

April 3, 2020

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Your Reference: 1868569  
Our Reference: 12903 – TM114898CA01

Canadian Intellectual Property Office  
Place du Portage I  
50 Victoria Street, Room C-114  
Gatineau, Quebec K1A 0C9

**Attention: Judy Tom, Examination Section**

Dear Registrar:

Re: **Trademark: F1 Design**   
**Canadian Application No. 1868569**  
**Applicant: Formula One Licensing B.V.**

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This is in response to the Examiner's report dated October 3, 2019.

The Examiner has raised technical and substantive objections with respect to the subject application. We respectfully request that the objections be withdrawn for the reasons that follow.

### **Technical Objections – Paragraphs 30(2)(a) and 30(3)**

The Examiner has requested that certain goods or services be further specified in ordinary commercial terms and/or reclassified according to Nice Classification.

#### Gloves for protection against accidents

The Applicant respectfully submits that "*gloves for protection against accidents*" is already in specific and ordinary commercial terms and should not require further re-definition.

First, we submit that the Registrar has already determined that the description at issue is sufficiently defined as it allowed over 150 applications with the identical term to proceed to registration. Very recently, the following marks have issued:

- TMA1070342 for **WRANGLER**, which registered on January 21, 2020;
- TMA1069516 for **CLENA**, which registered on January 15, 2020;
- TMA1063335 for **MASKOON**, which registered on November 15, 2019; and
- TMA1056377 for **SF70H DESIGN**, which registered on September 26, 2019.

We respectfully request that the examiner treat the subject application consistently and withdraw the objection against this term.

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Next, section 29 of the *Regulations* requires that statements of goods or services must describe each of those goods or services in a manner that identifies a specific good or service. The *Trademarks Examination Manual* in particular states that it may be necessary to include the area of use of the good in order to specifically define a good.

Here, we submit that the phrase “for protection against accidents” obviates the area of use for “gloves”, which in itself, is a pre-approved term.

Finally, “gloves for protection against accidents” is described in a manner where it is possible to assess whether 12(1)(b) or confusion applies and ensures that the Applicant will not have an unreasonably wide ambit of protection. The description in contention therefore meets the tri-partite test set forth in the *Manual*. Accordingly, we ask that the Examiner withdraw its objection to this term.

With respect to the remaining terms that the Examiner has deemed to be insufficiently specific and/or has required re-classification, we enclose an amended application wherein the goods and services noted in the Examiner’s report have been further specified and/or reclassified. In addition, the Applicant has deleted some of the goods.

As all of the goods and services are now in specific ordinary commercial terms, and classified in accordance with Nice Classification, we respectfully request that these objections be withdrawn.

### **Substantive Objection – Paragraph 12(1)(d)**

The Examiner has objected to registration of the subject application due to a perceived likelihood of confusion with TMA633014 for F1 RACING & Design [reproduced below] owned by Autosport Media UK Ltd. (hereinafter, “Autosport”).



When assessing the likelihood of confusion, the appropriate question is whether, in all the surrounding circumstances, including those set out at section 6(5) of the *Trademarks Act*, a prospective purchaser would be led to the mistaken inference that the goods and services associated with the trademarks are manufactured, sold, leased, hired, or performed by the same person (See: *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22 at para 51). This typically requires consideration of the “first impression in the mind of a casual consumer somewhat in a hurry” (See: *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, 2006 SCC 23 at para 21). As the standard for confusion is on a balance of probabilities (See: *Christian Dior, S.A. v. Dion Neckwear Ltd.*, 2002 FCA 29 at paras 10-15), the Registrar need not be satisfied beyond doubt that confusion will not occur, but rather that confusion is unlikely.

We respectfully submit that confusion as to the source of the goods/services is highly unlikely due to differences in the appearance, sound and ideas suggested of the marks, and in view of all the surrounding circumstances. In view of the following submissions, and particularly in view of the **consent** that has been provided by Autosport, we respectfully request that the confusion objection be withdrawn.

First, the marks are different in overall appearance, sound and idea suggested. The overall design elements of each mark can be distinguished. The subject mark is comprised of three thick, long bold lines in a backwards-sloping angle which together, form a unique, stylized letter F and a symbol representing an “1” or number 1. When viewed as a whole, the entire shape of the subject mark resembles a parallelogram with thin white lines intersecting in the middle. In contrast, the cited mark is comprised of a nondescript letter “F” written in black, and the white-colored number 1 within a black circle design. The circle element of the cited mark places emphasis on the number “1”. In addition, the cited mark includes the word RACING, which differentiates it from the subject mark in appearance and sound. The cumulative differences between the marks at issue indicates that the ordinary consumer would not, as a matter of first impression, be likely to think that the goods associated with the cited mark would emanate from the same source as those associated with the Applicant’s well-known trademark, or vice versa. As the overall commercial impressions of the marks at issue are entirely distinct, we submit that there is no reasonable likelihood of confusion between the parties’ marks.

Second, as noted above, section 6 of the *Trademarks Act* requires the Registrar to consider all the surrounding circumstances in assessing confusion, and the Supreme Court in *Masterpiece v. Alavida* (2011) 92 C.P.R. (4th) 361 (SCC) has advocated a “common sense” approach to confusion. To that end, we enclose a consent letter signed by Tim Chadwick, the Director of Autosport, wherein the owner of the cited mark **consents** to the use and registration of the subject mark in Canada. The fact that the parties have consented to co-existence is a surrounding circumstance that should be given significant weight, and common sense should dictate that, if the parties are prepared to co-exist, confusion between the marks is unlikely.

As set out in the attached agreement, the Applicant had initially agreed to the registration of Autosport’s F1 Racing logo in Canada pursuant to a co-existence agreement. The co-existence continues to this day and Autosport in particular has disclaimed the words “F1 RACING” apart from the trademark.

The parties have also agreed acknowledged that the visual differences between the parties’ respective marks are sufficient to alert consumers that the source of the goods/services are different.

In addition, as noted in the agreement, the trademarks of the parties have co-existed for over 22 years without any known instances of confusion. As noted by O’Reilly J. in *Micro Focus (IP) Ltd. v Information Builders, Inc.* (2014) 126 CPR (4th) 321 (FC), the admission of the parties in a co-existence agreement regarding the lack of any evidence of

consumers actually being confused about the source of the parties' respective wares or services is "significant on the issue of confusion".

In that respect, the respective owners of the marks are two large, reputable and sophisticated companies that are experienced in marketing consumer goods, and differentiating their products. They are well aware that they must each ensure that consumers are readily able to differentiate the source of goods and services associated with their marks and will take necessary steps to avoid confusion. This surrounding circumstance in assessing confusion is particularly important, in light of the Federal Court decision of *John E. Fetzer, Inc. v. Tiger Brand Knitting Co.* (1989) 26 C.P.R. (3d) 551 (FCTD) where Jerome A.C.J., held at p. 554 that "the primary focus must be on the likelihood of confusion and the motive of any party is never more than a minor or secondary consideration. In the final analysis, however, no judgment can be made without an appreciation of the manner in which the competing parties intend to market their products. Evaluation of the likelihood of confusion cannot be done in a vacuum. The marks and the products have to be viewed through the eyes of the ordinary consumer which brings into play the intention of the parties in terms of channels of distribution and marketing strategy" [emphasis added].

Accordingly, given that both the Applicant and Autosport have agreed to co-existence and both parties intend and have taken steps to distinguish and market their goods in a manner that would avoid confusion between the marks, and protect their respective interests, we respectfully submit that the Applicant's mark should be allowed to co-exist with the cited mark on the Register.

Finally, we wish to draw the Examiner's attention to the fact that the cited mark *already* co-exists with four other marks with "F1" owned by the same Applicant, including F1 by itself, as shown below.

Trademark	Status	Goods and Services	Owner
F1	Registered App 1488076 App 09-JUL-2010 Reg TMA1031976 Reg 25-JUN-2019	...downloadable electronic periodical publications; ... (8) Paper pennants, wrapping paper, cardboard boxes, corrugated cardboard containers; printed matter, namely printed awards, printed tags, printed timetables; photographs; stationery, namely stationery agendas, stationery binders, stationery labels; paint brushes; typewriters; ... brochures; bumper stickers; business card holders; business cards; calendars; cards namely gift cards; catalogues; marking chalk; charts; checkbooks; clipboards; colouring books; comic books; ... printed advertising flyers; ... guidebooks; handbooks, namely manuals; ...newsletters; newspapers; ... souvenir programs; reference books;...	Formula One Licensing BV
	Registered App 1488078 App 09-JUL-2010 Reg TMA903627 Reg 14-MAY-2015	... printed matter namely, printed tags, printed timetables; plastic materials for packaging namely, plastic bags; annuals; autograph books; booklets; books; books for children; boxes of cardboard or paper; desk accessories made of leather, namely notepaper folders; drawing instruments, namely pens and pencils; drawing pads; printed advertising flyers; guidebooks; handbooks, namely manuals; headed letter paper; labels, not of textile; leaflets; note books;...	Formula One Licensing BV
	Registered	(1) Activity books, address stamps, addressing machines, adhesive	Formula One

Trademark	Status	Goods and Services	Owner
	<b>App</b> 1471704 <b>App</b> 03-MAR-2010 <b>Reg</b> TMA935884 <b>Reg</b> 25-APR-2016	for stationery or household purposes, office requisites namely, adhesive tape dispensers, advertisement boards of paper or cardboard, albums, almanacs, annuals, namely, annually printed programmes, magazines, books, autograph books, ...books, books for children, ... brochures, ... catalogues, ...guidebooks, manuals namely, handbooks, . periodicals namely, magazines, handbooks namely, manuals, geographical maps, ...newsletters, newspapers, pen nibs, non-...photographs,...	Licensing BV
	Registered <b>App</b> 1191153 <b>App</b> 18-SEP-2003 <b>Reg</b> TMA882258 <b>Reg</b> 16-JUL-2014	... printed programmes for motor races; tickets; headed letter paper; ...	FORMULA ONE LICENSING B.V.

As the Applicant already owns a family of registered “F1” marks with publications and printed matter and the cited owner has disclaimed any rights to the term “F1 RACING”, we respectfully submit that the subject mark be afforded comparable treatment and be allowed to co-exist on the Register as well.

In view of the foregoing submissions, we respectfully request that the confusion objection be withdrawn and the application proceed to advertisement.

Respectfully submitted,

BERESKIN & PARR LLP/S.E.N.C.R.L., s.r.l.



Wynnie Chan / Suzie Suliman

Encl.