



Archive

Channel

Formula One succeeds where others failed: establishing that its mark is famous Examination/opposition
National procedures

Canada - Powell Trade Mark Services

October 25 2011

In *Formula One Licensing BV v Formula 1 Emporium Inc* (2011 TMOB 124), Formula One Licensing BV has successfully established that its mark F1 had acquired the notoriety to be considered a famous trademark and should be awarded a broader scope of protection. Canada does not recognise 'famous' trademarks, so why did Formula One succeed where others failed?

Subsection 6(5)(a to e) of the **Trademarks Act** states:

"6(5)... in determining whether trademarks... are confusing,... the registrar... shall have regard to all the surrounding circumstances, including:

- (a) the inherent distinctiveness of the trademarks... and the extent to which they have become known;*
- (b) the length of time the trademarks... have been in use;*
- (c) the nature of the wares, services or businesses;*
- (d) the nature of the trade; and*
- (e) the degree of resemblance between the trademarks... in appearance or sound or in the ideas suggested by them."*

Subsection 15 of the act allows registration of confusingly similar marks as long as the applicant is the owner of all such marks. The trademark register will reflect each registration and application as being 'associated'. Generally, associated marks, or a family of marks, are provided a broad scope of protection on the presumption that the owner has gained distinctiveness in the marketplace through use of its multiple marks.

In *Mattel Inc v 3894207 Canada Inc* ([2006] 1 SCR 772), Mr Justice Binnie made the following statement with respect to famous trademarks:

"The relevant point about famous marks is that fame is capable of carrying the mark

across product lines where lesser marks would be circumscribed to their traditional wares or services.”

Formula 1 Emporium Inc applied for the trademark F1EMPORIUM covering stationary and printed publications and operation of retail services dealing in automotive racing collectibles.

Formula One owns several registrations incorporating the elements 'F1' and 'Formula 1' covering entertainment services in the field of promoting automobile racing events (family of marks). Formula One has organised the motor racing series known as 'The Championship' since 1980 using its family of marks. Additionally, it has organised and promoted the Grand Prix of Canada automobile-racing event in Montreal since 1982 using its family of marks.

The registrar had several grounds to consider in this opposition proceeding, including Formula One's claim that the applicant was not entitled to the registration of the mark F1EMPORIUM, as it was confusingly similar with its family of marks.

The initial onus was on Formula One to establish that its family of marks had been used in Canada as of the applicant's date of first use claimed in the application (March 2000), and that the mark F1EMPORIUM was confusing with its family of marks. The applicant had the burden of establishing that use of the mark in association with its goods and services would not cause confusion in the marketplace.

Formula One showed that the motor racing events it organised and promoted using its family of marks reached both international and national audiences through various media channels, including radio, television, printed and electronic publications and videos. Formula One established that, in the year 2000, the date of first use claimed by the applicant, the television audience for The Championship races was in excess of 11 million people in Canada and 5.95 billion people globally. In addition to this evidence, Formula One provided extensive information regarding its advertising and marketing campaigns using its family of marks in Canada.

The applicant claimed that the element 'F1' was widely used and had become generic within the automobile racing industry. It submitted evidence showing five Canadian trademark registrations that incorporated the element 'F1', each owned by a different entity, inferring that consumers are accustomed to seeing the element 'F1' in association with automobile racing goods and services. The registrar held that five registrations were insufficient to make such inference.

The registrar found that, while the term 'F1' is not an inherently strong mark, Formula One's evidence showed that it has acquired sufficient distinctiveness to become a famous

trademark. In finding the common element 'F1' to be famous to Formula One, it warranted a broad scope of protection in relation to all things automotive.

The registrar held that the applicant was not entitled to the registration of its mark, as it was confusingly similar to Formula One's family of marks, given that the common component 'F1' was identical visually, phonetically and in suggested meaning. Furthermore, the nature of the goods and services and channels of trade were overlapping.

While the trademarks BARBIE and THE PINK PANTHER have failed to be awarded a fame that warranted protection across product lines, Formula One succeeded in establishing its fame through extensive evidence. The key being the common interest of both parties, automotive racing events and products.

This decision is currently pending appeal.

Jennifer Powell, Powell Trade Mark Services, Vancouver

© Copyright 2003-2011 **Globe Business Publishing Ltd**