

JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

17 February 2011 *

In Case T-10/09,

Formula One Licensing BV, established in Rotterdam (Netherlands), represented by B. Klingberg and K. Sandberg, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Folliard-Monguiral, acting as Agent,

defendant,

* Language of the case: English.

intervener before the General Court, granted leave to take the place of Racing-Live SAS, the other party to the proceedings before the Board of Appeal of OHIM, being

Global Sports Media Ltd, established in Hamilton (Bermuda), represented by T. de Haan and J.-J. Evrard, lawyers, and subsequently by T. de Haan,

ACTION brought against the decision of the First Board of Appeal of OHIM of 16 October 2008 (Case R 7/2008-1) concerning opposition proceedings between Racing-Live SAS and Formula One Licensing BV,

THE GENERAL COURT (Eighth Chamber),

composed of M.E. Martins Ribeiro, President, S. Pappasavvas and N. Wahl (Rapporteur), Judges,

Registrar: K. Pocheć, Administrator,

having regard to the application lodged at the Court Registry on 14 January 2009,

having regard to the response of OHIM lodged at the Court Registry on 30 March 2009,

having regard to the response of the intervener lodged at the Court Registry on 10 April 2009,

further to the hearing on 10 June 2010,

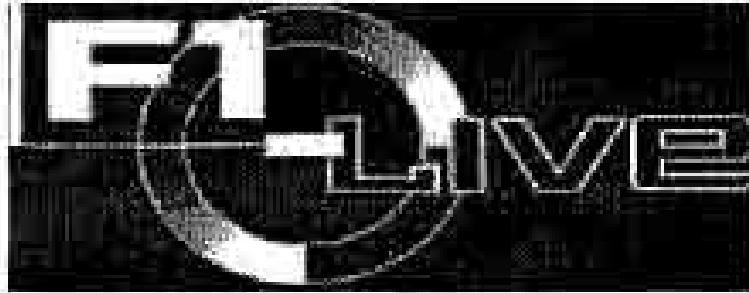
gives the following

Judgment

Background to the dispute

- ¹ On 13 April 2004, Racing-Live SAS filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

- 2 The trade mark in respect of which registration was sought is the figurative sign reproduced below:



- 3 The goods and services in respect of which registration was sought are in Classes 16, 38 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description for each of those classes:

- Class 16: ‘Magazines, pamphlets, books; all the aforesaid goods relating to the field of formula 1’;

- Class 38: ‘Communication and dissemination of books, magazines and newspapers via computer terminals; all the aforesaid services relating to the field of formula 1’;

- Class 41: ‘Electronic publication of books, journals and periodicals; entertainment information; arranging competitions on the Internet; reservation of tickets for shows; on-line gaming; all the aforesaid services relating to the field of formula 1’.
- 4 That application for registration was published in *Community Trade Marks Bulletin* No 5/2005 of 31 January 2005.
- 5 On 2 May 2005, the applicant — Formula One Licensing BV — filed a notice of opposition under Article 42 of Regulation No 40/94 (now Article 41 of Regulation No 207/2009) against registration of the trade mark applied for, alleging a likelihood of confusion for the purposes of Article 8(1)(b) and (5) of Regulation No 40/94 (now Article 8(1)(b) and (5) of Regulation No 207/2009).
- 6 The opposition was based inter alia on the following earlier registrations:
- three registrations of the word sign F1: (i) international registration No 732 134 of 20 December 1999, with effect in Denmark, Germany, Spain, France, Italy and Hungary, in respect of goods and services in Classes 16, 38 and 41, covering, inter alia, the goods and services covered by the mark applied for; (ii) German registration No 30 007 412 of 10 May 2000 for services in Class 41 (‘Conducting of sporting events’); and (iii) United Kingdom registration No 2 227 746 D of 13 August 2001 for goods and services in Classes 16 (‘Paper, card, cardboard, printing, painting and drawing sets; catalogues’) and 38 (‘Telecommunication services; electronic transmission of data, images and sound via computer terminal and networks’);

- registration of Community figurative trade mark reproduced below ('the F1 Formula 1 logotype'), registered under No 631 531 on 19 May 2003 in respect of goods and services in Classes 16, 38 and 41, covering inter alia the goods and services covered by the mark applied for:



- 7 The opposition was based on all of the goods and services covered by the earlier marks and was directed against all of the goods and services designated by the mark applied for.
- 8 The applicant claimed that all the marks owned by it had enhanced distinctiveness on account of their use, over many years, in relation to various goods and services.
- 9 By decision of 17 October 2007, the Opposition Division of OHIM, relying solely on earlier international registration No 732 134, rejected the application for a Community trade mark. It found that the goods and services covered by the two marks were similar or identical and that the signs at issue were similar to a medium degree and, in consequence, that there was a likelihood of confusion between those marks for the purposes of Article 8(1)(b) of Regulation No 40/94.
- 10 On 14 December 2007, the intervener filed a notice of appeal with OHIM under Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009) against the Opposition Division's decision.

- 11 By decision of 16 October 2008 ('the contested decision'), the First Board of Appeal annulled the Opposition Division's decision. It ruled that, even though the goods and services in question were identical or similar, there was no likelihood of confusion for the purposes of Article 8(1)(b) of Regulation No 40/94 between, on the one hand, the trade mark applied for and, on the other, those owned by the applicant (collectively, 'the signs at issue'), since there were obvious differences between them. The Board of Appeal also held that the relevant public, which consists of ordinary consumers and professional users, perceived the combination of the letter 'F' and the numeral '1' as the generic designation of a category of racing car and, by extension, of races involving such cars. The Board of Appeal concluded that the reputation of the earlier trade marks concerned only the 'F1' element of the F1 Formula 1 logotype, registered under No 631 531.
- 12 As regards Article 8(5) of Regulation No 40/94, the Board of Appeal found that, although the applicant has built up an image of state-of-the-art technology, exclusivity and luxury, the only vehicle for conveying that image is the 'F1' element in the F1 Formula 1 logotype. However, few consumers attribute any distinctive character to the abbreviation 'F1', unless it is represented in a fanciful manner, such as that logotype. In that connection, the Board of Appeal stated that nothing in the mark applied for reminded the public of that logotype and that, consequently, the trade mark applied for would not free-ride on the earlier marks or tarnish the reputation of those marks; nor would it enable its owner to benefit unjustifiably from the positive image of those marks.

Procedure and forms of order sought

- 13 By application lodged at the Court Registry on 14 January 2009, the applicant brought the present action.

14 The applicant claims that the Court should:

- annul the contested decision;

- order OHIM to pay the costs;

- order the intervener to pay the costs incurred in the procedure before OHIM.

15 OHIM and the intervener contend that the Court should:

- dismiss the application;

- order the applicant to pay the costs.

16 By fax of 8 June 2010, Racing-Live and Global Sports Media Ltd informed the Court that the former had transferred the mark applied for (F1-LIVE) to the latter and submitted a request that Global Sports Media, as the new owner of that mark, be allowed to take the place of the original owner in the proceedings. Since OHIM stated at the oral hearing that it had no objection to that request, the Court allowed the substitution, which was recorded in the transcript of the hearing.

Law

1. *Admissibility of the documents produced for the first time before the Court*

- 17 OHIM and the intervener submit, as a preliminary plea, that Annexes A 6 to A 10 to the application were never produced during the administrative procedure before OHIM and must accordingly be declared inadmissible.
- 18 It is settled law that the purpose of actions for annulment brought before the Court is to review the legality of decisions of the Boards of Appeal of OHIM for the purposes of Article 63 of Regulation No 40/94 (now Article 65 of Regulation No 207/2009), so it is not the Court's function, in that context, to review the facts in the light of documents produced for the first time before it. Facts which are pleaded before the Court without having previously been produced before the adjudicating bodies of OHIM can affect the legality of such a decision only if OHIM should have taken them into account of its own motion (see, to that effect, Case T-115/03 *Samar v OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 13, and Case T-346/04 *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)* [2005] ECR II-4891, paragraph 19).
- 19 In the present case, Annexes A 6 to A 10 contain documents which were not previously produced before OHIM and must therefore be declared inadmissible, without it being necessary to assess their probative value or to hear further argument from the parties (see, to that effect, *ARTHUR ET FELICIE*, paragraph 19 and the case-law cited).

2. *Substance*

- 20 In support of its action, the applicant raises two pleas: (i) infringement of Article 8(1)(b) of Regulation No 40/94 and (ii) infringement of Article 8(5) of that regulation.

The first plea: infringement of Article 8(1)(b) of Regulation No 40/94

Arguments of the parties

- 21 The applicant claims, in essence, that there is a likelihood of confusion between the mark applied for and the earlier marks, which have considerable reputation.
- 22 The applicant argues that: (i) the Board of Appeal did not take into consideration the fact that the goods and services at issue are for the most part identical or otherwise extremely similar; (ii) the Board of Appeal incorrectly presumed that the combination of the letter 'F' and the numeral '1', in plain typeset, would not be perceived by the public as a trade mark because of its allegedly generic and descriptive character and alleged complete lack of distinctiveness; (iii) since 'F1' is the dominant element in the contested mark, there is a high degree of similarity, from a visual, phonetic and conceptual point of view, between the earlier word marks and the mark applied for and,

accordingly, a likelihood of confusion, even though the earlier word marks have only a weak distinctive character; and (iv) there is also a likelihood of confusion between the mark applied for and the Community figurative mark — the F1 Formula 1 logotype — which has a particularly strong distinctive character.

²³ OHIM and the intervener dispute the applicant's arguments.

Findings of the Court

²⁴ Article 8(1)(b) of Regulation No 40/94 provides that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not be registered if, because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

²⁵ According to established case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings constitutes a likelihood of confusion. According to that same line of authority, the likelihood of confusion must be assessed globally, according to the relevant public's perception of the signs and of the goods or services concerned and account being taken of all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and the similarity of the goods or services designated (see Case T-162/01 *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)* [2003] ECR II-2821, paragraphs 30 to 33 and the case-law cited).

- 26 For the purposes of applying Article 8(1)(b) of Regulation No 40/94, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see Case T-316/07 *Commercy v OHIM — easyGroup IP Licensing (easy-Hotel)* [2009] ECR II-43, paragraph 42 and the case-law cited).
- 27 In the present case, the Board of Appeal found in paragraph 27 of the contested decision that the average consumer in the European Union was the relevant public and that the likelihood of confusion between the trade marks at issue should therefore be assessed in relation to those consumers. That finding — which, moreover, was not disputed by the parties — must, given the nature of the goods and services in question, be upheld.
- 28 Next, as regards the similarity of the goods and services at issue, it is sufficient to note that the Board of Appeal found in paragraphs 25 and 26 of the contested decision that the intervener's activities — the selling of printed matter and communication over the internet (the goods and services in classes 16 and 38) — were identical to the applicant's activities, and that the online publication and online entertainment services in the field of Formula 1 (services in class 41) were very similar to the services offered by the applicant.
- 29 This means that the Board of Appeal did not fail to assess the degree of similarity between the goods and services at issue. The plea raised by the applicant in that respect must therefore be rejected as unfounded.

30 Lastly, the applicant disputes the Board of Appeal's finding that, as between the signs at issue, there is neither a strong similarity nor a likelihood of confusion.

— The comparison of the signs at issue and their perception by the relevant public

31 The global assessment of the likelihood of confusion must be based, in so far as the visual, phonetic or conceptual similarity of the signs at issue is concerned, on the overall impression given by the signs, account being taken, *inter alia*, of their distinctive and dominant elements (Case C-334/05 P *OHIM v Shaker* [2007] ECR I-4529, paragraph 35 and the case-law cited).

32 Assessment of the similarity between two marks means more than taking just one component of a compound trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks at issue as a whole, which does not mean that the overall impression conveyed to the relevant public by a compound trade mark may not, in certain circumstances, be dominated by one or more of its components (see *OHIM v Shaker*, paragraph 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker*, paragraph 42, and judgment of 20 September 2007 in Case C-193/06 P *Nestlé v OHIM*, not published in the ECR, paragraph 42). That may be the case, in particular, where that component is likely by itself to dominate the image which the relevant public retains of that mark, with the result that the other components of the mark are negligible in the overall impression created by the mark (*Nestlé v OHIM*, paragraph 43).

- 33 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 compound mark, it is quite possible that in a particular case an earlier mark used by a third party in a compound sign including the name of the company of the third party still has an independent distinctive role in the compound sign, without necessarily constituting the dominant element. In such a case, the overall impression produced by the compound sign may lead the public to believe that the goods or the 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 (Case C-120/04 *Medion* [2005] ECR I-8551, paragraphs 30 and 31).
- 34 In the present case, it should be noted that the mark applied for is a compound mark, in that it is composed of two word elements, 'F1' and 'LIVE', separated by a hyphen, and some figurative elements. The two word elements are positioned inside a dark-coloured rectangle, in the middle of which is a ring-shaped figure shaded from white to black. The element 'F1' is printed in white in the upper left-hand corner of the rectangle, whilst the element 'LIVE' is printed in black letters outlined in white in the middle of the right-hand side of the rectangle.
- 35 The earlier marks on which the opposition is based are the F1 Formula 1 logotype (the Community figurative trade mark) and the national and international word marks F1.
- 36 For the purposes of the comparison of the signs at issue, the applicant has put forward various arguments designed to establish that 'F1' constitutes the dominant element in the mark applied for. The applicant also draws attention to the fact that the abbreviation 'F1', in ordinary typeset, has been registered in several countries. Furthermore, it disputes the Board of Appeal's finding that that abbreviation has only a weak

distinctive character and that the relevant public does not perceive the combination of the letter 'F' and the numeral '1' as a trade mark.

37 Given the relevance of the issue regarding the dominant element to the assessment of the similarity of the signs at issue, those arguments must be examined before a comparison of those signs is undertaken.

38 In the contested decision, the Board of Appeal found, first, that the relevant public would perceive the combination of the letter 'F' and the numeral '1' as an abbreviation of 'Formula One', which is the commonly used designation of a category of racing car and, by extension, of races involving such cars (paragraph 33 of the contested decision). Secondly, it found that the relevant public may perceive the 'F1' element of the F1 Formula 1 logotype as the trade mark that the applicant uses in relation to its commercial activities in the field of Formula 1 motor racing (paragraph 34 of the contested decision). The Board of Appeal inferred from this that it was necessary to distinguish between the 'F1' element as a word (a simple combination of a letter and a numeral) and the sign F1 as a logotype (paragraph 35 of the contested decision).

39 That conclusion must be endorsed.

40 First, it is clear from the evidence in the file that, over the past 10 years, the applicant has promoted only the F1 Formula 1 logotype — Community figurative mark No 631531 — and that, when granting licences, it has emphasised that logotype by issuing guidelines and design instructions to ensure consistent use of the marks.

- 41 Strict enforcement of those rules has enabled the applicant to make sure that the relevant public has consistently seen the ‘F1’ element as representing the F1 Formula 1 logotype.
- 42 However, it should be noted that the applicant has not imposed rules regarding the use of the ‘F1’ element in forms other than the F1 Formula 1 logotype, such as international registration No 732 134. As it is, it is common ground that the ‘F1’ element is always used by the applicant, or by the licence-holders, in combination with the F1 logo (except in cases where the logo cannot be portrayed because of the mode of communication used).
- 43 Secondly, it is clear from the evidence submitted by the applicant — in particular, from the results of a public survey conducted in Germany and a witness statement — that the public at large are not unaware that ‘F1’ is the common abbreviation of ‘Formula 1’, which designates a category of racing car and, by extension, races involving such cars. Furthermore, ‘Formula 1’ is used to designate, in generic terms, the sport of motor racing, which the public will not specifically associate with races organised by the group to which the applicant belongs, but rather with the top-end category of motor racing in general. Indeed, there is no other appropriate word or term to designate that type of sport.
- 44 Furthermore, it should be observed that the applicant does not dispute the Board of Appeal’s conclusion that ‘Formula 1’ is commonly used in everyday language to designate a category of racing car and, by extension, races involving such cars, and that ‘F1’ is the familiar abbreviation of that term. The evidence submitted by the applicant — in particular, the documents enclosed with the witness statement referred to in the previous paragraph — also shows that the abbreviation ‘F1’ can be used in a descriptive context. This means that the abbreviation ‘F1’ is just as generic as the term ‘Formula 1’.

- 45 In those circumstances, it should be noted that, according to settled case-law, the public will not generally consider a descriptive element forming part of a compound mark as the distinctive and dominant element of the overall impression conveyed by that mark (see the judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM — Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraph 47 and the case-law cited).
- 46 Furthermore, the sole fact that the earlier word mark has been registered as a national or international trade mark does not prevent it from being largely descriptive or, in other words, from having only a weak intrinsic distinctive character in relation to the goods and services it covers (see the judgment of 13 October 2009 in Case T-146/08 *Deutsche Rockwool Mineralwoll v OHIM — Redrock Construction (REDROCK)*, not published in the ECR, paragraph 51 and the case-law cited).
- 47 In that context, it should be borne in mind that the validity of an international or national trade mark — in the present case, the applicant's marks — may not be called into question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (see Case T-7/04 *Shaker v OHIM — Limiñana y Botella (Limoncello della Costiera Amalfitana shaker)* [2008] ECR II-3085, paragraph 26 and the case-law cited).
- 48 The fact nevertheless remains that OHIM had a duty to verify the way in which the relevant public perceived the 'F1' element in the mark applied for.
- 49 In the light of those considerations and of the evidence submitted, it must be held that the relevant public will not perceive the 'F1' element in the mark applied for as a distinctive element, but as an element with a descriptive function.

50 Accordingly, the Board of Appeal was right to find that the ‘F1’ element, in ordinary typeset, had only a weak distinctive character in relation to the goods and services covered and that the reputation of the Community figurative mark used in the European Union was essentially linked to the logotype itself.

51 The case that led to the judgment in *Medion*, paragraph 33 above — relied upon by the applicant at the hearing — is not relevant to the present case. In the present case, it must be held that the sign ‘F1’ does not play a distinctive independent role within the mark applied for, since, as has already been stated above, the relevant public will perceive the ‘F1’ element as a descriptive element of that mark.

52 It is therefore necessary to reject as unfounded the applicant’s arguments that the ‘F1’ element has a particularly pronounced distinctive character and that ‘F1’ in standard typeset has a reputation equal to that of the F1 Formula 1 logotype. By the same token, and contrary to the assertions made by the applicant, the evidence submitted in relation to the F1 Formula 1 logotype does not support a finding that considerable use was made of the earlier national and international word marks.

— The comparison of the mark applied for and the earlier national and international word marks F1

53 In the present case, the earlier national and international marks are word marks, made up of the element ‘F1’, whereas the mark applied for is a compound mark (see paragraph 34 above).

- 54 In that connection, it should be noted that there is some degree of similarity between the signs at issue because of the 'F1' element common to all of them. Nonetheless, they differ visually in length, and by virtue of the presence in the mark applied for of the word 'LIVE' and the fact that the mark applied for contains a figurative element.
- 55 From a phonetic point of view, it should be observed that the mark applied for consists of two words and the earlier marks only one. The addition of a striking extra word in the mark applied for counterbalances, to some extent, the common element 'F1'. Nevertheless, the Board of Appeal was correct in concluding, given that the signs at issue all contain the 'F1' element, which is the first to be pronounced in the mark applied for, that there was some degree of similarity from a phonetic point of view.
- 56 From a conceptual point of view, it should be noted that the earlier marks designate a specific category of racing car — Formula 1 cars — and can also be perceived as implicitly referring to Formula 1 races. The mark applied for carries the same message, but the addition of the word 'LIVE', which suggests the reporting or broadcasting of an event in 'real time', makes it conceptually richer than the earlier marks. As a consequence, although the common word element 'F1' makes the signs at issue to some extent conceptually similar, the degree of similarity remains weak.
- 57 It must be held that — as the Board of Appeal found — since consumers will not connect the 'F1' element in the mark applied for with the applicant, because the only sign that they have learned to associate with the applicant is the F1 Formula 1 logotype, and not the sign F1 in standard typeset, and since consumers will regard 'F1' in ordinary typeset as an abbreviation of 'Formula 1' — that is to say, as a description — there is no likelihood of confusion between the marks at issue.

58 The mark applied for should therefore be compared with the applicant's Community figurative mark, the F1 Formula 1 logotype.

— The comparison of the mark applied for and the F1 Formula 1 logotype, the earlier Community figurative mark

59 As the Board of Appeal correctly stated, there are obvious differences, as regards the general layout, between the mark applied for and the F1 Formula 1 logotype, the earlier Community figurative mark. In the mark applied for, the 'F' and the '1' are vertical and separate, whilst in the earlier mark, those elements are slanted to the right and written in such a way that the space between them creates the shape of the numeral element. Those two elements are also presented in sharply contrasting colours. The right-hand side of the mark has fading lines which probably represent speed. It must therefore be found that there is no visual similarity between the two marks.

60 From the phonetic and conceptual points of view, a comparison leads to the same result as the examination of F1 as a word sign (see paragraphs 55 and 56 above), which is that there is some degree of phonetic and conceptual similarity.

61 In the present case, with regard to the overall assessment of the likelihood of confusion, which established in particular a lack of visual similarity and only limited phonetic and conceptual similarities, it is sufficient to hold that the Board of Appeal was correct in finding that there was no likelihood of confusion between the two marks, since the relevant public will not confuse the mark applied for with the applicant's logotype mark. In that connection, it should be noted that the fact that the public attributes a generic meaning to the sign F1 means that it will understand that the mark

applied for concerns Formula 1, but, because of its totally different layout, the public will not make a connection between that mark and the activities of the applicant.

62 In the light of the foregoing, the first plea must therefore be rejected.

The second plea: infringement of Article 8(5) of Regulation No 40/94

Arguments of the parties

63 The applicant claims that the Board of Appeal was wrong to reject the argument that the common element — the 'F1' element — is sufficient to create a link, for the purposes of Article 8(5) of Regulation No 40/94, between the signs at issue in the eyes of the public. As a consequence, the Board of Appeal also failed to assess whether the mark applied for might take unfair advantage of the reputation and distinctive character of the earlier marks and thus be detrimental to their owner.

64 OHIM and the intervener dispute the applicant's arguments.

Findings of the Court

- ⁶⁵ It is apparent from the wording of Article 8(5) of Regulation No 40/94 that its application is subject to the following conditions: (i) the marks at issue must be identical or similar; (ii) the earlier mark cited in opposition must have a reputation; and (iii) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Since those three conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (Case T-67/04 *Spa Monopole v OHIM - Spa-Finders Travel Arrangements (SPA-FINDERS)* [2005] ECR II-1825, paragraph 30).
- ⁶⁶ It should also be pointed out that, according to the case-law, the types of damage referred to in Article 8(5) of Regulation No 40/94, where they occur, are the consequence of a certain degree of similarity between the marks at issue, by virtue of which the relevant section of the public makes a connection between the marks, that is to say, it establishes a link between them, even though it does not confuse them (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 30 and the case-law cited).
- ⁶⁷ As is clear from paragraph 66 of the contested decision, the only sign in respect of which the applicant has shown use and, possibly, reputation, is the F1 Formula 1 logotype, which it registered in the European Union under No 631 531. Accordingly, the first question to address is whether the figurative marks at issue are identical or similar. The distinctive character and the reputation of the logotype sign lie in the virtual fusion of the letter 'F' and the numeral '1', presented in sharply contrasting colours. The sole fact that the letter 'F' and the numeral '1' are present in the mark applied

for — a presence which has no distinctive character — is insufficient to support the inference that there is a link between the two marks. Consequently, notwithstanding a certain phonetic and conceptual resemblance, the Board of Appeal's finding that no element of the mark applied for reminds the public of the F1 Formula 1 logotype must be upheld, since the two signs cannot be regarded as similar.

⁶⁸ Given that one of the three cumulative conditions set out in paragraph 65 above is not fulfilled, there is no need to adjudicate on the question whether, in the present case, the third condition for application of Article 8(5) of Regulation No 40/94 is fulfilled.

⁶⁹ Accordingly, the second plea must also be rejected.

Costs

⁷⁰ Under Article 87(2) of the Rules of Procedure of the General Court, the unsuccessful party must be ordered to pay the costs if they have been applied for in the successful party's pleadings. As the applicant has been unsuccessful, it must be ordered to pay the costs in accordance with the forms of order sought by OHIM and the intervener.

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Formula One Licensing BV to pay the costs.**

Martins Ribeiro

Papasavvas

Wahl

Delivered in open court in Luxembourg on 17 February 2011.

[Signatures]