TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2180339
TO REGISTER A TRADE MARK IN THE NAME OF
CHANNEL F1 LIMITED
IN CLASSES 3, 4, 9, 14, 16, 18, 25, 28, 32, 35, 38, 41& 42

AND IN THE MATTER OF OPPOSITION THERETO
UNDER No 50355
BY FORMULA ONE LICENSING B.V. AND FORMULA ONE ADMINISTRATION LIMITED

BACKGROUND

1) On 16 December 1998 Channel F1 Limited of 9 Bradbrook House, Studio Place, Belgravia, London, SW1X 8EL applied under the Trade Marks Act 1994 to register the trade mark:

2) In respect of the following goods:

In Class 3: Cleaning, polishing, scouring and abrasive preparations; all for motor land vehicles; soaps; perfumery; essential oils; cosmetics preparations; hair lotions; body sprays; anti-perspirants; deodorants; cosmetic preparations for skin care; perfumes; perfumeries; eau-de cologne; after shaving preparations; pre-electric shaving preparations.

In Class 4: Industrial oils and greases; lubricants; fuels (including motor spirit); illuminants; candles; wicks; dust absorbing, wetting and binding compositions.

In Class 9: Coin or counter-fed electronic amusement apparatus; compasses (not for drawing); audio and video recording apparatus and cassettes; digital apparatus and digitizers; compact disc apparatus; compact discs and tapes; books or disc; flash apparatus; film; television; video recorders and video reproducing apparatus; records; video game amusement apparatus; receivers; teaching and instrumental apparatus and instruments; electrical remote control apparatus; personal security apparatus; radio receiving, radio transmitting, intercommunication telephonic, sound reproducing, and sound recording apparatus and instruments; computers; magnetic and encoded cards; computer programs; computer software; computer hardware; magnets; electronic games for television receivers; computer games; batteries; scientific, optical,

cinematographic and photographic apparatus and instruments; luminous and mechanical signs; anti glare screens; clothing, footwear, headgear, helmets, gloves, belts and goggles, all for protection; sunglasses and spectacles; frames, lenses, spectacle cases and optical lens cases; security system alarms; anti-theft apparatus and remote locking apparatus; counting apparatus; pedometers, speedometers; odometers; calculators; recording apparatus; scoreboard and timing apparatus; binoculars, CD ROMS; mini disks; discs.

In Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

In Class 16: Computer manuals; organisers; writing pads; writing blocks; printing, painting and drawing sets; business forms; albums; autograph books; diaries; books; almanacs; calendars; photographs; collector cards; stickers and sticker albums; bumper stickers, scrapbooks; binders; planners; stencils; transfers; writing instruments; writing inks; pencils; pens; erasers; portraits; plastic bags; gift wrap; wrapping material; packaging materials; party streamers; table covers made of paper; mats made of paper card or plastic; ornaments made of papier mache card or plastic; badges; paper, card, cardboard and goods made thereof; stationery; printed matter; cards; greeting cards; trading cards; address books; book covers and bindings; portfolios; newspapers; magazines; periodicals; comics; cartoons; publications; annuals; manuals; stamps; pictures; playing cards; easels; paint brushes and artists materials; posters; catalogues; charts; maps; plans; instructional and teaching materials; route maps and guides.

In Class 18: Bags; cases; luggage; holdalls; trunks; back packs; travelling bags; belt bags; sports bags; school bags; attache cases; shoulder bags; briefcases; all made of leather or imitation leather; writing set cases; wallets; holders; book covers; key fobs all made of leather or imitation leather; and articles made from leather or imitation leather; handbags; purses; umbrellas; parasols; walking sticks; portfolios; carrier bags or cases for articles of clothing.

In Class 25: Articles of clothing; peaks; visors; baseball caps; caps; hats; neckwear; ties; scarves; cravats; bow ties; gloves; mittens; belts; gaiters; braces; socks; stockings; pantihose; suits; shirts; blouses; T-shirts; sweatshirts; trousers; skirts; dresses; articles of fancy dress; jackets; overalls; waistcoats; dressing gowns; bath robes; articles of sports clothing; sleeping garments; pyjamas; aprons; jeans; swimwear; footwear; shoes; boots; ski boots; swimwear; caps; rainwear; sportswear; leisurewear; ski wear; underwear; track suits; shell suits; coats; mantles; polo shirts; headgear; sweatbands; wrist-bands; sports shoes and sports boots; footwear for sports.

In Class 28:Ornaments and decorations for Christmas trees; balloons, and party hats; party streamers; games, toys and playthings; electronic games; sports equipment and sporting articles.

In Class 32:Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices syrups and other preparations for making beverages.

In Class 35: Computerised business information storage and retrieval; display services for merchandising; compiling and disseminating advertising matter; production of advertising matter.

In Class 38:Electronic transmission of data, images and sound via computer terminal and networks including the Internet and via Extranets and Intranets; telecommunications services; radio and television broadcasting via the digital networks including the Internet and interactive services relating thereto; radio, television broadcasting and satellite and cable broadcasting.

In Class 41: The provision of education, entertainment and training all relating to sporting and cultural activities.

In Class 42: Providing access to databases and interactive computer databases in the field of sport; providing access to home ordering services via computer and/or interactive communications including digital television and the Internet; providing access to computer bulletin boards and real time chat forums in the field of sports; travel agency services for booking accommodation; rental of rooms; photographic services all provided by means of computer databases, web pages, by pay per view or digital television.

3) Opposition to the registration was jointly filed by Formula One Licensing B.V. (hereinafter the first opponent and/or FOL) of Koningin Emmaplein 13, P O Box 23038, 3001 KA Rotterdam, The Netherlands, and Formula One Administration Limited (hereinafter the second opponent and/or FOA) of 14 / 16 great Portland Street, London, W1N 6BL. on 28 October 1999. The grounds of opposition are in summary:

a) The first opponent is the proprietor of the actual and pending UK registrations and Community Trade Mark Registrations set out in Annex A

b) The second opponent is the "commercial rights holder" and organiser of the FIA Formula One World Championship (FOWC) and certain fundamental commercial and administrative arrangements for the staging of the FOWC are undertaken by the second opponent including, without limitation, all broadcasting and other media exploitation and licensing globally. The second opponent is licensed by the first opponent to use commercially the marks set out in annex A together with unregistered marks.

c) The opponents have by virtue of their trading activity acquired substantial goodwill and reputation in the trade marks at annex A, and also in the unregistered marks "Formula 1" and "F1". It is claimed that because of the usage made that the marks "FIA FORMULA ONE WORLD CHAMPIONSHIP plus device", "F1 FORMULA 1 plus device", "FORMULA 1", "FORMULA ONE" and "F1" are well known marks in accordance with Article 6bis of the Paris Convention.

d) The mark in suit contains the letter and numeral "F1" which is identical or similar to a number of the opponents' marks.

e) The mark in suit is intended to indicate, inter alia, a "channel" or medium through which coverage of the FOWC is to be conveyed. The public is aware of the control extended by those responsible for the organisation and commercial exploitation of the FOWC. The opponents submit that the public will believe that the goods and services supplied under the mark in suit are associated with or licensed by the opponents.

f) By reason of the above the opponents contend that the mark in suit offends against Sections 3(1)(b), 3(1)(c), 3(3)(b), 5(1), 5(2), 5(3) & 5(4) of the Trade Marks Act 1994.

g) The opponents also claim that the mark in suit offends against Section 3(6) in two ways. The relevant paragraphs are reproduced below:

> "12. Further or in the alternative, by reason of the above [*similarity of mark / goods / services / reputation etc]*, the trade mark sought to be registered is contrary to section 3(6) of the Act in that it was applied for in bad faith."
>
> "13. Further or in the alternative, by reason of the above, the trade mark sought to be registered is contrary to Section 3(6) as it is not intended to be used on all of the goods and in connection with all of the services as specified in the application."

4) The applicant filed a counterstatement denying the grounds under 3(1)(b), 3(1)(c), 3(3)(b), 5(1), 5(2), 5(3) and 5(4). In relation to the 3(6) allegations the applicant stated:

> "9.1. The objections raised under the various subsections of Section 3 should be dismissed. The contents of paragraphs 9,10,11 and 12 of the Notice of opposition are denied."
>
> "10.1 No admission is made as to the content nor relevance of paragraph 13 in the Notice of opposition. Without prejudice to the generality hereof, the opponent is not in a position to speak as to the intentions of the applicant."
>
> "10.2 Further or in the alternative Section 3(6) of the Act does not prohibit registration of a trade mark in the circumstances propounded by the opponents. In particular, Section 3(6) of the Act puts no obligation on an applicant to have an intention to use a mark at the date of application or at all."

5) Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 20 February 2002, when the applicant was represented by Mr Hooley of Messrs Philip Hooley while the opponents were represented by Mr Mellor of Counsel instructed by Messrs McDermott Will & Emery.

OPPONENTS EVIDENCE

6) The opponents filed a declaration, dated 9 May 2000, by Nicholas Duncan Couchman the

opponents Trade Mark Attorney. Mr Couchman states that he has access to the books and records of the opponents.

7) In his declaration and exhibits Mr Couchman provides a huge amount of information regarding the history of motor racing from its inception to its subsequent organisation into a series of races or Grand Prix known under the title of the Federation Internationale de l'Automobile (FIA) Formula One World Championship. He uses the shorthand version of "Formula One" to describe this series of races. He describes how, since 1950 the series has been built up so that it consists of sixteen or seventeen races which occur in fifteen countries spread across four continents. The series attracts approximately three million spectators annually and in addition is watched on television by approximately 39 billion people in over 200 countries.

8) Mr Couchman also provides details of the rules and regulations governing the participants and also the promoters of each race. In all his comments he makes it clear that the sport is highly regulated and closely governed. He instances that all journalists are required to sign an agreement which assigns "all and any copyright in any sound and moving picture footage recorded within the confines of an event and a recognition of FOL's rights in the Formula One Marks."

9) Mr Couchman details of the world wide trade mark registrations held by the opponents. He also provides details of the control of these marks including a copy of the "logo usage manuals issued by and on behalf of the opponents, although this does not appear to be dated. He submits that use of the "Formula One Device Marks and/or the Formula One Word marks and/or the Formula One Championship Title Marks in any context which connotes, suggests or refers to motor racing clearly refers to and will be taken by consumers to refer to the FIA Formula One World Championship and/or activity connected with and/or authorised by the organisers thereof". At exhibit NDC11 he provides a non-exhaustive list of licensed products which have been authorised by the opponents and copies of packaging of the relevant products. It is pointed out that the applicant advertises certain of these authorised products on its website, a print out at exhibit NDC18 shows this to be true. The products listed are mostly computer games or equipment for the playing of such games, and video tapes. Most of the packaging is undated, but all of the items are clearly and prominently marked with the opponents' trade mark number 2144749, which consists of a logo made up of the highly stylised letters "FIA" and the words "FORMULA 1 WORLD CHAMPIONSHIP".

10) Mr Couchman points out that most of the games are actually based on the FIA Formula One World Championship, featuring the circuits, drivers and teams from the championship. At exhibit NDC12 &13 he provides a list of licence agreements "in relation to (inter alia) the FIA Logo". These cover items such as clothing, electronic games, keyrings, postcards, binoculars, car accessories, bags, umbrellas, books, towels, and flags. At exhibit NDC 14 is provided a list of payments from licensees in relation to use of the FIA Logo and/ or the F1 Formula 1 and device marks, both solus and in combination with the names of teams, drivers and circuits. The goods covered Classes 14,18, 24, 25 and 28 in the UK. The total payments shown for the period December 95- July 96 on clothing is approximately US$440,000. It is not clear what period these licence payments cover. Further exhibits at NDC 15 and 16 show a range of products all of which appear to carry the opponents' trade mark 2144749 either as a neck

label, or on the outside of hats.

11) Mr Couchman states that:

> "The opponents do not seek to enforce their trademarks against third parties making use thereof where such use relates solely to bona fide journalistic, editorial or publishing use. The Championship and the sport of racing Formula 1 (or "F1") cars are very high profile media events and are naturally covered and reported upon by a very substantial range of media including newspapers, magazines, books and Internet websites. In the ordinary course of events, and in the absence of other commercial exploitation by such entities, references to "Formula 1" or "F1" in the context of such publications do not constitute trademark use nor usage which would otherwise infringe upon the opponents' rights."

APPLICANT'S EVIDENCE

12) The applicant filed a declaration, dated 9 November 2000, by Phillip William Hooley, the applicant's solicitor. He states that he has represented the applicant since 1997 and has full access to the applicant's records.

13) Mr Hooley states that the applicant company was set up in March 1997 with the purpose of providing Formula One motor racing fans with a complete service in terms of journalistic reporting of Formula One motor racing on the Internet. This medium provides a faster service than traditional magazines and newspapers. The business also offers fans the opportunity to purchase souvenirs, all of which are licensed where relevant.

14) Information regarding the weather and also betting odds is also provided. Mr Hooley states that by the provision of an electronic magazine and other related services the applicant will build its goodwill in its trade marks in the same manner as traditional magazines.

15) Mr Hooley points out that the FIA is not the ultimate administrative and regulatory body for all motor sport as it claims. There are many motor racing series which take place outwith the jurisdiction of the FIA, Mr Hooley instances NASCAR, The Indy Racing League and others. He also points out that a chequered flag is used in virtually every motor racing series and virtually all motor racing series have highly detailed rules and regulations which participants must adhere to.

16) Mr Hooley also claims that the term "Formula One" is used in other sports such as powerboat racing and triathlon. This, he claims, is why the opponent claims the right to exploit the commercial rights to the "FIA Formula One World Championship". Mr Hooley raises issues surrounding the agreement between the FIA and a subsidiary of FOA appertaining to competition law, but this is not an issue before the Registrar.

17) Mr Hooley also provides at exhibit 1 a copy of a World Intellectual Property Organisation (WIPO) decision regarding the domain name "F1.com" where the one of the panellists commented "there is an inherent difficulty, when a term which describes the nature of a sport

is taken over by the organisers of events in order to give them a brand image, that the public will partly continue to use the term to describe the sport in general. This makes it difficult to establish how far, as a mark, the term has become famous." However, a decision of WIPO regarding a domain name dispute is not something which can be decisive before the Registrar.

18) Mr Hooley claims that the teams and promoters participating in the FIA championship have various media and trade mark rights, only some of which they cede to the opponents. Mr Hooley claims that his company is merely offering the same service as any newspaper or motoring magazine in informing the public as to the results of all aspects of a weekends race.

19) Mr Hooley claims:

> "The term used to describe the sport is the generic term Formula 1 or Formula One. In context the term F1 is referred to for this sport, but in general conversation or writing simply referring to F1 would not necessarily be linked to the sport. The terms Formula 1 or Formula One are nevertheless generic terms, which were used to describe the sport before the FIA chose to organise a World Championship and decades before the advent of the FOA, FOL or any commercial promotion and exploitation of the sport."

20) Mr Hooley also states that there is no sport of motor racing in the same way that there is a sport of football or tennis. The term motor racing is simply a term to describe an activity with no standard rules, one has to further define the branch of motor sport such as Formula One, CART, drag racing etc. He then proceeds to provide a very detailed history of motor racing with particular reference to Formula One. This is provided to show that over the years the basic rules governing the Championship have changed dramatically in addition to the cars. He also claims that the name Formula One came into being prior to the use made by the FIA. He refers to numerous books on the subject of racing which state that Formula One came into being in 1948 prior to the start of the FIA World Championship in 1950.

21) Examples of other sports using the term F1 and also other uses of the term are provided at exhibits 9-12. These include the sports of power boats and triathlon, and companies offering items such as exhausts for motor bikes, guitar plectrums, computers and cameras. All the items have the term F1 in their name.

22) Lastly, Mr Hooley states at paragraph 58:

> "The Applicant simply wishes to register CHF1, which it has been using as a trade mark commercially since 1997, and to expand its use of that trade mark in its various commercial interests. There is no intent to deceive the general public. No suggestion is made that the company is in some way authorised by the FIA or the FOA. Indeed the popularity of the site and the potential exploitation of the brand in many ways depends on not being associated with the FIA or the FOA."

OPPONENTS EVIDENCE IN REPLY

23) The opponents provided a witness statement, dated 18 April 2001, by Kathleen D Harris the opponents' solicitor. She states:

> "In the context of motor racing or anything to do with or associated with motor racing "Grand Prix" is also regarded by the public as synonymous with Formula One, so that Grand Prix in the context of motor racing has the same connotation to the public as Formula One or F1. Therefore, it follows that where the context is motor racing, the Formula One marks include Grand Prix."

24) Ms Harris states that "Formula One is only a sport for two hours every other Sunday for 8 months of the year. At all times it is a business." She also claims that "Formula One is the brand name that describes the spectacle that is Grand Prix motor racing and the products, services and goods which are associated with it." She also claims that because of its global reputation that "this is a brand of brands; a brand by and with which other brands are promoted and one which the applicant is clearly trying to take unfair advantage of by seeking to register a mark so clearly associated in both the look and feel and in nature of the goods and services to those marks and goods/services already registered to the opponents."

25) Ms Harris provides a lot of detail about the technologies used in Formula One racing and the manner in which the teams and drivers deport themselves. She states that "As a certificate of origin for motor racing the Formula One marks are and have been for over twenty years the trademark for the races held under the FIA regulations for this class of racing and organised and executed by the Formula One undertaking."

26) At exhibit KDH2 Ms Harris provides a decision from OHIM which she states shows that F1 is distinctive of the opponents goods and services. She also provides at exhibit KDH3-5 copies of newspaper reports about "F1", print outs of television footage from ITV which shows use of the term F1 and advertisements for various products where the term F1 is used according to Ms Harris "to mean one thing and one thing only, the Formula One undertaking and the Championship".

27) That concludes my review of the evidence. I now turn to the decision.

DECISION

28) At the hearing Mr Mellor withdrew the grounds of opposition under Sections 3(1)(b), 3(1)(c) and 3(3)(b).

29) I first turn to the grounds of opposition under Sections 5(1),5(2), 5(3) & 5(4) of the Act which state:

> "5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the

goods or services for which the earlier trade mark is protected.

(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.

(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration."

30) An earlier trade mark is defined in Section 6 which states:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) 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 entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include 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 subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry."

31) The opponents have identified six earlier trade marks which they regard as providing them with their strongest case. For ease of reference these are reproduced below together with the specifications shown by Class (full details are at annex A).

Trade Mark	Number	Specification
	1565428	18
	1565429	25
	2144871A	9,12,16,28,35,38 & 41
	2144871B	4
FORMULA 1	CTM 554873	9
	CTM 770479	4,9,16,18,25,28,35,38,41 & 42

Evidence of use

32) I will deal with the evidence provided by the opponents first as this affects matters that are to be considered under all three heads of opposition.

33) I have to consider the issues before me as of the relevant date, which is the date of the

filing for registration, 22 October 1998. The opponents have to demonstrate that they had a valid case at this date.

34) The opponents claim that they have reputation in their earlier marks and also that "F1", "Formula One" and "Formula 1" are "well known marks" and are thus themselves "earlier trade marks". The opponents' evidence places great emphasis on the fact that the motor racing series they organise is highly regulated and closely governed. Use of the opponents' trade marks are also subject to a welter of restrictions as to size, positioning etc particularly on the items of clothing worn by the members of the various teams competing in the championship. In relation to the motor racing series the evidence shows use of marks 2144749 and 2144871 only. Mr Mellor attempted to extend this use to what he termed as the "fundamental activities associated with the racing series, and that is the transmission of data, the provision of entertainment, television broadcasting." The only evidence shown of television coverage is that by ITV which has as part of its "studio backdrop" the F1 logo from registration 2144871.

35) The opponents have provided evidence that licence agreements exist for products in Classes 14,18,24,25 & 28 in the UK. Some evidence is shown of licence payments. For example a large number of licence payments, totalling approximately US$440,000, are shown as being received during the period December 1995 - July 1996 inclusive. The exhibit shows these payments being in relation to various goods in Class 25. Although the licensing figures are said to relate to a number of the opponents' marks the evidence provided shows use, almost exclusively, of the trade mark 2144749, the FIA logo described earlier.

Effect of evidence under Section 5(2)(b)

36) As per *Sabel BV v. Puma AG* [1998] RPC 199 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc.* [1999] RPC 117 the reputation of a trade mark has to be taken into account in the global appreciation of likelihood of confusion. In *Sabel* the European Court of Justice (ECJ) held that:

> "In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact the two marks use images with analogous semantic content may give rise to a likelihood of confusion whee the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public."

37) In *Canon* the ECJ held that:

> "The distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion."

38) Consequently, the reputation of a trade mark can assist where it is not particularly distinctive or where there is a low degree of similarity between the respective goods or

services.

39) The opponents' evidence is mainly directed towards establishing the level of control they exert over the motor racing series including how their trade marks are used. Although in their evidence the opponents list a number of licensing agreements and show some licence payments, these are not put into context. For example a large number of licence payments, totalling approximately US$440,000, are shown as being received during the period December 1995 - July 1996 inclusive. The exhibit shows these payments being in relation to various goods in Class 25. However, it is not clear if these payments relate solely to this period or if payments are made annually and merely happen to fall due in this time. Whilst the country is specified it is not clear if this is the country of origin of the licensee or where the licence is valid. Even if I were to accept that the sales shown were all made in the period shown and in the UK it is not possible extrapolate the sales figures, nor are these figures put into context in terms of volume, market penetration etc. What evidence of use is provided relates, almost exclusively, to trade mark 2144749. Regarding the television coverage of the motor racing series to my mind any reputation as a broadcaster of sporting events such as the Formula One Championship would belong to the broadcasting company not the provider of the event being broadcast.

40) The fundamental question is whether as a result of such sales and publicity the terms "F1", "Formula One" and "Formula 1" have a reputation in a trade mark sense. The opponents have filed no independent evidence to assist their case. There is no doubt that these terms are well-known as a category of motor racing. If they have acquired a secondary meaning as a brand for motor racing, there is insufficient evidence to conclude that this is now the principal signification, and it is likely that most consumers, particularly outside the immediate field of motor racing enthusiasts, would see them mainly or exclusively as a name of a type of motor sport.

41) The opponents have not provided evidence to show that the public regard the terms FORMULA 1, FORMULA ONE or F1 as trade marks.

42) From the evidence before me I do not consider that the opponents can claim an enhanced reputation based on use. In respect of section 5(2)(b) the issue before me is therefore a simple comparison of the respective trade marks and services on the basis of notional and fair use.

Effect of evidence under Section 5(3)

43) In *General Motors Corporation v. Yplon SA* Case C-375/97 the European Court of Justice established the parameters for claiming a reputation in relation to Section 5(3):

> "Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one

of the countries composing that territory."

44) The applicant's specification is such that "the public concerned" must be regarded as the general public. The opponents have to show that their trade marks are known to a significant part of the public concerned in a substantial part of the United Kingdom. Whilst I accept that a substantial part of the concerned public in the UK will be aware of the Formula One motor racing series they may not be aware of it as a trade mark. The evidence before me does not establish that the terms FORMULA ONE, FORMULA 1 or F1 are viewed as indicators of origin, nor does it establish that the opponents have a reputation in these terms as part of their registered trade marks.

Effect of evidence under Section 5(4)

45) In relation to passing-off the opponents need to establish that at the relevant date, 22 October 1998, they enjoyed goodwill/reputation.

46) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

> "There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see Smith Hayden (OVAX) [1946] 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

47) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing-off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

48) In the instant case the evidence establishes reputation and goodwill under the FIA logo mark for motor racing entertainment and clothing. What the evidence does not establish is that "FORMULA 1" or "F1" are, *per se*, distinctive (as opposed to descriptive) for motor racing services.

Section 5(2)(b) - Likelihood of confusion

49) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 *and Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

50) As is clear from Annex A to this decision the opponents are relying on a number of registrations. At the hearing Mr Mellor attempted to add four further registrations to the case

even though they were not included in the pleading. These registrations have been existence for some time and the opponents gave no reason why they were not included in the original statement of grounds or why no such request had been made during the twenty-eight months between the start of the case and the hearing. I declined to agree to their inclusion in the case.

51) Also at the hearing Mr Mellor identified the earlier marks which provided him with his best case. These are, in relation to the "F1, FORMULA ONE" device trade mark numbers 2144871A, 2144871B, 1565428 and 1565429. In relation to the "Formula 1" mark the trade marks are 770479 and 554873, both of which are Community Trade Marks (CTM).

52) However, trade marks 1565428 and 1565429 both contain disclaimers of the letter and numeral "F1".In a recent case, *Torres v. Torreblanca* [BL 0/207/02], G. Hobbs Q.C. acting as the Appointed Person said:

> "It follows that an objection under section 5(2) cannot succeed in a case where the resemblance between the marks in issue is attributable to nothing more than the presence in the earlier trade mark of an element for which protection has been disclaimed *PACO /PACO LIFE IN COLOUR* trade marks [2000] RPC 451."

53) Therefore, trade marks 1565428 and 1565429 cannot be said to be confusingly similar to the applicant's mark.

54) Applications 2144871B and CTM770479 are still pending and so cannot be relied upon at this stage. This leaves earlier trade marks 2144871A and CTM554873.

Comparison of signs

55) The marks are shown below for ease of reference:

Applicant's mark	Opponent's marks
CHF1 CHANNEL F1	2144871A 
	CTM554873 **FORMULA 1**

56) Mr Mellor contended the following:

- that the applicant's mark "is not CHF1". The F is slanted and the number 1 has a curved top surface similar to that in the opponents' marks.

- "in any appropriate context F1 is understood to be an abbreviation of FORMULA ONE".

- "The CH and CHANNEL elements bring to mind a TV channel or something similar, particularly in the context of the internet."

57) *Sabel* states that "the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details". No evidence was filed as to how the average consumer would view the mark. Whilst I accept that the "F" in the applicant's mark is slanted I do not believe that the average consumer would perceive the mark as anything other than CHF1 CHANEL F1. Nor do I accept that the numeral "1" in the applicant's mark has a curved top surface similar to the opponents' mark and which is distinctive. To my mind the numeral looks unremarkable and is a normal way of depicting the number.

58) I accept that the term F1 could, in an appropriate context, be seen as an abbreviation of FORMULA ONE. However, this is of little significance given my earlier finding that F1 has not been shown to have trade mark significance, even in respect of motor racing. The applicant's mark is not "F1" solus but CHF1 (albeit with a slanted F) CHANNEL F1. No evidence was provided to corroborate the general contention that the CH element of the applicant's mark would bring to the average consumer's mind a TV channel or something similar.

59) I will first compare the mark in suit to the opponents' mark 2144871A. To my mind the distinctive and dominant feature of the opponents' mark is the presentation of the letter numeral "F1" device. I cannot ignore the presence of the word/numeral "Formula 1" underneath but given the relative size compared to the device, it is my opinion that the average consumer would regard the word/numeral combination as being of secondary importance. The applicant's mark would, in my view, be seen as CHF1 CHANNEL F1. Visually the marks differ in their beginnings although I accept that the applicant's mark does contain the letter/numeral combination "F1" which is also found in the opponents mark, but without the "get up" used by the opponent. It is accepted that the public attributes greater importance to the beginning of a mark in identifying a sign than it does to the following components of the mark.

60) The first part of the applicant's mark, CHF1, is clearly not a word and so would, in my view be seen as a letter/numeral combination with each letter being pronounced individually. The last part of the mark is quite clearly the word "CHANNEL" with the letter/numeral combination F1.

61) Conceptually, the average consumer may take note of the presence in the applicant's mark of the letter/numeral combination F1, when seen in use on certain goods or services, and make the connection with the motor racing series. When used on other goods and/or services other connotations will come to mind, or the mark will appear meaningless. When used in relation to television services it is possible that the average consumer might consider the "CH" element to relate to the term "Channel". This is quite likely given that the second part of the mark "Channel F1" could be seen as an explanation of the initial part of the mark. The opponents mark is clearly designed to bring to mind the type of motor racing series known as Formula 1.

However, if Formula 1 indicates a type of motor racing, rather than a trade mark, the reference to it must be unobjectionable.

62) I now move onto comparing the mark in suit to the opponents' mark CTM 554873. The marks are clearly different visually and aurally. Conceptually, the average consumer may take note of the presence in the applicant's mark of the letter/numeral combination F1, when seen in use on certain goods or services, and make the connection with the motor racing series. When used on other goods and/or services other connotations will come to mind, or the mark will appear meaningless, other than when used on television services. The opponents mark is clearly designed to bring to mind the type of motor racing series known as Formula 1. However, if Formula 1 indicates a type of motor racing, rather than a trade mark, the reference to it must be unobjectionable.

Comparison of goods and services

63) Subsequent to the hearing the opponents provided a list of the goods and services, for the marks identified by Mr Mellor as providing the opponents with their strongest case, which they felt were similar or identical to those of the applicant. For ease of reference this list and the applicant's specifications are set out in Annex B. The opponents accept that the goods within the applicant's specification in classes 3, 14 and 32 are dissimilar to any of the goods their earlier registered marks.

64) The European Court of Justice held in *Canon* in relation to the assessment of the similarity of goods and/or services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

65) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

66) Clearly, the goods listed under Class 9 for the opponents' trade mark 554873 are encompassed in the Class 9 goods in the applicant's specification. With regard to the opponents' trade mark 2144871A the goods and services in Classes 9,16,28,35,38, 41 and 42 are identical or very similar with the exception of the following goods which are included in the applicant's Class 28 specification "Ornaments and decorations for Christmas trees; balloons, and party hats; party streamers".

Conclusion

67) In considering whether the average consumer would find the various marks confusingly similar I take into account the similarity of the goods and services, and also whether the goods

and services in question are associated in the consumers mind with motor racing or televisual type goods and/or services. The matter of imperfect recollection must also be taken into account.

68) I first consider the applicant's mark to the opponents' CTM554873. Prima facie the marks are clearly different. The opponents' mark is registered for goods in Class 9 in which I have already found it has no reputation. Therefore, although the applicant's specification includes identical goods there is no likelihood of confusion. The opposition under Section 5(2)(b) fails.

69) I now consider the applicant's mark to the opponents' mark 2144871A. Clearly in relation to goods and services where the initial element "CH" of the applicant's mark has no significance there would be no confusion as the marks are different both visually and aurally and even when used on goods normally connected to the sport of motor racing would only bring to mind only an association with motor racing and not the opponents.

70) However, even when used on services where, because of the presence of the word "CHANNEL" in the mark, the "CH" element of the mark might be taken by the average consumer as a reference to the word "Channel" the mark does not capture the distinctive character of the earlier mark, which in relation to goods and services connected with motor racing, relies upon the presentation of F1 rather than the letter/numeral per se.

71) The ground of opposition under Section 5(2) therefore fails in relation to all goods and services.

72) Earlier in this decision I stated that the opponents could not rely UK Trade Mark 2144871B or CTM770479 as these are still pending. In the light of my findings in relation to the opponents registered marks I must consider whether the opponents would have a stronger case based on its pending marks. The device applied for in Application 2144871B is identical to the device in mark 2144871A but the specification applied for relates only to goods in Class 4. This mark would not be successful under section 5(2)(b).

73) Community Trade Mark 770479 is identical to CTM5548733 in that it is the word/ numeral combination "Formula 1". However, where CTM 554873 has a specification restricted to goods in Class 9, CTM 770479 covers goods and services in Classes 4,9,16,18,25,28,35,38,41 and 42.

74) Clearly in relation to goods and services where the initial element "CH" of the applicant's mark has no significance there would be no confusion as the marks are different both visually and aurally and even when used on goods normally connected to the sport of motor racing would only bring to mind only an association with motor racing and not the opponents.

75) When the applicant's mark is used on services where the "CH" element of the mark may be taken by the average consumer as a reference to the word "Channel" then the prefix CH would not be an effective distinguishing feature. However, the remaining part of the dominant element "F1" is not similar to the opponents' mark as it does not adopt the distinctive presentation or get-up of the opponents' mark. The secondary part of the applicant's mark "CHANNEL F1" would serve either to provide the average consumer with an "explanation" of

the initial part of the applicant's mark, or would bring to mind the sport of motor racing. The opponents would therefore be in no stronger position to launch an opposition based on this mark under Section 5(2)(b) than they are with their current registered marks.

Section 5(3)

76) At the hearing Mr Mellor stated:

> "In relation to section 5(3), obviously I am saying that we have a very significant reputation in the field of motor racing, and so that reputation certainly does support a 5(3) ground based on a mark relating to the organisation of motor racing, and brings it on to the provision of information effectively concerning those motor races, so perhaps when I am doing my table I can also explain precisely the basis for the 5930 case and identify the service where, even if you accept they are not similar, we say the reputation still bites there."

77) In the table provided subsequent to the hearing the opponents contended that the goods and services included in the application in suit were identical or similar to the specifications of their registered marks with the exception of the goods in Classes 3,14 & 32. The opponents made no other observations either at the hearing or in their evidence regarding this ground of opposition.

78) To succeed under this ground the opponents must show that they enjoy a reputation in the earlier right. The onus is on the opponents to establish their claim under this ground. Their failure to support, or enhance, their case with adequate evidence of the trade mark reputation of the FORMULA 1/ FORMULA ONE / F1 signs in relation to even its core activity must mean that its case under this Section must fail. Whether the opponent has a reputation under its FIA logo mark or the stylised F1 device is irrelevant as the applicant's mark is not similar to these marks.

Section 5(4)(a) - Passing off

79) In deciding whether the mark in question "CHF1" offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

> "The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.
>
> A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt &*

Colman Products Ltd - v - Borden Inc [1990] RPC 341 and *Even Warnik BV - v - J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

> The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:
>
> (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
>
> (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
>
> (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

80) To succeed under this ground the opponent must show that it enjoyed goodwill at the relevant date. The relevant date for passing off purposes relates to the commencement of the behaviour complained of. This will normally be the date of the filing of the application. It could be an earlier date if it is shown that the behaviour complained of commenced prior to this.

81) I have found earlier in this decision that the opponent has shown no goodwill or reputation in Formula 1 or F1 as trade marks or trade names. The opponent no doubt enjoys a goodwill under the FIA logo mark, and possibly the stylised F1 device mark, but the applicant's mark is unlikely to be confused with either of these marks. This ground of opposition therefore fails.

82) The opponents have also pleaded Section 56 and the Paris Convention. However I do not believe that their position is any the stronger under this ground than under the Section 5(2) and 5(4) grounds I have already considered. Therefore, I do not propose to deal with this ground.

83)Finally I deal with the ground of opposition under Section 3(6) which reads:

> "A trade mark shall not be registered if or to the extent that the application is made in bad faith."

84) Mr Mellor contended that with a vast range of goods and services included in the application and an applicant in "a very small way of business" that there was a clear prima facie case of bad faith. He referred me to the cases of *Demon Ale Trade Mark* [2000] RPC 345. However, in that case the applicant admitted that he had no intention of using the mark. I accept that the applicant's counterstatement incorrectly claimed that Section 3(6) placed no obligation on the applicant to use or have an intention to use the mark. Whilst the wording of Section 3(6) makes no specific reference to "use or intention to use" it is clear that if an applicant has no intention of using a mark on the goods and/or services specified then the application has been made in bad faith because of the statement made under Section 32(3) of the Act. In the instant case the applicant's evidence confirms that the applicant is seeking to expand its use of the mark in suit beyond its current use on an electronic magazine, and has an eye on further exploitation of the mark. This is shown at paragraph 22 above. To my mind

this refutes the opponents claim and confirms an intention to utilise the mark on the goods and services set out in the application specification. I do not consider the instant case to be on all fours with the *Demon Ale* case as the applicant has denied the ground of opposition and stated a clear intention to exploit the mark in suit.

85) Mr Mellor also contended that the specification was so wide ranging that "you would need a vast multi-national company to be able to sustain a bona fide intention to use on all of these goods and services." He also commented that "the intention that is required is not an intention to use it at some point in the future when or if you have got the capital to put the mark into use in relation to all the goods. The expression is 'a bona fide intention', and that has to be judged by the normal standards of commercial men". He explained that he was drawing an analogy with the comments of Lindsay J. in *Gromax Plasticulture Ltd v Don & Low Nonwovens* [1999] RPC 367 at 379 where the learned judge stated:

> "I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined."

86) The opponents further contend that the applicant had not put forward, in response to the challenges in the opponents' evidence, any plans of how they intended to use the mark in suit on the range of goods and services. It was claimed that the applicant had provided no evidence of a business plan, prospective licensees or proposals for financing. Evidence supplied by the opponents of the existing business of the applicant shows that, at the time of the evidence gathering, the applicant links customers to other websites for goods and services. Thus it is not using the mark in suit in relation to these goods and services.

87) I do not accept these contentions. Section 32 of the Act stipulates the application requirements for trade mark registration. Section 32(3) in particular states:

> "32(3) - The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods and services, or that he has a bona fide intention that it should be so used."

88) The fulfilment of this requirement is satisfied by the signing of the declaration on the trade mark application form TM3, either by the applicant or by an authorised representative. The application for the registration in question was made on 16 December 1998 and was completed to the Registrar's satisfaction by the signing of the declaration on the Form TM3. The applicant has stated that it intends to use its mark on the goods and services covered by its application.

89) It is well established that in an opposition under Section 3(6) of the Act the onus is on the opponent, reflecting the usual approach under English law that he who asserts must prove.

90) An allegation that the applicant had no bona fide intention of using its trade mark is not, in itself, sufficient to sustain an objection to registration under this head. The applicant in this case has in his evidence made it clear that he intends to expand his use of the mark in suit,

albeit he has not filed evidence of how it is intended to carry out this exploitation. Nonetheless, the opponents, on whom the onus rests, have provided no evidence that the applicant has no intention of using the mark across the whole specification other than to allege that the applicant lacks the financial resources at the moment to carry out such an ambitious expansion. This is not enough to present a prima facie case for the applicant to answer. Applications to register trade marks are not made for the sake of it and no other purpose has been suggested. Therefore the ground of opposition based on Section 3(6) is dismissed.

91) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1635. This sum 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 14TH day of October 2002

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

ANNEX B

Applicant's Specification	Opponent's marks and specifications
	Application number 770479
Class 4: Industrial oils and greases; lubricants; fuels (including motor spirit); illuminants; candles; wicks; dust absorbing, wetting and binding compositions.	Class 4:Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles; wicks.
Class 9: Coin or counter-fed electronic amusement apparatus; compasses (not for drawing); audio and video recording apparatus and cassettes; digital apparatus and digitizers; compact disc apparatus; compact discs and tapes; books on disc; flash apparatus; film; television; video recorders and video reproducing apparatus; records; video game amusement apparatus; receivers; teaching and instrumental apparatus and instruments; electrical remote control apparatus; personal security apparatus; radio receiving, radio transmitting, intercommunication telephonic, sound reproducing, and sound recording apparatus and instruments; computers; magnetic and encoded cards; computer programs; computer software; computer hardware; magnets; electronic games for television receivers; computer games; batteries; scientific, optical, cinematographic and photographic apparatus and instruments; luminous and mechanical signs; anti glare screens; clothing, footwear, headgear, helmets, gloves, belts and goggles, all for protection; sunglasses and spectacles; frames, lenses, spectacle cases and optical lens cases; security system alarms; anti-theft apparatus and remote locking apparatus; counting apparatus; pedometers, speedometers; odometers; calculators; recording apparatus; scoreboard and timing apparatus; binoculars, CD ROMS; mini disks; discs.	Class 9: Clothing, footwear, headgear, helmets, gloves, belts, all of a protective nature; luminous and mechanical signs and signposts; anti-glare screens; sunglasses and spectacles; cords, frames, lenses and cases for use with spectacles, sunglasses and optical; apparatus for anti-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; videocassettes, 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 discs 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.

	Application number 770479 (continued)
Class 16: Computer manuals; organisers; writing pads; writing blocks; printing, painting and drawing sets; business forms; albums; autograph books; diaries; books; almanacs; calendars; photographs; collector cards; stickers and sticker albums; bumper stickers, scrapbooks; binders; planners; stencils; transfers; writing instruments; writing inks; pencils; pens; erasers; portraits; plastic bags; gift wrap; wrapping material; packaging materials; party streamers; table covers made of paper; mats made of paper card or plastic; ornaments made of papier mache card or plastic; badges; paper, card, cardboard and goods made thereof; stationery; printed matter; cards; greeting cards; trading cards; address books; book covers and bindings; portfolios; newspapers; magazines; periodicals; comics; cartoons; publications; annuals; manuals; stamps; pictures; playing cards; easels; and artists materials; posters; catalogues; charts; maps; plans; instructional and teaching materials; route maps and guides.	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 materials; artists materials (other than colours or varnish); paint brushes; 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 papier 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.
Class 18: Bags; cases; luggage; holdalls; trunks; back packs; travelling bags; belt bags; sports bags; school bags; attache cases; shoulder bags; briefcases; all made of leather or imitation leather; writing set cases; wallets; holders; book covers; key fobs all made of leather or imitation leather; and articles made from leather or imitation leather; handbags; purses; umbrellas; parasols; walking sticks; portfolios; carrier bags or cases for articles of clothing.	Class 18: Articles made from leather and from imitation leather; luggage; cases and bags; holdalls; back packs; handbags; purses; belt bags; sports bags; school bags; attache cases; writing set cases; umbrellas; parasols; walking sticks; trunks and travelling bags; sunshades; portfolios; jewellery boxes; wallets; holders; book covers and key fobs all of either leather or imitation leather; parts and fittings for all the aforesaid goods and all other goods in Class 18.

	Application number 770479 (continued)
Class 25: Articles of clothing; peaks; visors; baseball caps; caps; hats; neckwear; ties; scarves; cravats; bow ties; gloves; mittens; belts; gaiters; braces; socks; stockings; pantihose; suits; shirts; blouses; T-shirts; sweatshirts; trousers; skirts; dresses; articles of fancy dress; jackets; overalls; waistcoats; dressing gowns; bath robes; articles of sports clothing; sleeping garments; pyjamas; aprons; jeans; swimwear; footwear; shoes; boots; ski boots; swimwear; caps; rainwear; sportswear; leisurewear; ski wear; underwear; track suits; shell suits; coats; mantles; polo shirts; headgear; sweatbands; wrist-bands; sports shoes and sports boots; footwear for sports.	Class 25: Articles of clothing; swimwear; rainwear; sportswear; leisurewear; nightwear; 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 and ski boots; gaiters and cases for same; shoes; socks; sweatbands and wrist-bands; footwear for sports; parts and fittings for all the aforesaid goods; and all other goods in Class 25.
Class 28:Ornaments and decorations for Christmas trees; balloons and party hats; party streamers; games, toys and playthings; electronic games; sports equipment and sporting articles.	Class 28: Games, toys and playthings; sports equipment and sporting articles; electronic games; ornaments and decorations (other than candles or lamps) all for Christmas trees; balloons and party hats; and all other goods in Class 28.
Class 35: Computerised business information storage and retrieval; display services for merchandising; compiling and disseminating advertising matter; production of advertising matter.	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.
Class 38:Electronic transmission of data, images and sound via computer terminal and networks including the Internet and via Extranets and Intranets; telecommunications services; radio and television broadcasting via the digital networks including the Internet and interactive services relating thereto; radio, television broadcasting and satellite and cable broadcasting.	Class 38: Radio and television broadcasting, satellite and cable broadcasting; radio and television broadcasting via the digital networks including the internet and interactive services relating thereto; telecommunications services; electronic transmission of data, images and sound via computer terminal and networks.

	Application number 770479 (continued)
In Class 41: The provision of education, entertainment and training all relating to sporting and cultural activities.	Class 41: Arranging, organising and staging of sporting events, tournaments and competitions; production of sports events, tournaments and competitions for radio, film and television; provision of recreation facilities for sports events, tournaments and competitions and all other services in Class 41.
In Class 42: Providing access to databases and interactive computer databases in the field of sport; providing access to home ordering services via computer and/or interactive communications including digital television and the Internet; providing access to computer bulletin boards and real time chat forums in the field of sports; travel agency services for booking accommodation; rental of rooms; photographic services all provided by means of computer databases, web pages, by pay per view or digital television.	Class 42 "Travel agency services for booking accommodation; rental of rooms; photographic services all provided by means of computer databases, web pages, by pay per view or digital television"
	Application number 1565429
Class 25: Articles of clothing; peaks; visors; baseball caps; caps; hats; neckwear; ties; scarves; cravats; bow ties; gloves; mittens; belts; gaiters; braces; socks; stockings; pantihose; suits; shirts; blouses; T-shirts; sweatshirts; trousers; skirts; dresses; articles of fancy dress; jackets; overalls; waistcoats; dressing gowns; bath robes; articles of sports clothing; sleeping garments; pyjamas; aprons; jeans; swimwear; footwear; shoes; boots; ski boots; swimwear; caps; rainwear; sportswear; leisurewear; ski wear; underwear; track suits; shell suits; coats; mantles; polo shirts; headgear; sweatbands; wrist-bands; sports shoes and sports boots; footwear for sports.	Class 25: Sweatpants, shirts, sports shirts; sweatshirts, T-shirts; none being knitted; gloves not included in Class 28; nightwear; all included in Class 25.
	Application number 2144871A
Class 9: Audio and video recording apparatus and cassettes.	Class 9: Audio and video recording apparatus and cassettes

	Application number 2144871A (continued)
Class 16: Computer manuals; organisers; writing pads; writing blocks; printing, painting and drawing sets; business forms; albums; autograph books; diaries; books; almanacs; calendars; photographs; collector cards; stickers and sticker albums; bumper stickers, scrapbooks; binders; planners; stencils; transfers; writing instruments; writing inks; pencils; pens; erasers; portraits; plastic bags; gift wrap; wrapping material; packaging materials; party streamers; table covers made of paper; mats made of paper card or plastic; ornaments made of papier mache card or plastic; badges; paper, card, cardboard and goods made thereof; stationery; printed matter; cards; greeting cards; trading cards; address books; book covers and bindings; portfolios; newspapers; magazines; periodicals; comics; cartoons; publications; annuals; manuals; stamps; pictures; playing cards; easels; paint brushes and artists materials; posters; catalogues; charts; maps; plans; instructional and teaching materials; route maps and guides.	Class 16: Paper; card; cardboard; stationery; printed matter; books; almanacs; material and printed matter for advertising signs; calendars; photographs; collector cards; stickers and sticker albums; transfers; bumper stickers; trading cards; address books; organisers; writing pads and blocks; route maps; printing, painting and drawing sets; catalogues; maps, plans and charts; posters; rulers; pens; plastic bags; wrapping material; portraits.
Class 28:Ornaments and decorations for Christmas trees; balloons, and party hats; party streamers; games, toys and playthings; electronic games; sports equipment and sporting articles.	Class 28:Games, toys and playthings; sports equipment and sporting articles; electronic games; but not including golfing equipment or any goods similar to golfing equipment.
Class 35: Computerised business information storage and retrieval; display services for merchandising; compiling and disseminating advertising matter; production of advertising matter.	Class 35: Computerised business information storage and retrieval; display services for merchandising; compiling and disseminating advertising matter; production of advertising matter.
Class 38:Electronic transmission of data, images and sound via computer terminal and networks including the Internet and via Extranets and Intranets; telecommunications services; radio and television broadcasting via the digital networks including the Internet and interactive services relating thereto; radio, television broadcasting and satellite and cable broadcasting.	Class 38:Radio and television broadcasting; satellite and cable broadcasting; radio and television broadcasting via the digital networks including the Internet and interactive services relating thereto; telecommunications services; electronic transmission of data, images and sound via computer terminal and networks.

	Application number 2144871A (continued)
In Class 41: The provision of education, entertainment and training all relating to sporting and cultural activities.	Class 41Arranging, organising and staging of sports events, tournaments and competitions; production of sports events, tournaments and competitions for radio, film and television; provision of recreation facilities for sports events, tournaments and competitions; provision of information relating to sports via inter computer communications mediums; providing computer games and contests that may be accessed network-wide by network users and/or subscribers; provision of gambling facilities; gaming services; organisation of sports competitions; but not including the provision of recreation facilities for playing golf.
In Class 42: Providing access to databases and interactive computer databases in the field of sport; providing access to home ordering services via computer and/or interactive communications including digital television and the Internet; providing access to computer bulletin boards and real time chat forums in the field of sports; travel agency services for booking accommodation; rental of rooms; photographic services all provided by means of computer databases, web pages, by pay per view or digital television.	Opponent's specification under Classes 38 and 41: "Providing access to databases and interactive computer databases in the field of sport; providing access to home ordering services via computer and/or interactive communications including digital television and the Internet; providing access to computer bulletin boards and real time chat forums in the field of sports."
	Application 1565428
Class 18: Bags; cases; luggage; holdalls; trunks; back packs; travelling bags; belt bags; sports bags; school bags; attache cases; shoulder bags; briefcases; all made of leather or imitation leather; writing set cases; wallets; holders; book covers; key fobs all made of leather or imitation leather; and articles made from leather or imitation leather; handbags; purses; umbrellas; parasols; walking sticks; portfolios; carrier bags or cases for articles of clothing.	Class 18 :Luggage and bags, holdalls, attache cases, umbrellas, parasols and walking sticks, trunks, and travelling bags; all included in Class 18.

	Application number 2144871B
Class 4: Industrial oils and greases; lubricants; fuels (including motor spirit); illuminants; candles; wicks; dust absorbing, wetting and binding compositions	Class 4: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles; wicks.
	Application number 554873
Class 9: Computer programs; computer software; electronic games for television receivers; computer games; CD ROMS	Class 9: Computer programmes; computer software; electronic games for television receivers; computer games; CD ROMS.