



Press and Information

Court of Justice of the European Union

**PRESS RELEASE No 67/12**

Luxembourg, 24 May 2012

Judgment in Case C-196/11 P  
Formula One Licensing BV v OHIM

**The Court of Justice sets aside the judgment of the General Court which failed to acknowledge, in relation to trade marks, the distinctive character of the ‘F1’ sign**

*Neither OHIM nor the General Court are competent to call into question the validity of national trade marks capable of opposing the registration of a Community trade mark*

In April 2004, Racing-Live SAS<sup>1</sup> filed an application for registration of a Community trade mark with OHIM (the Community Trade Marks Office) for the following figurative trade mark in respect of various goods and services (magazines, books, publications, reservation of tickets for shows, and arranging competitions on the Internet):



However, Formula One Licensing BV opposed that application. The opposition was based on the existence of an international word mark and two national word marks for ‘F1’, and the following Community figurative mark, covering the same products and services as those indicated in Racing-Live SAS’ application for registration:



By a decision given in October 2008, OHIM dismissed the opposition, considering that there was no likelihood of confusion between the trade mark applied for and those of which Formula One Licensing was the proprietor. Moreover, OHIM stated that the word element ‘F1’ was a descriptive element in the trade mark applied for.

Formula One Licensing subsequently brought an action for the annulment of OHIM’s decision before the General Court. By its judgment of 17 February 2011<sup>2</sup>, the General Court dismissed the company’s action and confirmed OHIM’s decision. Formula One Licensing now claims that the Court of Justice should set aside the judgment of the General Court.

In its judgment delivered today, the Court of Justice notes, first, that that the Community trade mark does not replace the national trade marks of Member States and that those two types of trade mark co-exist in the economic life of the EU. The Court states that in this dual system of trade marks, the registration of national trade marks is solely a matter for the Member States and that, therefore, OHIM and the General Court are not competent for either the registration or the declaration of invalidity of those trade marks. Accordingly, the Court notes that **the validity of a national trade mark may not be called into question in proceedings opposing the**

<sup>1</sup> A company which was subsequently replaced by Global Sports Media Ltd as proprietor of the trade mark applied for.

<sup>2</sup> Case [T-10/09](#) *Formula One Licensing BV v OHIM*. See also Press Release No [10/11](#).

**registration of a Community trade mark, but only in cancellation proceedings brought in the Member State in which the national trade mark was registered.**

In addition, according to the Court, **it cannot be found, in such opposition proceedings, that a sign identical to a national trade mark is devoid of distinctive character**, that is, the ability to allow the public to associate the products and services designated by the sign with the company which applied for its registration. Such a finding would be likely to eliminate the protection which national trade marks are supposed to provide.

Hence, the Court notes that, in a situation such as that in the present case, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark, solely in relation to the mark applied for, and evaluate, if necessary, **the degree of distinctiveness of that sign**. In that respect, the Court points out that **it is necessary to acknowledge a certain degree of distinctiveness of a national mark on which an opposition against the registration of a Community trade mark is based.**

In those circumstances, the Court finds that, in finding that the sign 'F1', identical to the national trade marks of Formula One Licensing, was devoid of distinctive character, **the General Court called into question the validity of those trade marks in proceedings for registration of a Community trade mark** and therefore infringed the regulation on the Community trade mark<sup>3</sup>.

Therefore, the Court **sets aside the judgment of the General Court** and, since it is not in a position to give final judgment in the matter, refers the case back to the latter.

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**NOTE:** An appeal, on a point or points of law only, may be brought before the Court of Justice against a judgment or order of the General Court. In principle, the appeal does not have suspensive effect. If the appeal is admissible and well founded, the Court of Justice sets aside the judgment of the General Court. Where the state of the proceedings so permits, the Court of Justice may itself give final judgment in the case. Otherwise, it refers the case back to the General Court, which is bound by the decision given by the Court of Justice on the appeal.

**NOTE:** Community trade marks are valid throughout the European Union and co-exist with national trade marks. Applications for registration of a Community trade mark are sent to OHIM. Actions against its decisions may be brought before the General Court.

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*The [full text](#) of the judgment is published on the CURIA website on the day of delivery.*

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<sup>3</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended by Council Regulation (EC) No 1992/2003 of 27 October 2003 (OJ 2003 L 296, p. 1), ('Regulation No 40/94'). That regulation was repealed and replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. Nevertheless, in view of the time at which the events occurred, the present dispute is governed by Regulation No 40/94.