

### F1 loses the race against F1H2O Switzerland - Meyer Lustenberger

### Examination/opposition National procedures

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The Administrative Court has upheld a decision of the [Swiss Federal Institute of Intellectual Property](#) (IGE) in which the latter had found that the trademark F1H2O was not confusingly similar to the earlier registered trademark F1.

The owner of the trademark F1 opposed the application for the registration of the trademark F1H2O. Both marks covered goods and services in Classes 9, 25, 38, and 41 of the [Nice Classification](#).

The IGE rejected the opposition, holding that the F1H2O mark was not confusingly similar to the trademark F1 because:

- the chemical element H2O was the dominant part of the F1H2O mark; and
- consequently, the mark as a whole appeared as a chemical formula.

The opponent appealed, arguing that the public would divide the F1H2O mark into its two elements, 'H2O' and 'F1'. The opponent also claimed that based on the strength of the F1 mark and the similarity of the goods covered by both marks, there was a likelihood of confusion among the public.

In its defence, the applicant submitted that the dominant element of the F1H2O mark was the chemical element H2O, while the term 'F1' was generic. Therefore, the differences between the marks were sufficient to avoid a likelihood of confusion.

The Administrative Court dismissed the appeal, holding as follows:

- 'F1' is the abbreviation of 'Formula 1' and is registrable as a trademark.
- The trademark F1 is not particularly strong but has an average degree of distinctiveness, since it may refer not only to the motor racing sport, but also to the F1 key on the keyboard of computers.
- The fact that a trademark is incorporated into another mark in its entirety does not necessarily imply that the marks are confusingly similar. The relevant public was unlikely to divide the F1H2O mark into 'H2O' and 'F1', especially because the goods at issue made no reference to the chemical element H2O. The average consumer would thus perceive the mark as a fanciful sign.

The decision seems to contradict previous case law in which the IGE had found that the F1 mark was well known and thus benefited from broader protection (eg, *F1 v F1 BISTRO*).

Moreover, the argumentation on the similarity of the goods and services was not convincing. The court, as well as the IGE, held that "educational and training services" and "vehicles" were similar because "vehicles are used in connection with courses for handling and driving vehicles". In *F1 BISTRO*, the IGE had held that "vehicles" were similar to "leasing services", since vehicle manufacturers often offer leasing services under the same mark as that used for the vehicles themselves. However, the same argumentation may not apply to "training services", since:

- training may be offered for virtually any kind of products; and
- with regard to motor vehicles, training services are usually offered by third parties (eg, driving schools), rather than by the vehicle manufacturer itself.

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