

Who is “Hamilton”? Lessons learned in evaluating evidence

30 November 2023

In its decision of 17th October 2023¹, the First Board of Appeal of the EUIPO (‘BoA’) confirmed the Opposition decision in the ‘**Lewis Hamilton**’ case, which had allowed the opposition filed against the application of 44IP Limited who was acting for the well-known F1 driver, Lewis Hamilton, for the registration of the mark ‘LEWIS HAMILTON’ in relation to certain goods in class 14 and services in class 35. The opposition had been filed by the Swiss watch manufacturer Hamilton International AG, the proprietor of the famous earlier mark ‘HAMILTON’ which is registered in relation to goods in classes 9 and 14 (which included jewellery and watches).

In reply to the notice of opposition the applicant claimed that there could not be any likelihood of confusion as Lewis Hamilton (‘LH’) was a **well-known person** in the world of Formula 1 and due to him being a recognizable figure, any recognition would ‘neutralize’ any similarity with other signs and thus eliminate the risk of any confusion. To this effect the applicant had filed voluminous amounts of evidence to prove LH’s reputation.

The BoA reiterated established case law confirming that ‘famous persons’ enjoy ‘special protection’ when applying for trade marks. In particular, in so far as their name is recognizable, it has the effect of *neutralizing* any similarity it may have with other earlier signs, which under normal circumstances, would lead to a likelihood of confusion².

The decision is important as it illustrates once more the rules applied by the BoA when assessing evidence submitted in order to prove a claim of reputation of an allegedly ‘well-known person’ within the EU. The decision is also important in reiterating that an allegation of there being a likelihood of confusion encompasses both the risk of the relevant consumer confusing the two signs between them, as well as that of being confused into thinking that the two signs are linked to each other.

¹ [R336/2022-1](#)

² C-51/09 P Barbara Becker, T-212/09 Barbara Becker, C-449/18 P & C-474/18 P [MESSI/ MASSI], T-368/20 Miley Cyrus/ Cyrus et al.

The BoA made clear that any claim of one being a 'well-known' personality would be proven upon demonstrating with solid and adequate evidence that one is well-known across the *entire* EU and not only in part (albeit a substantial part) of the EU, since in this case the BoA had found that the goods in relation to which the mark applied for, were addressed to the general public and not only to a specialist public interested in motor sports. Thus, in this case where the applicant had failed to adequately prove that LH was a well-known figure amongst the general public in Bulgaria, Estonia, Croatia, Latvia and Lithuania also, the claim could not stand.

The BoA carried out an evaluation of the viewers of F1 races- how many were there and who were they- paying attention to the fact that a number of spectators watch the sport on site, whilst others on television. It made note further of the fact that in some Member States such sports events are only available via subscription television and are available to a limited pool of persons, whilst the number of spectators fluctuates from race to race and from year to year.

The evidence submitted was found lacking as regards statistical data for a number of EU Member States, such as Bulgaria, Estonia, Croatia, Latvia and Lithuania. Rather, the submitted evidence concerned only evidence of the number of viewers amongst the Spanish, Finnish, Austrian, German and French public and even the British public. These latter figures were ignored by the BoA as they did not represent a section of the public within the EU.

Moreover, the BoA made note of the fact that the evidence on viewers was not entirely reliable, as it related also to viewers of motorbiking or rally cross. The BoA focused its assessment on Bulgaria, Croatia, Estonia, Latvia and Lithuania, since these countries had the least connection with Formula 1, its drivers and constructors. Further, none of these countries had ever hosted a Formula 1 race, nor did any nationals or constructors from these countries ever participated in a Formula 1 event.

Another interesting aspect of the BoA's evaluation of the submitted evidence is that it noted that the evidence concerned fans of F1 generally. It noted that the evidence did not directly relate to LH, nor did it prove that the evidence submitted of viewers of F1 *necessarily* translated to a corresponding number of fans knowing of LH. It merely proved that they were made aware of F1 and/ or of Grand Prix races, but fell short of proving that this number of viewers also knew of LH.

The BoA also made note of the fact that most of the evidence submitted related to a period outside the relevant period (i.e. after the date of filing of the trade mark application), and as such, could not be relied upon; it would not be dismissed either however. Rather, the BoA could draw conclusions from it.

As regards evidence concerning website visits from different geographical areas, the BoA had two main comments to make: first, that the numbers presented were 'not impressive' (they were in the region of a few thousands, with the exception of Germany where the evidence submitted showed visits equal to 103,255). Secondly, the BoA commented on its estimation that the figures presented as 'website visits' should not be taken on their face value as it appreciated that it could not be safely assumed that all the visits came from different persons each time.

The BoA in evaluating the social media evidence filed, commented on (i) the temporal element of the evidence noting that the evidence concerned a period outside the relevant one, (ii) the fact that the evidence did not distinguish between the different regions nor individual countries that it emanated from and (iii) that unlike Lionel Messi's dizzying popularity demonstrated by the 106 million followers, LH's 6 million followers paled in comparison and could hardly be considered as rendering him a 'well-known figure'.

The BoA adopted a pragmatic approach in its evaluation of the evidence submitted concerning Instagram and X followers. It noted that the submitted figures concerning X followers for Germany, France and Italy were exactly the same and this also applied for the submitted figures concerning Instagram followers for Germany, France, Spain and Italy. It considered this 'coincidence' as proof of the figures being unreal and concluded that 'the information is unreliable and must go to the detriment of the applicant'.

The BoA also commented on the fact that the Instagram figures which were the highest were the ones relating to the UK and not to any of the EU Member States, i.e. they related to an irrelevant jurisdiction which could not and was not taken into consideration.

As regards the evidence on published books, it is interesting to note that the BoA, despite noting the 'quite impressive' number of books published on Hamilton, it did not fail to note that nevertheless, this evidence (a) would probably only indicate that a number of specialised consumers (i.e. F1 fans) may have become aware of the books- as opposed to members of the general public acquiring exposure to them, (b) was not accompanied

by evidence concerning sales figures for these books and (c) most of the books in question were in English, thus would very likely remain unread by the general public in a number of countries in the EU, such as Bulgaria, Estonia, Croatia, Latvia and Lithuania, in relation to which the BoA expressed the view that the general public may have a cursory knowledge of English and would very much unlikely be in a position to read an entire book from beginning to end in English.

In assessing evidence of newspaper and magazine articles, the BoA's assessment was equally scathing, stating that despite their volume being 'impressive', their content was not 'at all impressive'! The BoA pointed out the shortcomings of this voluminous evidence stating that information should have been submitted to prove whether these articles had been directed to the general public or to specialist consumers, how many of these articles had been sold, and details of their distribution to the general public and online.

As regards digital articles, evidence should have been provided not only of the mere existence of the articles, but also of the number of accesses to the articles as well as the time spent on each article in order to sift out any bot access to render the figures reliable (i.e. take into consideration only genuine, human access). The BoA also noted that only relevant articles would be taken into consideration, i.e. ones which related directly to LH and not generally to F1 or not even to F1.

The treatment of the evidence concerning advertisements and endorsement contracts is also of notable mention. In particular, as regards the evidence on the joint endorsement of fuels and lubricants by LH and his team, the BoA noted that this evidence did not actually prove that it had any influence on the *general public* at all, which is the purpose for which evidence was submitted after all. This conclusion was drawn on the basis that the undertaking from which the fuels and lubricants emanated from did not address the public at large.

The same comment was made of insurance contracts and a hotel chain: none of these undertakings could be said with certainty to have reached out to the general public and if so, there was no proof of how the public had perceived these endorsements. As regards two contracts with luxury watchmakers, the BoA again questioned their relevance since, by themselves, could not be used to prove whether they had reached the general public.

Evidence was submitted to show that LH was ranked the 'world's most marketable athlete for 2014'. In spite of the seemingly 'global' reach of this accolade, the BoA treated it with skepticism pointing out that this ranking did

not allow for any conclusions to be drawn with respect to the perception of the public in the aforementioned countries- Bulgaria, Estonia, Croatia, Lithuania and Latvia. It commented that despite the all-encompassing nature of this ranking, the fact remained that a person may be easily marketable in one market but hardly at all in another.

The BoA in its concluding remarks on the evidence submitted to prove the claim that LH was a 'well-known figure', stated that the perception of the public in the EU was not homogeneous and thus, it was not possible to draw conclusions in the absence of specific and relevant evidence how LH was perceived in one Member State on the basis of his perception in another Member State. The BoA conceded that the evidence could be sufficient to prove that LH was famous in the UK (and as such, irrelevant to the case at hand), and less so in Germany, Spain, France and Italy. It was not convinced that the general public in Bulgaria, Estonia, Croatia, Lithuania and Latvia would recognize him as a famous sportsman by the vast majority thereof. These latter 5 countries together constituted 1/5 of the Member States of the EU, which translated to 8% of the size of the EU and approximately 5% of its population; as such, the BoA concluded that this was not a 'negligible part of the European Union' which could be ignored.

On the basis of the evaluation of the evidence submitted as outlined above, the BoA concluded that the opposition decision could be endorsed and the application dismissed. The BoA's treatment of the submitted evidence illustrates how important it is for applicants to ensure that any evidence submitted is carefully selected and presented, such that (a) it concerns the essential point in time for which one submits evidence, (b) it is relevant in proving the point at hand, e.g. in this case that the general public in the entire EU was in a position to recognise LH as a well-known person.

Submitted evidence must be credible and go directly in proving specific facts. Submissions of voluminous evidence (notably, in this case the applicant had submitted around 6,000 pages of evidence!) which is irrelevant, vague, general, insufficiently precise and/ or incredulous, may work against any party and fail to assist in proving a claim.

The collation and evaluation of evidence is an important, arduous and challenging task which parties should go through in a painstaking fashion and not underestimate. Applicants should strive to present evidence in the most

efficient and relevant manner in order to assist the Office in its evaluation and assessment as well as to convince it of the claims in support of which it is submitted in the first place.

Indeed, as this case demonstrates, despite the heaps of evidence submitted, the applicant had failed to prove that LH was a 'well-known figure' in the European Union and thus the mark was unable to neutralize any likelihood of confusion with the earlier mark. The BoA even went as far to state the 'easiest way' of proving that LH was a well-known figure in the EU: via a **survey** conducted before the application date of the mark, covering all the EU Member States.

On a separate note, it is interesting to mention that the BoA expressed the view that even if LH had been proven as being famous throughout the EU, since on the basis of the evidence submitted it had been shown that LH was known by his surname alone- 'Hamilton' (rather than by the full name 'Lewis Hamilton'), a likelihood of confusion could still be found with the earlier 'Hamilton' mark since likelihood of confusion also encompasses the likelihood of association: consumers could be confused into thinking that the earlier mark was endorsed by LH. On this point the BoA distinguished the earlier cases of Barbara Becker and Miley Cyrus as in both of these cases the famous persons were found to be known by their full names and not only by their last names.

This decision is also interesting in understanding the scope of application of Article 14(1)(a) of the EU Trade Mark Directive. Per 14(2) EUTMD, the exception would only apply where the *use* (not the registration) made by the third party would be in accordance with 'honest practices in industrial or commercial matters'. The question thus arises 'what would constitute 'honest practices in industrial or commercial matters''. Per the Court of Justice's judgment in T-863/19, the said exception would not allow one to register a name/ surname as a trade mark, where such registration would lead to a likelihood of confusion with an earlier mark; this would tantamount to a violation of 'honest practices in industrial or commercial matters'.

Thus, LH in this case, could not register his name as a trade mark in the absence of proving that he was a well-known person, as this would lead to a likelihood of confusion with an earlier mark, even if this was in the form of a likelihood of association.