should add that this is one of two cases between the parties (the other is being dealt with under opposition no. 93290). The actions involve different marks, the opponent relies on different earlier trade marks and, with certain exceptions, the actions give rise to different considerations. It was not, therefore, appropriate to consolidate the two oppositions. They are however ‘travelling together’.

10. Neither party has asked for a hearing. The opponent has filed written submissions dated 2 August 2007. The applicant has filed undated submissions that were received in the Office on 3 September 2007. Acting on behalf of the Registrar I give this decision.

Opponent’s evidence

11. Patricia Anne Heavey has filed a witness statement. She is the Trademark Manager of Formula One Management Limited part of a group of companies in common ownership with the opponent company.

12. Her statement sets out details of the marks relied on (as per the Annex to this decision). She says:

“In this Witness Statement I will collectively refer to the trademarks listed above as “the Opponent’s Marks”, unless I am referring to a specific trademark. However, specific mention will be made of the F1 FORMULA 1 logo, which for reference appears as follows:”

13. The mark referred to is the stylised F1 mark of Nos. 3429396 and 631531. As can be seen from the Annex all the marks consist of or contain the word and numeral FORMULA 1. In the case of Nos. 770479 and 554873 those elements make up the whole of the marks. In the case of most of the other marks there is other dominant distinctive matter in the form of the FIA logo and the F1 logo. There is also a FORMULA 1 oval mark. The evidence does not readily disentangle the various threads in a way that permits determination of issues of distinctiveness and consumer recognition of the FORMULA 1 element on its own or as a component part of the composite marks. I have given careful consideration to the exhibits supporting Ms Heavey’s witness statement and agree that it is the stylised F1 logo that features most prominently and consistently in the material supplied. What follows at this point is, therefore, a brief overview of the content of the evidence rather than a full summary.

14. Paragraphs 5 to 7 deal with the activities of the opponent and the FIA Formula One World Championship.

15. Paragraphs 8 to 13 deal with the prestige of the Championship, the costs and technological achievements of the teams and the consequent attraction of the sport for sponsors and advertisers.

16. Paragraphs 14 to 25 deal with use of the marks which is tightly controlled by the opponent’s group. Each of the participating teams is able to use FORMULA 1/ONE or F1 in their official name. The group is said to have licensed such use since as early as 1998. There is enormous televised coverage of the races producing European

annual audience figures at or about 1 billion people. There were over 85 million UK viewers in the 2001 season. There is also associated press coverage.

17. Ms Heavey's witness statement goes on to deal with use by the opponent's group within the areas of goods and services applied for.

18. Paragraphs 26 to 55 deal with the various Class 9 goods. A great deal of information is supplied about the international (television) feed including footage of the race, footage from on board cameras, information on track and weather conditions and driver (timing) data. The opponent's group also licenses computer games and videos based on the sport. Still photographs are made available over the Internet. A review of the 1998 Championship was produced in CD ROM format. There is also an official website.

19. Paragraphs 56 to 60 deal with use in relation to Class 16 goods. In March 2001 a monthly magazine went on sale in the UK and was available internationally. Since February 2004 Haymarket Publications Ltd has been licensed to use the F1 mark. There have also been annual season book reviews for 2001 to 2003 and race programmes etc. featuring the marks.

20. Paragraphs 61 to 66 deal with general merchandising including clothing. In 1995 the group entered into an exclusive worldwide licence with Specialised Licensing Services SA, a wholly owned subsidiary of The Walt Disney Company. This agreement ran for three years. In 2003 the group licensed use of the logo mark to Hackett Limited to use on sportswear. The teams and the tyre manufacturer, Michelin, have also been licensed to use the mark in association with their own names.

21. Paragraphs 67 to 93 deal with use of the opponent's marks in relation to advertising through, official sponsorship of each race, trackside advertising, a global partner programme, team sponsorship, suppliers, television advertising and advertising space in magazines and programmes.

22. Finally Ms Heavey deals, in paragraphs 95 to 101 with observations on the liquidated company March Engineering and the relationship between March Holdings Ltd (the applicant) and March Racing Ltd. She is of the view that the position whereby each of these companies wholly owns the other is illegal under the Companies Act 1985.

23. Furthermore, an online search of Companies House records disclosed no reference to March Formula 1, a company referred to in the counterstatement. Various other claims are made in relation to the applicant's claim to the mark MARCH FORMULA ONE. Ms Heavey also exhibits a letter from one of the founding members of March Engineering which claims that neither March Holdings Limited or March Racing Limited has the rights to the mark FORMULA ONE. The letter also acknowledges the opponent to be the rightful owner of the rights to the mark.

24. There are some 44 exhibits in support of the various claims made above. That completes my overview of the evidence. I will return to relevant details later in this decision.

DECISION

Section 3(6)

25. The relevant part of the statute provides that a trade mark shall not be registered if or to the extent that the application is made in bad faith.

26. The opponent's written submissions contain the following:

- “1. In relation to the objection under Section 3(6), the opponent refers the Registrar in particular to paragraphs 95 to 103 of the witness statement of Patricia Anne Heavey dated 9 October 2006 (the witness statement) and the exhibits mentioned in those paragraphs, particularly Exhibit 44. From this section of the witness statement it is clear that the application has been made in bad faith given that the applicant has no rights to the MARCH element of the mark applied for.
2. Further, in view of the opponent's very extensive registered and unregistered rights in the trade mark FORMULA ONE and variations thereon, it is clear that the application has been made in bad faith because it was made in the knowledge of those rights.
3. Similarly, UK trade mark application No 2331375 MARCH GRAND PRIX, which the applicant filed on the same date as the subject application, is a further indication of bad faith, showing the applicant's intention to take unfair advantage of the opponent's extensive registered and unregistered rights.”

27. Exhibit 44, referred to in paragraph 1 above is a letter from a former director of March Racing Ltd written it would seem after being contacted by 'Bernie's office' (Bernie Ecclestone) and informing a Mr Tom Megan that March Racing cannot use the expressions 'Formula One' or 'Grand Prix' without the specific permission of Mr Eccelstone's group.

28. Ms Heavey's evidence also raises the issue of a claimed irregularity in the cross shareholdings of two March companies, one of these being the applicant. The perceived implications (if any) for the trade mark application are not made clear. Reference is also made in paragraph 98 of Ms Heavey's witness statement to a registration of the mark MARCH in classes 12 and 42 standing in the name of the March Racing Organisation Limited. Ms Heavey suggests that this contradicts the applicant's claim to all the marks, goodwill and branding of the early team. Finally, there is the suggestion that bad faith claim is reinforced because of the existence of the related application.

29. It will be apparent from the above that the opponent has started a number of hares running and that the grounds or potential grounds of the attack under Section 3(6) have shifted. However, the statement of grounds that is before me does not disclose any request to amend the pleaded case which, therefore, stands as:

“The applicant is using the Opponent’s earlier mark, FORMULA ONE, within its sign MARCH FORMULA ONE to take advantage of the goodwill and well-known nature of the Opponent’s mark FORMULA ONE”.

30. Only paragraph 2 of the opponent’s written submissions and evidence bear any relationship to the ground as pleaded and even the aforementioned paragraph 2 introduces the notion of knowledge of the opponent’s rights on the part of the applicant that was not alluded to in the statement of grounds.

31. In *Julian Higgins’ Trade Mark Application* [2000] RPC 321 the Vice Chancellor said:

“If the pleadings do not identify the right issues, the issues parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.”

32. Not only has the direction taken by the opponent’s case strayed a long way from the pleaded case but the objection as framed in the statement of grounds does not necessarily disclose a bad faith issue as distinct from a relative ground objection.

33. In *Royal Enfield Trade Mark* [2002] RPC 24 Simon Thorley QC, sitting as the Appointed Person, said:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning MR in *Associated Leisure v Associated Newspapers* [1970] 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1878) 7 Ch D 473 at 489). In my judgment precisely the same considerations apply to an allegation of bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.”

34. On the basis of the ground as pleaded the applicant has no case to answer. The papers placed before me do not indicate that there has been any request to amend the pleadings to deal with any other basis of attack. Furthermore, it is not properly explained what the implications of any irregularities in cross-shareholdings or the March Racing registration are (if any) for these proceedings. The objection under Section 3(6) fails.

Section 5(2)(b)

35. This reads:

“(2) A trade mark shall not be registered if because –

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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, which includes the likelihood of association with the earlier trade mark.”

36. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods that cumulatively, lead to a likelihood of confusion. The leading guidance from the European Court of Justice is contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

37. As noted about the opponent relies on eight registrations some of which would be subject to the requirement to show proof of use under the Trade Marks (Proof of Use, etc) Regulations 2004. However, it is reasonably clear that the opponent’s best chance of success rests on registration No 770479, FORMULA 1, covering some 10 classes. The opponent’s other registrations for the most part consist of more stylised marks and/or marks with other matter that puts more distance between them and the application in suit. If the opponent does not succeed on the basis of No 770479 then it can be no better placed on the basis of its other registrations. No 770479 has a filing date of 5 March 1998 but was not registered until 20 February 2006. On that basis it is not caught by the Proof of Use provisions.

38. I reproduce below the applied for specification of goods and services and set against it relevant classes (only) of the specification of No 770479. Within the latter the goods and services in bold text are most relevant for comparison purposes.

Applicant’s	Opponent’s
Class 9: Photographic, cinematographic computer software and games relating to transmitting and reproducing the sound and images of motor vehicles, racing cars, motor cycles and land, sea and air locomotives.	Class 9: Clothing, footwear, headgear, helmets, gloves, belts, goggles, all of a protective nature; luminous and mechanical signs and signposts; anti-glare screens; sun glasses and spectacles; cords, frames, lenses and cases for use with spectacles, sunglasses and optical; apparatus for anti-

	<p>theft; alarm and security systems; remote locking apparatus; electrical remote control apparatus; personal security apparatus; encoded and magnetic cards; batteries; electric, electronic, scientific, optical, cinematographic, photographic, radio receiving, radio transmitting, intercommunication, telephonic, sound reproducing, sound recording apparatus and instruments; satellite apparatus; computers; computer programs, computer software and hardware; electronic toys, games and playthings; video recorders and video reproducing apparatus; video cassettes, records, tapes and compact discs; video game amusement apparatus; receivers; coin or counter-fed electronic amusement apparatus; teaching and instructional apparatus and instruments; compasses (not for drawing); audio and video recording apparatus and cassettes; compact disc apparatus; digital apparatus and digitisers; books on disks and tapes; films; televisions; photographic apparatus; exposed films; flash bulbs; magnets; pedometers; counting apparatus; speedometers; odometers; calculators; recording apparatus; scoreboard and timing apparatus; binoculars; pre-recorded tapes and discs; electronic games adapted for use with television receivers; computer games; parts and fittings for the aforesaid goods and all other goods in Class 9.</p>
<p>Class 16: Paper, cardboard and goods made from these materials, printed matter, photographs, printed publications.</p>	<p>Class 16: Paper, card, cardboard and goods made thereof; stationery; printed matter; greeting cards; books; almanacs; material and printed matter for advertising signs; calendars; photographs; collector cards; stickers and sticker albums; bumper stickers; trading cards; address books; organisers; writing pads and blocks; route maps; printing, painting and drawing sets; catalogues; maps, plans and charts; posters; instructional and teaching material; artists' materials (other than</p>

	<p>colours or varnish); paintbrushes; easels; playing cards; pictures; stamps; book covers and bindings; portfolios; newspapers; magazines; periodicals; comics; cartoons; publications; manuals; annuals; business papers; albums; autograph books; diaries; scrap books; binders; planners; imitation bank notes; computer documentation; stencils; transfers; gift wrap; party streamers; table linen made of paper; cases, bags, wallets, holders, packaging, badges, mats all of either paper, card or plastic; ornaments of either paper mache or card or plastic; rulers; writing instruments and inks; erasers; plastic bags; wrapping material; portraits; parts and fittings for all the aforesaid goods; all included in Class 16.</p>
<p>Class 25: Clothing, footwear and headgear.</p>	<p>Class 25: Articles of clothing; swim wear; rainwear; sportswear; leisurewear; night wear; ski wear; underwear; track suits; shell suits; overall; coats; mantles; suits; bath robes; polo shirts; hats and headgear; peaks; visors; baseball caps; neckwear; scarves; gloves; belts; braces; boots, ski boots, gaiters and cases for same; shoes, socks; sweatbands and wristbands; footwear for sports; parts and fittings for all the aforesaid goods; and all other goods in Class 25.</p>
<p>Class 35: Advertising; business management; business administration; office functions; all of the aforesaid relating to the creation of sporting and motoring teams.</p>	<p>Class 35: Computerised business information storage and retrieval; display services for merchandising; compiling and disseminating advertising matter; production of advertising matter; providing home or office shopping and ordering services via computer and/or interactive communications technologies in the fields of sports related equipment, clothing, games and playthings, memorabilia, printed goods and books, computer software, on-line pay per view and interactive subscription services and general merchandise.</p>

39. There is considerable and near complete overlap in the respective specifications (taking the highlighted parts of the opponent's specification). No additional comment is called for in relation to the specifications in Classes 16 and 25 where the same terms appear. Some comment is necessary in relation to the other classes.

40. The applicant's Class 9 specification is curiously worded. I am not clear for instance what '...sea and air locomotives' are. However, it is clear that the specification is based in general terms on computer software and games for the designated purposes. For practical purposes any such software and games must be encompassed by the terms 'computer software' and 'computer games' (as well as other items) in the opponent's specification. They must be identical goods or to put the matter another way the applicant's goods must be a sub-set of the opponent's goods.

41. So far as Class 35 is concerned the applicant's 'advertising' services must be the same as 'compiling and disseminating advertising matter; production of advertising matter'. 'Business management; business administration; office functions' is specified as being 'relating to the creation of sporting and motoring teams'. The opponent's specification covers 'computerised business information storage and retrieval' and 'providing ... office ... ordering services ... in the fields of sports related equipment'. The opponent's services are particular examples of the sort of business and office services for which the applicant is seeking coverage. If they are not identical they are highly similar in terms of the standard test in the *Canon* case.

42. Turning to the marks the standard comparison requires me to consider visual, aural and conceptual similarities. The earlier trade mark consists of the word and numeral FORMULA 1. The applied for mark is MARCH FORMULA ONE. The marks share the same idea created by the words, or word and numeral, FORMULA ONE and FORMULA 1. The word ONE and numeral 1 are interchangeable. The different visual impact of using a word instead of a numeral is more than offset by the conceptual and phonetic identity of the combinations. The principal difference between the marks is, therefore the presence of the word MARCH in the applied for mark. It is the first and a prominent element in the mark but it does not reduce FORMULA ONE to insignificance. The latter remains a strong point of similarity.

43. The issue that seems to me to be at the heart of this case is the distinctive character of the opponent's earlier trade mark. To reach a view on this I need to revert to the evidence that has been filed by Ms Heavey. Two aspects of the evidence present difficulties. Firstly, certain parts of the evidence raise concerns about the nature of the usage of FORMULA 1 in particular as to whether it is simply the name of the sport or a brand. Secondly, as I have already mentioned, the evidence conflates use of a number of the marks relied on by the opponent in a way that makes it more difficult to resolve questions as to the nature and character of the word and numeral FORMULA 1. I am thinking particularly of the use of the combination within and as part of the FIA and F1 logo marks.

44. A number of the usages of FORMULA 1 in Ms Heavey's evidence suggest to me that the word and numeral are being used to identify the name of a particular type of motor sport rather than as an indicator of trade origin. A prime example of this is the material from the www.telegraph.co.uk website at Exhibit 8 containing reports on

sporting events. A side panel on the front pages gives the viewer the opportunity to select from a choice of sports e.g. football, cricket, rugby union and so on. Included in this list is Formula One (it is presented in word form rather than word and numeral). The message that this conveys in the context and manner in which it is presented strongly suggests that Formula One is a generic name for a particular sport. Other material such as the use of FORMULA 1 on the computer game covers (Exhibit 14), the licensed videos (Exhibit 19) and the magazine covers (Exhibit 25) are at best ambiguous as to the nature of the usage.

45. Nevertheless I must consider the totality of the evidence. It is in my view a fair reading of the evidence to say that the mark/logo that is most consistently used is the F1 stylised logo (of eg No 3429306). It is true that the word and numeral FORMULA 1 form a part of that mark but that is not conclusive as to the nature or distinctive character of the usage. The stylised F1 is the dominant and distinctive element of the mark and there is room for debate as to the significance of the subtext FORMULA 1.

46. I have not found this an easy matter to resolve. The only evidence available to me is that supplied by the opponent and the applicant has not taken an active part in proceedings after the filing of the counterstatement save for very brief written submissions claiming that “formula 1 is relating to the nature of this company and the cars that it used to race”. I do not, therefore have the benefit of any countervailing evidence or detailed submissions on this important point. With some hesitation I have decided there is just sufficient in the material before me to reach the view that FORMULA 1 is distinctive of the opponent. In coming to this view I have taken into account:

- the intent evidenced in the Group design guidelines which identify FORMULA ONE/1 as trade marks of the group (see Exhibit 4).
- the fact that some usages of the F1 logo show a TM symbol against the element FORMULA 1 within the composite mark (Exhibits 5, 7, 8, 14, 17 etc) though this cannot in itself be determinative.
- FORMULA 1 is in some cases a stand alone mark identified by TM consistent with the group design guidelines (Exhibits 12 and 13).
- FORMULA 1 is used in conjunction with the names of the various racing teams eg BENETTON FORMULA 1 (Exhibit 6). This point might have told against the opponent and pointed to descriptive usage were it not for the fact that Ms Heavey’s evidence makes it clear that “the Opponent’s Group has licensed since as early as 1998 each of the teams to use FORMULA1/ONE” (paragraph 20). Race promoters also use the mark under licence (paragraph 16). No examples of such licenses are exhibited but Ms Heavey’s evidence stands unchallenged on the point.
- Exhibits 39 and 40 contains requests from third parties in relation to the opponent’s marks. The correspondence and e-mails refer variously to the logo marks, F1 and FORMULA ONE. The correspondents either see the commercial potential of a link with the opponent’s group

or seek permission to use the opponent's marks under licence. The relevance of this material is that it gives an indication as to how third parties approach and perceive the mark. A significant number appear to be of the unprompted view that the opponent's permission is needed to use the marks in question. A significant number refer to FORMULA ONE/1.

- I have not given weight to Exhibit 44, the letter from a former March director seeking to persuade the applicant to withdraw the application. The letter was initiated following contact from Bernie Ecclestone's office and the writer does not explain the basis for his views. I consider that the letter must be treated with some caution. It was clearly generated as a result of knowledge of this application. The writer has not filed evidence as such and could not have been cross-examined.

47. I, therefore, proceed on the basis that FORMULA ONE is distinctive in relation to the opponent's business of organising motor racing events and the goods and services most closely associated with it. I also bear in mind that the mark is in any case inherently distinctive in relation to certain items (paper and cardboard for instance to take an example from the goods and services in conflict).

48. Key guidance on how to approach issues of similarity involving composite signs can be found in the ECJ's judgment in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 where it was held that:

“29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject

to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

49. If I understand the applicant’s position correctly it is that MARCH is the name of a former racing team. The applicant has not commented on the words FORMULA ONE beyond the brief reference in the written submissions referred to above. It is in my view an independent element of the applied for mark and one which is similar to a high degree to the opponent’s mark. The presence of the word MARCH as the first element reduces but does not displace that similarity when the marks are considered as wholes. I do not, however, accept the opponent’s submission that its case is assisted by the fact that the first event of the season is held in March. The motor racing events in relation to which the opponent’s marks are used are usually known or referred to by the name of the country in which they are being held (e.g. the British Grand Prix). The mere fact that the first event of the year is or may be held in March does not mean that it is known or referred to in a way that increases the likelihood of confusion in some way.

50. As noted in the extract from the *Medion* case quoted above a finding of a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark. *Medion* recognises that the overall impression may lead the public to believe that the goods and services derive, at the very least, from companies which are economically linked. The same would be the case if the relevant consumer group (the general public and businesses) considered that the presence of the element FORMULA ONE in the mark MARCH FORMULA ONE pointed to a trade link or licensing arrangement with the opponent’s group. The evidence here is to the effect that the opponent exercises close control over the sport and the use of its marks. Merchandising is an important part of the business. The opponent says that it licences use of the mark FORMULA ONE/1. In all the circumstances of the case I find that there is a likelihood of confusion on the part of the public if the applicant’s mark was to be registered and used for the goods and services applied for. The relevant public would assume that the presence of the words FORMULA ONE was an indication that the mark was being used under licence from the opponent’s group. The opponent’s case is made out under Section 5(2)(b).

51. In the light of the above finding it is not necessary to consider the opponent’s further grounds of objection.

COSTS





52. The opponent has been successful and is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of **£1200**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of September 2007

**M Reynolds
For the Registrar
The Comptroller-General**

ANNEX

Opponent's Marks

No.	Mark	Classes
1530560 (UK)		16
2144749 (UK)		4, 12, 36, 38 and 42
3429396 (CTM)		1,3,7,8,11,12,14,18,21,29,30,32,33,34,35,36,39,42 and 43
770479 (CTM)	FORMULA 1	4,9,16,18,25,28,35,38,41 and 42
604801 (CTM)		14,16,25,28,30,41 and 42
554873 (CTM)	FORMULA 1	9
631531 (CTM)		4,9,16,18,25,28,38 and 41

631747
(CTM)



4,9,16,18,25,38 and 41