



FACULTY OF LAW
Lund University

Martina Vivlund

The Protection of Event Marks

An analysis of the registrability of valuable trademarks
associated with major sporting events

JAEM03 Master Thesis

European Business Law
30 higher education credits

Supervisor: Ulf Maunsbach

Term: Spring 2013

Contents

SUMMARY	1
SAMMANFATTNING	3
PREFACE	5
ABBREVIATIONS	6
1 INTRODUCTION	7
1.1 Background	7
1.2 Purpose	8
1.3 Method	8
1.4 Material	9
1.5 Delimitations	10
1.6 Outline	12
2 THE COMMUNITY TRADEMARK PROTECTION	14
2.1 Grounds for Refusal	14
2.1.1 Absolute Grounds for Refusal	15
2.1.2 Non-Distinctive and Descriptive Marks	15
2.1.3 Case Law	17
3 THE OLYMPIC SYMBOLS	21
4 PROTECTION OF EVENT MARKS	23
4.1 Event marks	23
4.2 Case Law on Event Marks	24
5 THE ALTERNATIVE TO AN EXTENDED PROTECTION	28
5.1 London Olympic Games and Paralympic Games Act 2006	28
5.2 Sydney 2000 Games (Indicia and Images) Protection Act of 1996	31
5.3 The World Cup 2010	32
5.4 Framework of Protection to Event Organizers in Brazil	34
5.5 Other Major Sporting Events	36

5.5.1	The Commonwealth Games	37
5.5.2	New Zealand	39
5.6	Summary – the Common Denominators of the Extended Protections	41
6	ANALYSIS	42
7	CONCLUSION	49
	BIBLIOGRAPHY	51
	TABLE OF CASES	54

Summary

Trademark law is a dynamic area of law that changes as societies perception of the mark and its features change. Over the past few years, the trend has been to strengthen the position of the trademark proprietor by expanding their possibilities of obtaining a trademark registration together with the strengthening of the already registered marks. However, according to the trademark law of the European Union a trademark will not obtain such a registration if the mark lacks distinctive character and is descriptive of the goods or services for which the mark is applied as this means that it cannot fulfill the essential function of a trademark, to act as an indication of origin.

There are several issues regarding the provisions governing the criteria for registration. While some of the issues have been resolved, many uncertainties still remain. Even if the grounds of distinctive character and descriptiveness are to be seen as two separate provisions, they are often applied cumulatively, which means that a mark will often be rejected based on more than one ground. Two tests, the distinguishing and protective functions, have been identified as underlying the application of these absolute grounds for refusal. However, the European Court of Justice has not been wholly consistent in its approach to what the governing test for registration should be. Even though it has had plenty of opportunities to explain the proper means of the interpretation of the distinctiveness grounds for refusal, it has continuously failed to establish an overarching framework for the operation of the distinctiveness test. Various scholars have been discussing the subject and it has been suggested that the provisions should be seen as interdependent rather than independent and that the provisions, taken collectively, are intended to serve either a distinguishing function alone, or, in addition, a protective function.

Major sporting events have become a huge business on the international market by attracting the attention of a global audience of billions of spectators, which in turn generates huge amounts of money by the accumulated awareness. Throughout the years, companies have tried to take advantage of this awareness by creating an association between their businesses and the event marks. These associations are sometimes authorized but a fair market strategy to obtain the valuable association is not always used. To prevent such abuse, the International Olympic Committee has subsequently taken steps throughout the years to protect the valuable identifications, such as the 'City + Year' identifications, likely to be associated with the sporting events. In some situations, traditional legal measures are not sufficient to tackle the most complex abuses, which have led to the enactment of the so-called *sui generis* protection by the host countries of the events, a form of protection that is complementary to the traditional legal measures. Whether it is possible to register event marks as protected trademarks has been discussed in a number of court decisions, since they actually lack the distinctiveness needed. It has been argued that

these marks should fulfill the same requirements as ordinary trademarks in order to obtain a registration. However, due to the big economic value of the event marks they become important to protect in order not to jeopardize the future of the sporting events, which makes the marks eligible for registration in many cases. Consequently, it is very important to strike a balance between the protection of trademarks that fulfill the requirements needed and the protection of the valuable event marks, which means that a temporary extended protection like the event-specific legislations enacted by the host countries before the major sporting events would be a fair solution.

Sammanfattning

Varumärkesrätten är ett dynamiskt rättsområde som förändras i takt med att samhällets syn på varumärket och dess funktioner förändras. Trenden har under de senaste åren varit att stärka varumärkesinnehavarens ställning genom att utvidga dennes möjligheter att erhålla skydd för sina kännetecken samt att skyddet för befintliga varumärken har stärkts. Varumärkesrätten inom Europeiska Unionen förbjuder emellertid registrering av varumärken som saknar särskiljningsförmåga och är beskrivande för de varor eller tjänster för vilka varumärket har ansökts då detta innebär att de inte kan uppfylla dess grundläggande syftet, nämligen att indentifiera ursprung.

Flera frågor gällande bestämmelserna som reglerar kriterierna för registrering existerar. Medan vissa frågor har blivit lösta återstår fortfarande många osäkerheter. Även om bestämmelserna gällande särskiljningsförmåga och 'icke beskrivande karaktär' anses vara två separata bestämmelser tillämpas de ofta kumulativt, vilket innebär att ett varumärke oftast avslås baserat på mer än en grund. Två test, den särskiljande och den skyddande funktionen, har konstaterats ligga till grund för tillämpningen av dessa absoluta registreringshinder. Emellertid har EU-domstolen inte varit konsekventa i sin syn på vilket det styrande testet för registrering bör vara. Även om flera tillfällen har givits domstolen att redogöra för en korrekt bedömning av särskiljningsförmågan och grunderna för avslag, har man kontinuerligt misslyckats med att inrätta en övergripande ram för detta test. Frågan har diskuterats bland forskare och det har föreslagits att bestämmelserna bör ses som ömsesidigt beroende snarare än oberoende av varandra och att bestämmelserna är avsedda att tjäna enbart en särskiljande funktion eller också en skyddande funktion.

Stora idrottsevenemang har på senare tid kommit att anses vara något stort och värdefullt på den internationella marknaden då de fångar uppmärksamheten hos en global publik bestående av miljarder av åskådare, vilket i sin tur genererar enorma summor av pengar genom en ackumulerad kännedom. Företag har under flera år försökt dra nytta av denna kännedom genom att skapa en association mellan deras verksamheter och evenemangets varumärken. Dessa associationer är ibland auktoriserade men det är inte alltid som en rättvis marknadsföringsstrategi används för att erhålla den värdefulla associationen. För att förhindra sådant missbruk har Internationella Olympiska Kommittén de senaste åren jobbat för att skydda de värdefulla identifikationerna som med stor sannolikhet kommer förknippas med ett idrottsevenemang, så som 'Stad + År' identifikationer. I vissa fall är traditionella juridiska åtgärder inte tillräckliga för att lösa dessa komplexa missbruk vilket har lett till att värdenationerna antagit så kallad *sui generis* skydd, ett skydd som är ett komplement till de traditionella juridiska bestämmelserna. Huruvida det är möjligt att registrera evenemangsvarumärkena som skyddade varumärken har diskuterats i ett antal domstolsbeslut där man bland annat diskuterat märkenas avsaknad av

särskiljningsförmåga. Man hävdar att dessa märken bör uppfylla samma krav som vanliga varumärken för att kunna erhålla en registrering. På grund av evenemangens stora ekonomiska värde är det däremot viktigt att skydda dessa märken för att inte äventyra idrottsevenemangens framtid, vilket gör att märkena i många fall bör kunna registreras. Därför är det oerhört viktigt att hitta en balans mellan skyddet för de varumärken som uppfyller kraven för registrering och skyddet av de värdefulla evenemangesvarumärkena, vilket innebär att ett tillfälligt utökat skydd, så som evenemangsspecifika lagar som antas av värdnationerna, skulle vara en rättvis lösning.

Preface

Writing a Master thesis is not an easy task and during these past five months has been like an emotional roller coaster. Without the support of friends and family, this trip would have been much harder and I am very grateful for all the inspiration and positive words they have given me along the way.

I would like to give a special thank you to my supervisor Ulf Maunsbach for inspiring conversations and good feedback during the writing process. I am further grateful to Ross Watson for reading through my thesis making sure that I used a correct language.

Last but not least, I would like to thank my amazing friend Maja Björkengren who believed in me every step of the way and stood by my side even during the darkest of days encouraging me with positive words and inspiration.

It has been a challenging, and at times stressful, journey but I am extremely proud to be able to say that I finally made it.

'Success is the sum of small efforts, repeated day in and day out'
- Robert Collier

Abbreviations

AG	Advocate General
BIPL	Brazilian Industrial Property Law
BSA	Brazilian Sports Act (the Pelé Law)
CJEU	Court of Justice of the European Union
CFI	European Court of First Instance
CTMR	Community Trade Mark Regulation
EU	European Union
FIFA	Fédération Internationale de Football Association
GC	General Court
GCGA	Glasgow Commonwealth Games Act
IOC	International Olympic Committee
LOCOG	London Organizing Committee of the Olympic Games
LOGPGA	London Games and Paralympics Games Act of 2006
MCGPA	Melbourne 2006 Commonwealth Games (Indicia and Images) Protection Act 2005 (No. 68)
MEMA	Major Event Management Act 2007 (no.35)
NOC	National Olympic Committee
OHIM	Office for Harmonization in the Internal Market
OSPA	Olympic Symbols etc. (Protection) Act 1995
TMD	Trade Mark Directive
SGPA	Sydney 2000 Games (Indicia and Images) Protection Act of
The Treaty	the Nairobi Treaty
UK	United Kingdom
US	United States of America
WIPO	World Intellectual Property Organization

1 Introduction

1.1 Background

Throughout the years, big sporting events like the Olympic Games and the Fédération Internationale de Football Association (FIFA) Soccer World Cup have become big business. With their increasing popularity, these major events generate huge amounts of money by building awareness through attracting billions of spectators from a global audience. This, in turn, attracts companies which are eager to associate their trademarks with the events, to create emotional attachment and to get people to talk about and buy their products.

One event, one platform, one message and one organization with all of its branding makes the Olympic Games the most extensive sports marketing alliance ever seen. In 1993, before Sydney was elected to host the 2000 Olympic Games, a third party filed for registration of all the names of the candidate cities for the 2000 Olympic Games. When Sydney was elected, this party threatened the International Olympic Committee (IOC) with legal actions if they used these city references. To prevent similar future abuses, the IOC has subsequently taken steps throughout the years to protect the 'City + Year' identifications, well before a city is elected to host an edition of the Olympic Games. However, this has been discussed in a number of Court decisions where they called into question the distinctive character of a trademark composed of a city and a year.¹

Following this, problems have arisen about whether it is possible at all to register event marks due to the fact that they lack the distinctiveness needed. However, it has been discussed that the big economic value of the event marks is a very important aspect to protect and therefore registration has been approved in many cases. Therefore, it is important to try to strike a balance between the protection of trademarks that fulfill the requirements needed and the protection of the valuable event marks.

The idea of a single unitary Community trademark system was conceived as early as the 1960's. Preliminary proposals were prepared in 1964 but it was not until the 20th December 1993 when the European Council issued the Council Regulation (EC) 40/94 on the Community trademark, which came into force on 15th March 1994. It was supposed to establish a unitary system for registration of trademarks throughout the European Union (EU). This regulation was later replaced by Council Regulation 207/2009 of 26th

¹ OHIM First Board of Appeal, decision R 1467/2005-01 - GERMANY 2006 (20 June 2008), [hereafter: GERMANY 2006].

February 2009 (the CTMR), which came into force on 13 April 2009 and is the latest version used today.²

The CTMR regulates the creation and protection of a supra-national Community trademark which is effective throughout the territory of the Member States of the EU. The thought behind the introduction of the CTMR was to try to simplify the registration procedures of trademarks within the EU, which led to the fact that now only one application needs to be made in order for a trader to obtain a trademark registration in each of the Member States.³

1.2 Purpose

The aim of this thesis is to analyze the distinctiveness provision in Article 7(1)(b) CTMR as applicable to the registration of word marks as trademarks and, through that, to identify whether or not a ‘City + Year’ identification is given a special protection because of the worldwide interest of sporting events. The situation within the European Union (EU) and the Office of Harmonization for the Internal Market (OHIM) will be analysed together with a comparison in relation to international case law.

The issue in question, on which the thesis is based, is to investigate under what circumstances an exception from the fulfillment of the required distinctive character can be made.

This thesis also aims to identify in what way the trademarks belonging to different sport organizations are regulated within the field of law.

Finally, an investigation regarding the justifications of the protection of a trademark consisting of ‘City + Year’ will be conducted.

1.3 Method

This thesis will be focused on European trademark law. The case law of the Court of Justice of the European Union (CJEU), the General Court (GC) and the Board of Appeal of the OHIM will be the starting point, which will be complemented by relevant sources of law and legal doctrine. This means that a legal dogmatic approach will be the main method used throughout the thesis.

² Firth, Alison., Lea, Gary., Cornford, Peter., *Trade Marks, Law and Practice*, 3rd edition, 2012, Jordan Publishing Ltd., p. 285, [hereafter: Firth *et al*].

³ MacQueen, Hector., Waelde, Charlotte., Laurie, Graeme., *Contemporary Intellectual Property – Law and Policy*, 2008, Oxford University Press Inc., New York, p. 550-553, [hereafter: MacQueen *et al*].

By applying for a trademark registration, one can obtain a special intellectual property protection. The main reason for such a trademark registration application is to protect the substantial value found in a trademark. Taking into account that the official sponsors pay huge amounts of money in order to associate their businesses with the major sporting events, and as this is the main financial source for the event organizers, it puts a great economic value to the ‘City + Year’ identifications and other marks that can be associated with the events. By this reason an economic perspective will be attached in combination with the above-mentioned method when discussing the registrability of such marks.

1.4 Material

As stated, case law from the CJEU, GC⁴ and the OHIM will be used as a starting point when analysing the different provisions within the EU legislation. The focus within this thesis will be on the provisions within Article 7(1) CTMR, which states the absolute grounds for refusal of a trademark application. Another important provision is Article 7(2) CTMR, which states that it is not necessary that the grounds of Article 7(1) CTMR are applicable throughout the whole Community. It is sufficient for non-registrability that they are applicable in only parts of the Community.⁵ Article 7(1)(b) CTMR will be referred to as the provision on distinctiveness, Article 7(1)(c) CTMR as the provision on descriptiveness and Article 7(3) CTMR as the provision on how to acquire distinctiveness through use. The thesis will also touch upon Article 15 CTMR, which refers to the use of a registered Community trademark.

As a complement to the case law, further inspiration will be gathered from legal literature together with relevant articles from esteemed law journals within the field of Intellectual Property Law, such as the European Intellectual Property Review and the Journal of Intellectual Property Law & Practice.

The Olympic Charter and the Nairobi Treaty will be used when analysing the protection of the Olympic properties. These two international legislations are to be found at the official websites of the Olympic Movement⁶ and of the World Intellectual Property Organization (WIPO).⁷

Special national legislations will be used in order to analyse the justification of the protection of the ‘City + Year’ identifications. These legislations are

⁴ The latest abbreviations of the courts, namely CJEU and GC, will be used throughout the thesis even if the court cases, that will be analyzed later on, are from the time when the courts were abbreviated as ECJ (European Court of Justice) and CFI (Court of First Instance).

⁵ Case C-383/99 P *Procter & Gamble CO v. OHIM*, [2001] ECR I-06251, para. 41, [hereafter *Baby-Dry*].

⁶ http://www.olympic.org/Documents/olympic_charter_en.pdf.

⁷ http://www.wipo.int/treaties/en/ip/nairobi/trtdocs_wo018.html.

the Sydney 2000 Games (Indicia and Images) Protection Act of 1996, the London Olympic and Paralympic Games Act 2006 and a number of other national legislations concerning the protection of the ‘City + Year’ identifications in relation to various major sporting events around the world. These various legislations are all national. Consequently, it is a national question to assess the status of such legislative acts. For the purpose of this thesis, I regard the provisions as binding instruments within the jurisdiction in which they apply. The main reason for me to use this material is to show how the concrete issues concerning the registration of marks consisting of ‘City + Year’ identifications are in fact handled during the various events.

1.5 Delimitations

Even if the CJEU most often refers to provisions from the TMD when dealing with trademarks, the focus in this thesis will be on analysing the provisions within the CTMR. This does not mean that the outcome would have been different if an examination of the relevant provisions of the TMD was made, since there are specific provisions within the two regulatory frameworks that are identical. The provisions dealt with in this thesis are of that kind, which means that the conclusions will be equally applicable to the TMD.⁸ As the focus within this thesis will be on the provisions within the CTMR, if nothing else is stated when referring to other articles, hereinafter it is the CTMR that is referenced.

The main focus will be on analysing the provision of distinctiveness found in Article 7(1)(b) CTMR. Therefore, a discussion about the relative grounds of refusal found in Article 8 CTMR will be outside the scope of this thesis. Since it is often stated that the provisions of distinctiveness and descriptiveness are to be examined together, the thesis will also address descriptiveness in Article 7(1)(c) CTMR to some extent.

The assessment of the registrability of a trademark is often linked to the question of trademark infringement. An attempt to register a new trademark is in this sense viewed as an infringement of a trademark that already exists. This means that when discussing registrability, cases concerning trademark infringements will be examined in relation to the discussion regarding registrability of word marks. The provision that regulates trademark infringements is to be found in Article 9 CTMR. As indicated, this provision will not be examined on its own, but will be covered indirectly when infringement cases are used in order to analyse the registrability of word marks and the ‘City + Year’ identifications.

Even though the subject of this thesis will involve aspects that have international implications, the discussion will mainly focus on the community level. However, in order to compare different views and to be able to make an extensive analysis, some international aspects might be

⁸ AG Jacobs in Case C-191/01 P *Doublemint*, para.16.

touched upon within the discussions. Furthermore, a detailed discussion regarding the problems of ‘ambush marketing’⁹ when hosting a major sporting event will not be covered by this thesis as such but may have to be touched upon in the analysis of the registration of non-distinctive word marks such as the ‘City + Year’ indications.

During the writing process, the assumption will be that the reader of the thesis will have a basic knowledge within the field of European Intellectual Property Law. This means that the most basic elements of the subject in question will not be discussed in depth, but merely be mentioned for a better understanding.

In addition to the different grounds for refusal, a trademark might come across other obstacles during its life time. Even if the proprietor has obtained a valid trademark registration, and through that an indeterminate monopoly in the trademark, there are a number of situations when a registered trademark can be revoked. If a registered trademark has not been put to genuine use for a period of five years since the registration, the trademark in question might be subjected for revocation in accordance with the ‘use’-provision found in Article 15 CTMR. Genuine use means that the trademark is used to guarantee the origin of the goods and services ‘for which it is registered in order to create or preserve an outlet for the goods’¹⁰. What is required to reach the level of genuine use has not been defined and the CJEU has held that there is no fixed *de minimis* level which the court uses to determine if there has been genuine use. The main question is whether such use serves a real, commercial purpose.¹¹

A discussion regarding the requirement to use the registered trademark could be included in the analysis concerning the protection of the ‘City + Year’ identifications, as a registration of these trademarks is sought long before the trademark is actually put to use. However, this aspect will not be covered within this thesis, except where relevant for the analysis of the provisions under review, since the main focus will be on the complexity surrounding the registration procedure.

In the adoption of new legislation, it is important that the legislators take into consideration the various interests that can be affected by the enactment of the new legislation. The interest of preventing anti-competitive behavior and the protection of freedom of expression are two interests that should be taken into consideration when it comes to the enactment of the extended event-specific legislations. An in-depth discussion regarding these two

⁹ For more information regarding the protection of event marks and the problematic of ambush marketing read the following article: Vivlund Martina. *Event Marks: Trademark Abuse or Necessary Form of Protection in View of Ambush Marketing*, 2012, Lund Student EU Law Review, available at: [http://www.jur.lu.se/Quickplace/eu_law_review/Main.nsf/0/BE6BEFE32576AABCC125799E00316E6D/\\$file/Volume%201%20Full%20Version.pdf](http://www.jur.lu.se/Quickplace/eu_law_review/Main.nsf/0/BE6BEFE32576AABCC125799E00316E6D/$file/Volume%201%20Full%20Version.pdf), last visited: 2013-04-22.

¹⁰ Davis, Jennifer. *Intellectual Property Law*, 4th edition, 2012, Oxford University Press, p. 248, [hereafter: Davis].

¹¹ *Ibid*, p. 247-248.

interests will not be conducted, but they will be included in the analysis when discussing the justifications of the extended protection regarding the ‘City + Year’ identifications.

I have noted that the European Commission has delivered a proposal¹² to amend both the CTMR and the TMD but have chosen not to take the proposal into consideration since it merely is a suggestion of changes that can be made. However, after have read the draft I conclude that the proposed amendments would not affect this thesis and have therefore chosen to disregard the proposal.

1.6 Outline

In order to put the provisions of Article 7 CTMR in their right context, chapter two starts with a short description on how to define a trademark and what formal requirements that needs to be fulfilled in order to obtain a Community trademark registration. The relationships and objectives of Article 7(1)(b)-(c) CTMR will be analyzed particularly through relevant case law and various scholarly articles. A number of case reviews will show how to interpret these criteria and how the Court evaluates a registration decision.

Chapter 3 describes the protection of the various Olympic properties protected by the Nairobi Treaty and the Olympic Charter. This chapter is mainly intended to point out the importance of protecting such valuable marks, symbols and terms that are associated with a major sporting event.

Chapter 4, which is the main chapter of this thesis, contains a thorough analysis of the event marks together with a review of the relevant case law in order to conduct a better discussion concerning trademark registration of a ‘City + Year’ identification.

In chapter 5 follows an overview in regards of various event-specific legislations, which provides the event marks, such as ‘City + Year’ identifications, with a protection going beyond the ordinary trademark protection. Not only are the event-specific legislations regarding the Olympic Games included, but also specific legislations in relation to other major sporting events in order to compare the various protections. There is a link between chapter 4 and 5 since the event marks described in chapter 4 are the properties that the event-specific legislations are aiming to protect.

Chapter 6 will then conclude the thesis with an analysis and critique of the event marks and their extended protections. This critique will be conducted primarily through close reading of the case law concerning the problematic of the protection of event marks, but will also be based on legal doctrine and scholarly articles.

¹² http://www.riksdagen.se/sv/Dokument-Lagar/EU/EU-forslag/Proposal-for-a-REGULATION-OF-T_H1B6161/, last visited: 2013-05-22.

The last chapter will contain a summary of all the conclusions made throughout the thesis.

2 The Community Trademark Protection

A trademark can be registered on a national level, a Community level or both. Since the focus of this thesis will be on the Community trademarks, the discussion will be limited to only include the Community trademark protection and therefore not include the explanation of the protection of national trademarks.

Any person, natural or legal, may apply to register a Community trademark at OHIM¹³ and in order to register a Community trademark the mark in question must first and foremost fulfil the formal requirements for a trademark. According to Article 4 CTMR a trademark is defined as ‘any sign capable of being represented graphically [...] provided that such signs are capable of distinguishing the goods and services of one undertaking from those of other undertakings’. The subject of importance for a potential trademark is the sign. It may consist of words, designs, letters, numerals etc. but in order for the sign to serve as a trademark, it must be able to be graphically represented. This requirement may be a low hurdle to overcome for two-dimensional marks¹⁴ but can, on the other hand, be more difficult for less traditional marks, such as smells, colours and shapes which might not be able to be reproduced directly in their visible form as stated in the Sieckmann case.¹⁵

Whether or not a sign, that is graphically represented, will be successful in the process of registration depends on its capability of distinguishing the goods and services of a particular trader from those of the competitors, the last criterion in article 4 CTMR. In order for a sign to fulfil that criterion, it needs to be capable of being distinctive of a particular trader’s goods and services to the relevant consumers on the market. Furthermore, it is up to the applicant to persuade the Trade Mark Registry or the court in question that the sign fulfils the criteria and therefore is capable of functioning as a trademark.¹⁶

2.1 Grounds for Refusal

As previously mentioned, a trademark needs to satisfy the criteria of registrability laid down in Article 4 CTMR. This provision indicates the minimum level of registrability of a trademark and if these requirements are not fulfilled the trademark in question cannot be registered. Not only must

¹³ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, Article 5.

¹⁴ Davis, *supra* note 10, p. 205-206.

¹⁵ Case C- 273/00, Sieckmann v Deutsches Patent- und Markenamt, para. 70-73.

¹⁶ Davis, *supra* note 10, p. 207.

the trademark fulfil the “absolute” requirements in Article 4, it also has to overcome a number of possible objections before a registration can be approved. These objections are divided into two groups, the absolute grounds for refusal and the relative grounds for refusal. As mentioned in the delimitations, a discussion concerning the relative grounds for refusal falls outside the scope of this thesis and will not be further discussed.

2.1.1 Absolute Grounds for Refusal

The basic approach of the CTMR is that any sign, which is operating as an indicator of origin on the market, should be able to obtain a registration. Even if this is the case, there are some signs that, on specific grounds such as the public interest, should not be registered at all or be registered in certain limited circumstances. These marks will be refused a registration on the basis of the absolute grounds for refusal listed in Article 7 CTMR and it is the nature of the trademark, not the trademark’s relationship with other trademarks, that renders it inappropriate for registration.¹⁷

The absolute grounds for refusal (within Article 7 CTMR) state that signs that do not conform to the requirements of Article 4 CTMR should not obtain a registration. Except from this, the provision also refuses registration of trademarks that are devoid of any distinctive character¹⁸ or are considered descriptive, generic or customary¹⁹. The only way for these two categories of marks to actually obtain a registration is if they have acquired the distinctive character through use according to Article 7(3) CTMR. Furthermore, there are additional absolute grounds for refusal in article 7(1)(e)-(h) CTMR. Unlike the aforementioned provisions, these cannot be cured for their lack of distinctiveness through use.²⁰

As the focus of this thesis will be on analyzing the distinctiveness provision, a further discussion around the other provisions within Article 7 (1) will not be included. However, for the sake of clarity, a brief discussion around the provision of descriptiveness will be needed.

2.1.2 Non-Distinctive and Descriptive Marks

Non-distinctive and descriptive marks are two categories of absolute grounds for refusal. Each ground represents a separate basis for refusal and for a mark to be valid, it must not fall within any of these grounds. Even if the grounds are to be seen as two separate provisions, they will often be applied cumulatively, which means that a mark will often be rejected based on more than one ground. In several cases it has been noted that if a mark is said to be descriptive and therefore falls within the scope of Article 7(1)(c)

¹⁷ Davis, *supra* note 10, p. 208.

¹⁸ Article 7(1)(b) CTMR.

¹⁹ Article 7(1)(c) CTMR.

²⁰ Firth *et al.*, *supra* note 2, p. 298-299.

CTMR, it also lacks distinctive character and will consequently also be excluded under Article 7(1)(b) CTMR. However, a mark that is not descriptive may still lack the distinctive character needed for a registration. Even if the mark might fall under both of the provisions and because of that should be denied registration, it is not to be treated as invalid if the mark has acquired distinctive character through use in accordance with Article 7(3) CTMR. In other words, the grounds for refusal under Article 7(1)(b)-(c) CTMR can be overcome if there has been such use as to educate the consumers that this mark operates to distinguish the goods or services of one particular undertaking from those of its competitors.²¹

There are some marks that consist exclusively of signs or indications serving to designate the characteristics of goods and services. These marks are considered wholly descriptive and should automatically be refused a registration according to Article 7(1)(c) CTMR. The only situation in which a descriptive mark can be registered as a trademark will be if it has acquired distinctiveness through use in accordance with Article 7(3) CTMR.²²

It is not always easy to determine whether a mark is descriptive or not. Some marks are obviously descriptive, such as ‘Screen’ for TV’s, while others might be more ambiguous. It is complicated to draw a line between the descriptive marks, which should not be registered without proof of distinctiveness, and marks that are allusive of a certain product’s characteristics without being descriptive.²³

When assessing whether a mark is capable of being registered, the average consumer of the category of goods and services is the relevant class from whose perspective the mark will be assessed. The assessment is made by the Registrar of OHIM and even if this category of consumers is assumed to be reasonably observant, cases from different Courts make clear that the level of awareness vary from sector to sector. This means that the Registrar of OHIM must interpret the mark in the application as the average consumer would and will therefore take into account a so-called normal and fair use of the mark.²⁴ It is also important to note that a mark will normally be viewed as a whole. This means that a mark will not be refused registration just because parts of it lack distinctiveness or are descriptive.²⁵

Two tests have been identified as underlying the application of the absolute grounds for refusal. The first reflects what is called the ‘distinguishing function’ of a trademark where the idea is that a trademark acts as an indication of origin²⁶. The focus should here be on how the trademark would be perceived by the average consumers of the category of goods or services

²¹ Bently, Lionel., Sherman, Brad., *Intellectual Property Law*, 3rd edition, 2009, Oxford University Press Inc., New York, p. 818-819, [hereafter: Bently and Sherman].

²² Davis, *supra* note 10, p. 211-212.

²³ *Ibid*, p. 211-212.

²⁴ Bently and Sherman, *supra* note 21, p. 819-821.

²⁵ *Ibid*.

²⁶ Joined Cases C-53/01 *Linde AG*, C-54/01 *Winward Industries Inc.* and C-55/01 *Rado Uhren AG*, [2003] ECR I-03161, para. 40, [hereafter: *Linde et al.*].

in question.²⁷ To avoid rejection based on Article 7(1)(b) CTMR the Court must conclude that the trademark will be perceived as a ‘badge of trade origin’ allowing consumers to make the connection between the goods and the trader in question. If a trademark is not sufficiently distinctive to do that, the trademark will be excluded from registration.²⁸

The second test reflects the so-called ‘protective function’ of a trademark. The purpose of this function is to protect the interests of other traders working in the same field by leaving certain signs free for competing traders to use in the course of trade. A legal protection over such descriptive marks might enable one trader to keep other traders completely out of the market.²⁹

Although these tests are not mutually exclusive, to put a greater emphasis on the interests of the consumers will more likely give a broader spectrum of registered trademarks than if the interest of competing traders was emphasised. Even if a competing trader would have the interest of keeping a mark freely available for all to use, it is still possible for a consumer to perceive the same mark as an indication of origin and thereby render the mark registrable.³⁰

2.1.3 Case Law

In order to show practical limitations for word marks in the respect of registration as a trademark, a discussion around some interesting Court decisions will now be made. However, the CJEU has not been wholly consistent in its approach to what the governing test for registration should be. As aforementioned, the assessment of the registrability of a trademark is often linked to the question of trademark infringement. The tests mentioned above are therefore, relevant even in cases regarding trademark infringements. This means that both cases regarding registrability of trademarks and cases regarding trademark infringements will be discussed below.

In an early infringement case from 1999, *Windsurfing Chiemsee v Attenberger*³¹, the question before the CJEU concerned the word Chiemsee, the name of a lake in Bavaria, and whether it could be registered as a trademark for sports clothing or if such a trademark would fall within Article 7(1)(c) CTMR. The National Court filed for a preliminary ruling on the interpretation of Article 7(1)(c) CTMR asking in what circumstances the provision precludes registration of a trademark which consists exclusively

²⁷ Joined Cases C-53/01, C-54/01 and C-55/01 *Linde et al*, *supra* note 26, para. 41.

²⁸ Bently and Sherman, *supra* note 21, p. 822.

²⁹ *Ibid*, p. 832.

³⁰ MacQueen *et al.*, *supra* note 3, p. 580.

³¹ *Joined cases Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehor Walter Huber*, Case 108/97; *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Attenberger*, Case C-109/97, [1999] ECR I-2779, [hereafter: *Windsurfing Chiemsee*].

of a geographical name.³² Here the CJEU stressed the protective function, that Article 7(1)(c) CTMR pursues an aim which is in the public interest, namely that descriptive marks should be freely used by all. This means that the provision in question prevents such marks from being reserved to one undertaking alone through a trademark registration.³³ However, the Court went on to take into account the distinguishing function by stating that the National Courts should also investigate whether there is an ‘association in the mind of the relevant class of persons between the geographical name and the category of goods in question’³⁴. This means that if the consumer would see the mark as an indication of origin, this could be enough for the mark to obtain a registration.

The importance of the protective function seemed later to be contradicted in one of the most widely noted cases in this respect. In the case of *Procter & Gamble Co v OHIM*³⁵ the CJEU reviewed a refusal to register the words ‘BABY-DRY’ for diapers. A decision to refuse a registration was delivered by the examiner of OHIM. This decision was appealed to the First Board of Appeal of the OHIM, which in turn dismissed the appeal of the contested decision. The Board found that ‘BABY-DRY’ consisted exclusively of words suitable to define the intended purpose of the goods in question and was therefore considered to be descriptive. Furthermore, the mark also lacked distinctive character and was therefore not eligible for a Community trademark registration according to Article 7(1)(b) and (c) CTMR.³⁶ The applicant contested the decision to the European Court of First Instance (CFI), today known as the General Court (GC), which confirmed the decision from the Board. Furthermore, it held that the combination of the two words ‘baby’ and ‘dry’ was not to be registered as a Community trademark since the combination ‘BABY-DRY’ lacked the required distinctive character necessary to distinguish the goods from other competitors and was solely descriptive.³⁷

In its review, the CJEU did not fully agree with the aforementioned decisions. The CJEU agreed upon the fact that it is clear that the purpose of the prohibition of registration of purely descriptive marks is to prevent registration of a mark which cannot identify the goods or services of the undertaking in question and thus are devoid of distinctive character.³⁸ However, in discussing the descriptiveness the CJEU held that ‘only signs that may serve in normal usage from a customer’s point of view to designate [...] goods or services’³⁹ would be excluded from registration. It also stressed the fact that when assessing the registrability of marks composed of words, the descriptiveness must be determined in relation to the mark as the

³² *Joined cases* Case C-108/97 and Case C-109/97 *Windsurfing Chiemsee*, *supra* note 31, para. 19.

³³ *Ibid*, para. 25.

³⁴ *Ibid*, para. 37.

³⁵ Case C-383/99 P, *Baby-Dry*, *supra* note 5.

³⁶ *Ibid*, para. 5.

³⁷ *Ibid*, para. 20 and 30-34.

³⁸ *Ibid*, para. 37.

³⁹ *Ibid*, para. 39.

whole which it form and not only in relation to each word taken separately. If the combination of words is regarded as purely descriptive, that is sufficient to render it ineligible for registration.⁴⁰ In the case of the ‘BABY-DRY’ combination, the CJEU considered it necessary to assess the word combination in question from an English-speaking consumer’s point of view. Whilst each of the words in the combination could be seen as forming parts of expressions used in everyday speech to designate the function of the goods in question, the unusual juxtaposition of the words was not a familiar expression. Therefore, a combination like this could not be regarded as exhibiting a descriptive character and should not be refused registration. Here it would appear that the distinguishing function should take precedence since the CJEU ruled that the focus should be on the consumers and their interpretation of the mark.⁴¹

The CJEU came to consider the question of registrability again in a later case, *OHIM v Wrigley*⁴², concerning an appeal from the OHIM where the Board had rejected the application for registration of the word ‘Doublemint’ for chewing gum on the basis that it was descriptive of certain characteristics of the goods in question.⁴³ The CFI did not fully agree with the Board in its decision. Even if the combination had numerous meanings and thus could deprive the sign of any descriptive function, the word ‘Doublemint’ had an ambiguous and suggestive meaning which was open to various interpretations, this meant that the mark could not be seen as exclusively descriptive and therefore not be refused a registration.⁴⁴ When the question reached the CJEU it referred, yet again, to the protective function test in Article 7(1)(c) CTMR and did not mention the ‘BABY-DRY’ case. Instead it referred back to *Windsurfing Chiemsee* and stressed that it is important to keep descriptive marks free for everyone to use and that a mark should be refused registration if at least ‘one of its possible meanings designates a characteristic of goods or services consumed’⁴⁵. This means that the mark does not have to be exclusively descriptive for a registration to be refused.⁴⁶

The different outcomes in the cases above shows that it is far from settled in which circumstances the protective and distinguishing tests should be applied when considering a refusal of an application to register a trademark under the absolute grounds of refusal in Article 7(1)(b)-(c) CTMR. To read the two subsections of the article disjunctively and divide the assessment in two steps may seem like a logical approach. Here, the first step would be to consider whether the mark is distinctive and capable of distinguishing the goods or services in question from other traders in accordance with Article 7(1)(b) CTMR, where the perception of the consumers is paramount. The

⁴⁰ Case C-383/99 P *Baby-Dry*, *supra* note 5, para. 40-41.

⁴¹ *Ibid*, para. 42-44.

⁴² Case C-191/01, *OHIM v Wrigley (Doublemint)*, [2003] ECR I-12447, [hereafter: *Doublemint*].

⁴³ Case C-191/01 *Doublemint*, *supra* note 42, para. 7.

⁴⁴ *Ibid*, para. 11-12.

⁴⁵ *Ibid*, para. 32.

⁴⁶ *Ibid*, para. 31-32.

second stage would then be to consider whether the mark is descriptive and should be left free for use by others in the course of trade in accordance with Article 7(1)(c) CTMR.⁴⁷ However, this approach has been criticised. Even though the CJEU have had plenty of opportunities to explain the proper means of the interpretation of the distinctiveness grounds for refusal, it has continuously failed to establish a coherent and overarching framework for the operation of the distinctiveness tests. The Court seemed to place great weight on the notion that the provisions are ‘independent’ of each other and therefore should be interpreted disjunctively. To treat the provisions in this manner is inadequate because it pays insufficient attention to the fact that there is a clear overlap between the scopes of the provisions. There are circumstances in which a non-descriptive mark still is devoid of a distinctive character. However, the reverse does not hold true. If a mark is considered to describe the characteristics of a trader’s goods or services, the mark will not be able to do the job of distinguishing the goods or services from those of the competitors. To be precise, ‘descriptiveness’ should be seen as an illustration of when a mark is ‘devoid of distinctive character’. To categorically state that the provisions within Article 7(1)(b)-(c) CTMR are independent of each other cannot be seen as the correct interpretation. Rather, the ‘descriptiveness’ should be seen as an example of marks which are ‘devoid of distinctive character’, since all marks caught by the ‘descriptiveness’ provision in Article 7(1)(c) CTMR will also be caught by Article 7(1)(b) CTMR. For these reasons, it has been suggested that the provisions should be seen as interdependent rather than independent and that the provisions, taken collectively, are intended to serve either a distinguishing function alone, or, in addition, a protective function. The test of indicating origin and the need to leave marks free for other traders to use should be considered in relation to both of the provisions.⁴⁸

⁴⁷ MacQueen *et al.*, *supra* note 3, p. 581-582.

⁴⁸ Handler, Michael, *The distinctive problem of European trade mark law*, E.I.P.R. 2005, 27(9), p. 309, [hereafter: Handler].

3 The Olympic Symbols

The Olympic Games is a big sporting event held every fourth year (every other year if the Winter Olympic Games are taken into consideration) for a limited period of time. It is an event that commands the attention of the entire world, including the media, during the above mentioned short period of time, which makes it the most effective international marketing platform for companies. Simply, the estimated global audience of billions of viewers from all over the world seems like a marketing opportunity too good to miss.

The Olympic properties are to be found in the Olympic Charter⁴⁹. The same Charter also states that the rights in those properties belong exclusively to the IOC, who in turn may license these rights to others for profit making purposes.⁵⁰ The Olympic Symbol⁵¹, the Olympic flag⁵², the Olympic motto⁵³, the Olympic emblems, the Olympic anthem, the Olympic flame and the Olympic torch together with any other Olympic designations are all included in the Olympic properties.⁵⁴ However, the Olympic Charter does not, in itself, provide the properties with any legal protection, which means that it requires the IOC to take appropriate steps to try to obtain protection for the Olympic properties in other ways. Not only does this responsibility fall on the IOC, but the National Olympic Committees (NOC) are also obliged to try to secure the protection of the properties.⁵⁵

There is an international Treaty that provides protection for the Olympic symbol. This Treaty is called the Nairobi Treaty⁵⁶ and is a legislation administered by the World Intellectual Property Organization (WIPO). The purpose of the Treaty is to make the commercial use of the Olympic symbol dependent on the authorization of the IOC. However, the Treaty does not cover the use of any of the other properties stated in the Olympic Charter. This means that if the host country is a member of the treaty, the Olympic rings are protected from unauthorized use, while a protection regarding the use of the other Olympic properties found in the Olympic Charter need to be adopted in each host country in order to prevent an unauthorized use.⁵⁷

⁴⁹ The Olympic Charter, available at:

http://www.olympic.org/Documents/olympic_charter_en.pdf.

⁵⁰ The Olympic Charter, Chapter 1(7)(2).

⁵¹ The Olympic symbol consists of the well-known five interlaced rings.

⁵² A plain white flag with the Olympic Symbol located in the centre.

⁵³ 'Citius. Altius. Fortius'.

⁵⁴ The Olympic Charter, Chapter 1(8)-(14).

⁵⁵ Johnson, Phillip, *EIPR Practice Series; Ambush Marketing: A Practical Guide to Protecting the Brand of a Sporting Event*, Book 1 2007, 2008, Sweet & Maxwell Limited, London, p. 98-99, [hereafter: Johnson].

⁵⁶ Nairobi Treaty of the Olympic Symbol, available at:

http://www.wipo.int/export/sites/www/treaties/en/ip/nairobi/pdf/trtdocs_wo018.pdf.

⁵⁷ Johnson, *supra* note 55, p. 99.

There are two obligations on the contracting parties under the Nairobi Treaty. According to Article 1 of the Nairobi Treaty, the contracting parties must refuse, or invalidate, the registration of a trademark which consists of or uses the Olympic symbol in any way. The second obligation is to make sure that the use of the symbol as a mark is prohibited when used for commercial purposes. The only time any use of the Olympic Symbol will be accepted is when the authorization for use has been given by the IOC or if any of the exemptions stated in the Treaty are fulfilled.⁵⁸

Even if the Treaty exists, it has had little or no impact at all on the Olympic symbol. The fact that it requires that the rights in the Olympic symbol must belong to the IOC, rather than the NOC, makes it particularly problematic in countries where the domestic law has already granted rights in the Olympic symbol to the NOC. Furthermore, not many of the host countries were even members of the Treaty at the time they hosted the Olympic Games. In order to protect the Olympic symbol, motto and certain words, they made commitments to the IOC to legislate the protection by creating an extended protection of these properties, the so called *sui generis protection*, which will be thoroughly discussed later on in the thesis. Since neither of these two international legislations provides a legal protection of Olympic properties, except from the Olympic symbol, or any other association right registered by the IOC, these extended protections becomes very important especially in the attempt to protect the 'City + Year' identifications.⁵⁹

⁵⁸ Johnson, *supra* note 55, p. 99-100.

⁵⁹ *Ibid*, p. 100-101.

4 Protection of Event Marks

A brand can be defined as a name, symbol, design, logo or some sort of combination of the above, but regardless of how the brand is defined, the intention of it is always to identify a certain trader's goods or services from those of the competitors. Not only will a brand identify products or services, it also tends to extend beyond that and let people and organizations be viewed as brands. For sport consumers, a person like Zlatan Ibrahimovic can be seen as a valuable brand since his name, for example, can influence ticket purchases of a sporting event or the sale of Nike products (which is his official sponsor). Similarly, organizations such as the Detroit Red Wings or FC Bayern München can also represent valuable brands to the sport consumers.⁶⁰ There are many different branded products and the major sporting events can also be regarded as yet another type of a branded product since their event marks are to be seen as part of the word mark concept.

4.1 Event marks

Brands can be defined as mental structures that reside in the minds of the consumers. The residing information creates a link between the information provided and the specific brand, which is referred to as a unique brand association. Marketing is one of many strategies that companies tend to use to create a strong and unique brand association among the relevant consumers. A fair market strategy is not always used in order to create a differentiation between their products and those of the competitors.⁶¹ To market, for example, an energy drink with a banner saying 'The Drink of the Olympic Games 2016' does not necessarily make people believe that this drink was produced and distributed by the IOC. However, the banner could most certainly make the consumers think that the energy drink has an official link to, in this case, the 2016 Olympic Games held in Rio de Janeiro. This aspect of trademark infringements called 'ambush marketing' has been widely discussed the past couple of years, especially around the major sporting events.⁶² As with many other terms, the meaning of the words have changed considerably since it was coined and can now, in a simple way, be defined as 'a planned campaign by an organisation to associate itself indirectly with an event in order to gain at least some of the recognition and benefits that are associated with being an official sponsor'.⁶³ A more thorough discussion around this aspect will not be covered by the thesis. However, the concept might be taken into consideration further on in the analysis chapter.

⁶⁰ Amis, John., Cornwell, T. Bettina., *Global Sport Sponsorship*, 2005, Oxford International Publishers Ltd., p. 180, [hereafter: Amis and Cornwell].

⁶¹ Amis and Cornwell, *supra* note 60, p. 180.

⁶² Johnson, *supra* note 55, p. 14.

⁶³ *Ibid*, p. 6-7.

As previously mentioned, the IOC has tried to avoid the abuse of the ‘City + Year’ identifications by obtaining a trademark registration. Identifications such as ‘SYDNEY 2000’, ‘LONDON 2012’ and ‘RIO 2020’ are, according to the IOC, very valuable indications to each of the host countries of the Olympic Games and need to be protected as official trademarks. The concept of such ‘event marks’ may be understood as a sign used to identify an event in which the event organizer has the interest to use and protect the mark in connection with their products and services.⁶⁴ There have been discussions around the concept of ‘event marks’ and what requirements these marks should fulfil in order to obtain a trademark registration. Some scholars have argued that these marks should fulfil the same requirements as ordinary trademarks while others believe that they should be recognised as a new form of protection.

To be able to discuss the registration of the ‘City + Year’ indication as a trademark, the following chapter will touch upon some relevant cases from OHIM, a case from the GC, and a case from the U.S. District Court for the District of Columbia concerning the registration of such marks.

4.2 Case Law on Event Marks

In June 2001, FIFA filed an application before the OHIM seeking to protect the word marks ‘WORLD CUP 2006’⁶⁵, ‘GERMANY 2006’⁶⁶ and ‘WM 2006’⁶⁷. All three of the applications were referring to a wide range of goods and services and were all relating to, or to be associated with, the football championships held in Germany during 2006. The chocolate company Ferrero filed a cancellation application seeking to obtain a declaration of invalidity of these marks and argued that the marks were devoid of any distinctive character and descriptive in relation to the goods and services in question. Due to the fact that the OHIM’s decisions were all very similar to each other I will therefore only focus on the validity of the trademark ‘GERMANY 2006’⁶⁸, which was the decision concerning an application for registration of a mark similar to a ‘City + Year’ identification as a trademark.

In this case, the Board of Appeals concluded that the mark ‘GERMANY 2006’, taken as a whole, was a descriptive mark and devoid of distinctive character and rejected the argument that the mark had acquired distinctiveness through use. By stating that the word “Germany” refers to

⁶⁴ Dannemann Lundgren, Felipe. *Event Marks: A Necessary Form of Protection against Ambush Marketing?*, 2010, a thesis submitted to the Munich Intellectual Property Law Center, available at: http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1742420, p. 42, [hereafter: Dannemann].

⁶⁵ OHIM First Board of Appeal, decision R 1466/2005-01 - WORLD CUP 2006 (20 June 2008).

⁶⁶ Decision R 1467/2005-1 - GERMANY 2006, *supra* note 1.

⁶⁷ OHIM First Board of Appeal, decision R 1468/2005-1 - WM 2006 (30 June 2008).

⁶⁸ Decision R 1467/2005-1 - GERMANY 2006, *supra* note 1.

the country'⁶⁹, the Board declared that the trademark 'GERMANY 2006' had a clear descriptive meaning since such a combination usually describes something happening in Germany in 2006.⁷⁰ In order for the trademark to become non-descriptive the expression had to be combined with some other element such as the organizers name or the main sponsor.⁷¹ The geographical indication and the year was not proved to be recognised as an indication of origin standing on its own and the Board said that the average consumer would most likely not perceive the 'GERMANY 2006' as an indication of origin but 'merely as the reference to a particular link between the goods and services and a country in a particular year'.⁷² Regarding the question concerning acquired distinctiveness through use, the Board ruled that the evidence brought by FIFA was not sufficient enough to prove that the mark was strongly remembered by the consumers throughout the European Union as an indication of origin. In fact, the evidence brought by FIFA was considered insufficient because the mark was either not used as a trade mark as such, or it was used as one expression together with the official logo or with the identifier FIFA.⁷³

FIFA filed for court actions before the GC against the Board's decision. However, according to the Official Journal of the European Union, these actions were rejected and will not be dealt with.⁷⁴

Getting off of the football pitch and entering the battlefield of martial arts, another decision from the OHIM worth analysing concerns an application for registration of the trademark 'ULTIMATE FIGHTING CHAMPIONSHIP'⁷⁵. The Board reached the same conclusion in this case and stated that the mark was devoid of any distinctive character⁷⁶ and descriptive in relation to the services in one of the international classes applied for.⁷⁷ The interesting point of this decision is that, despite recognizing that 'ultimate fighting' was a term that was coined by the applicant to be able to identify its own fighting events, the Board believed that 'ULTIMATE FIGHTING' would implicitly be identified as a type of combat. In other words, the Board found that the mark in question had become the generic name of the sport itself.⁷⁸

⁶⁹ Decision R 1467/2005-1-GERMANY 2006, *supra* note 1, para. 24.

⁷⁰ *Ibid.*

⁷¹ *Ibid.*, para 25.

⁷² *Ibid.*, para. 46.

⁷³ *Ibid.*, para. 57-59.

⁷⁴ [http://eur-](http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2008:313:0049:0049:EN:PDF)

[lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2008:313:0049:0049:EN:PDF](http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2008:313:0049:0049:EN:PDF).

⁷⁵ Court of First Instance (now General Court), case T-118/06 (2009/C 128/20), *Zuffa v OHIM - ULTIMATE FIGHTING CHAMPIONSHIP* (2 April 2009).

⁷⁶ OHIM - First Board of Appeal, decision R 931/2005-1 - *ULTIMATE FIGHTING CHAMPIONSHIP* (30 January 2006), para. 24, [hereafter: *ULTIMATE FIGHTING CHAMPIONSHIP*].

⁷⁷ Decision R 931/2005-1 - *ULTIMATE FIGHTING CHAMPIONSHIP*, *supra* note 76, para. 17.

⁷⁸ *Ibid.*, para. 15.

The decision was appealed to the GC where the decision was annulled due to ‘inadequate statement of reason’⁷⁹. According to the Court, when assessing whether an application for registration of a mark should be refused under Article 7(1) CTMR, it is important to analyse each individual product and services separately. A group analysis should only be allowed if there is ‘a sufficiently direct and specific common link to each other to the extent of forming such a sufficiently homogeneous category’.⁸⁰ Therefore, the Court annulled the decision and sent it back to the OHIM for a new and better motivated decision. This decision by the GC could be seen as disappointing since it never addressed the core issue of the registrability of an event mark. Nevertheless, one cannot discard that the GC probably would have adopted the same understanding as in the FIFA ‘World Cup’ cases. Even if that would have happened, it will still take years before a case concerning a registration of an event mark as a trademark reaches the CJEU which in turn means that legal uncertainty will remain in the European level until that time.

The issue of enforcement of ‘event marks’ has also been addressed by the U.S. courts and one of the cases is *FIFA v. Nike*⁸¹, decided by the U.S. District Court for the District of Columbia. In 2003, the Women’s World Cup football tournament was held in the USA and FIFA had filed applications to register the mark ‘USA 2003’. As a non-official sponsor of the World Cup but a sponsor of the U.S. Women’s National football Team, Nike designed a logo combined with the phrase ‘USA03’ and used it on clothing and on their website. Even if these uses contained no reference to FIFA or the World Cup, FIFA filed actions against Nike and alleged that the use of the expression ‘USA03’ by Nike amounted to trademark infringement and unfair competition among other claims and applied for a preliminary injunction to oblige Nike to cease the use of the expression.⁸²

However, the Court denied the request and highlighted that FIFA’s trademark was descriptive since ‘USA 2003 simply identifies the country in which the World Cup is being played along with the year in which the event is taking place’⁸³ and could only obtain protection upon proof of secondary meaning⁸⁴. Seeing that FIFA did not present any direct evidence of secondary meaning and that FIFA’s prior use of ‘City+Year’ identifications for previous World Cup tournaments was not sufficient to establish a consumer association of ‘USA 2003’ with the 2003 Women’s World Cup,

⁷⁹ Decision R 931/2005-1 - ULTIMATE FIGHTING CHAMPIONSHIP, *supra* note 76, para. 36.

⁸⁰ *Ibid*, para. 28.

⁸¹ *Federation Internationale de Football Association v. Nike, Inc.*, 285 F. Supp.2d 64 (D.D.C 2003).

⁸² *Ibid*, para. 67.

⁸³ *Ibid*, para. 69.

⁸⁴ The doctrine regarding the ‘secondary meaning’ is very similar to the discussion regarding the possibility to acquire distinctive character through use in accordance with Article 7(3) CTMR.

the Court concluded that no protection should be granted.⁸⁵ Even if secondary meaning had been proven by FIFA, the Court was of the opinion that the mark lacked distinctive character since ‘FIFA has not used its “USA 2003” mark in a way that would lead consumers to associate those words alone with this year’s World Cup’.⁸⁶

It is fair to conclude that the principles deriving from the above cases make it clear that a word mark needs to fulfil the same requirements for registration as any other trademark and should not be seen as a new category of trademarks in need of special treatment. However, it remains unclear whether there should be an extended protection for valuable word marks associated with a major sporting event.

⁸⁵ *Federation Internationale de Football Association v. Nike, Inc.*, 285 F. Supp.2d 64 (D.D.C 2003), para. 75.

⁸⁶ *Ibid*, para. 73.

5 The Alternative to an Extended Protection

In some situations, traditional legal measures, such as the Community trademark law, are not always sufficient to tackle the most complex problems that may arise concerning sporting events and their protected intellectual properties. The importance of sponsorships for financing the major events has grown over the past few years. That, together with the lack of effective legal measures within ordinary trademark law and the increasing instances of ambush marketing, has led the event organizers, such as FIFA or the IOC, and the official sponsors to demand better protection of the properties associated with the events. A so-called *sui generis* protection must be formed by the host countries, a form of protection that is complimentary to the traditional means of protection.⁸⁷

Along the years, the host countries of various major sporting events have drafted *sui generis* legislations in order to protect their event marks and other valuable marks that are not protected by the Treaty. The following chapter will briefly analyse some of the *sui generis* legislations adopted by different countries and will then consider the potential effects thereof. Although *sui generis* protection has become almost a mandatory requirement for countries that want to host a major sporting event nowadays, this type of legislation has been mostly used by the IOC in the protection of the Olympic Games and the Olympic association rights that are not protected by the Treaty. This is why most of the legislation commented upon in this chapter will be related to the Olympic Games.⁸⁸

5.1 London Olympic Games and Paralympic Games Act 2006

As mentioned before, the Olympic Symbol is protected through the Nairobi Treaty⁸⁹. However, the Treaty does not provide protection of any of the other Olympic properties such as the word ‘Olympics’ or any other association right registered by the IOC. This is the main reason why the event-specific legislation becomes very important.⁹⁰

The United Kingdom (UK) is not a party of the Nairobi Treaty but made a commitment to the IOC to legislate to protect the Olympic symbol, motto

⁸⁷ Dannemann, *supra* note 64, p. 54-56.

⁸⁸ *Ibid*, p. 55.

⁸⁹ Nairobi Treaty on the Protection of the Olympic Symbol, adopted at Nairobi on 26 September 1981.

⁹⁰ Dannemann, *supra* note 64, p. 55-56.

and certain words, which resulted in the Olympic Symbol etc. (Protection) Act 1995 (OSPA).⁹¹

Before selecting the host country of the Olympic Games, the main task for the IOC is to make sure that an adequate protection of the Olympic brand exists. The protection sought by the IOC goes far beyond simply protecting the various Olympic symbols, which means that the Olympic contract requires the host country to draft and pass legislation to protect all properties associated with the event. The legislation must cover the core Olympic symbols, which in the UK is covered by the OSPA, as well as the 'City + Year' identifications and a number of other Olympic associations.⁹² This thesis will go on to discuss if such a broad protection really is necessary.

One of the requirements for the candidature for the 2012 Olympic Games was to pass a legislation restricting the use of the so-called Olympic association rights. When London came out as the winner of the bid to host the games, the UK adopted the London Olympic Games and Paralympic Games Act 2006 (LOGPGA) with the main purpose of preventing the creation of an unauthorized association between people, goods and services and the London 2012 Olympic Games. As the main purpose of the OSPA is to provide protection for certain specific Olympic properties, LOGPGA aims to protect the London Olympics Association Right found in Schedule 4 of the LOGPGA. This legislation provides the organizers with a protection going beyond the protection provided by ordinary trademark laws.⁹³

The exclusive rights that came out of the LOGPGA in relation to use of the protected symbols and trademarks belong to the London Organizing Committee of the Olympic Games (LOCOG). However, this exclusive right is only temporary since the application period of the LOGPGA stretches between the 30th of March 2006 and the 31st of December 2012.⁹⁴ When using the protected association rights (covered by the LOGPGA) in a way likely to suggest to the public that there is an association between the goods or services provided and the London Olympic Games, there is no requirement that the association in question must be misleading or deliberately made for it to constitute an infringement.⁹⁵ It is sufficient that the public has been given the impression that a contractual or commercial relationship with the company and the Olympic Games exist. In other words, even if there is no risk of confusion to consumers, the activity causing the association might be found to infringe the special legislation.⁹⁶ Schedule 4 of the LOGPGA states various combinations of words that the Court may take into consideration when deciding whether an association

⁹¹ Johnson, *supra* note 55, p. 101.

⁹² *Ibid*, p. 128-129.

⁹³ Dannemann, *supra* note 64, p. 58-59.

⁹⁴ London Olympic Games and Paralympic Games Act 2006, section 40(1) and (8), [hereafter: LOGPGA].

⁹⁵ LOGPGA, *supra* note 94, Schedule 4 para. 2(1).

⁹⁶ Johnson, *supra* note 55, p. 130.

with the Olympic Games has been made and thereby an infringement of the London Olympics association rights.⁹⁷ If one uses the words ‘Games’, ‘two thousand and twelve’, ‘2012’ and ‘twenty twelve’ in combination with each other or together with any of the words ‘gold’, ‘silver’, ‘bronze’, ‘London’, ‘medals’, ‘sponsor’ or ‘summer’ it becomes a strong indication that an association has been created.⁹⁸

Despite the fact that an association can be made in more or less any way, the legislators still chose to set specific combinations of words that the court may take into account when assessing the association. It seems like the specified words mentioned above do not need to be next to each other to be considered as a combination that infringes the protected association rights. An unauthorized combination could be an advertisement saying ‘Visit London with us in 2012’ or ‘Sponsor of the 2012 FA Cup’. This means that the Court may take account of the specified words whenever they are used in a phrase but at the same time, there must be a point where the link between the words is not sufficient to ensure an infringement.⁹⁹

The specified words in Schedule 4 of the LOGPGA are a tool used to determine whether an unauthorized association with the London Olympic Games has been made. When an assessment in proceedings relating to the London Olympics association rights is made, the Court may (not shall) take such combinations of the protected words into account. In other words, the Court is not required to consider the combinations in question. Instead, the focus will be on making an overall assessment on a case by case basis.¹⁰⁰

Regardless of this strong protection of the association rights, the Act foresees some exceptions to infringements. It is permitted to use the combinations of the protected words associated with the London Olympic Games if you hold the right to a prior registered mark¹⁰¹ or when broadcasting news¹⁰². Furthermore, a use to describe the characteristics of the goods or services in question is not considered to be an infringement of the protected rights. This may include a description of the quality, quantity, intended purpose, values, geographical origin or time of production.¹⁰³ This means that a winery located within the Olympic area and named ‘London Winery’ will, in its advertisement of a wine produced in 2012, be able to refer to both the company name and what year the wine is produced without infringing the protected rights.

There have been discussions regarding the need of specifying the combinations and words that should be protected since the CJEU is free to take them into account if it so chose. Some say that it is difficult to see why

⁹⁷ LOGPGA, *supra* note 94, Schedule 4 para. 3(1).

⁹⁸ *Ibid*, Schedule 4 para. 3(2)-(4).

⁹⁹ Johnson, *supra* note 55, p. 132.

¹⁰⁰ *Ibid*, p. 132-133.

¹⁰¹ LOGPGA, *supra* note 94, Schedule 4 para. 6.

¹⁰² *Ibid*, Schedule 4 para. 8.

¹⁰³ *Ibid*, Schedule 4 para. 7(b).

a court needs a specific authorization to determine whether ‘Visit London with us in 2012’ creates an association with the London Olympic Games. However, from a commercial point of view, the protected word combinations can be used by the London Olympic Committee as an enforcement strategy and the legislated extended protection of these words will probably be sufficient to push some traders not to exploit the situation to promote themselves through unauthorized use.¹⁰⁴

The two legislations have provided the organizers with civil remedies to combat infringements of the protected association rights. In addition to those remedies, an infringement is also considered to be a criminal offence if a person uses the protected properties without the authorization of the proprietor for.¹⁰⁵ Substantially, the remedies are the same as those available in the ordinary trademark legislations. The most significant difference is that the remedies within this extended protection is limited to a fine, whereas there are other remedies available in the trademark legislation e.g. damages and corrective actions. The fine is not specified in the London Act, but left to the national court to decide. However, during the specified period when the extended protection is applicable, the maximum fine should be taken as a reference to £20.000.¹⁰⁶

5.2 Sydney 2000 Games (Indicia and Images) Protection Act of 1996

Before the 2000 Olympic Games in Sydney, Australia adopted the Sydney 2000 Games (Indicia and Images) Protection Act of 1996 (SGPA), as a part of the federal trade practices law. This Act was considered to be, until now, one of the most effective pieces of legislation aiming to prevent ambush marketing.¹⁰⁷

The Sydney 2000 Games Indicia was defined to include a broad manner of terms that was frequently associated with various Olympic Games. Combinations such as ‘Sydney 2000’, ‘Sydney Games’ and ‘Millenium Games’ and several other ordinary words commonly associated with sport events were included in the protection given by the Act in question.¹⁰⁸

According to the SGPA, the exclusive rights over the protected words belonged to the organising committees of the Sydney Olympic Games and the Sydney Paralympic Games. These two organisations were the only ones who had the right to use the protected words for commercial purposes. The only time someone else was allowed to make such use of the rights was if

¹⁰⁴ Johnson, *supra* note 55, p. 133.

¹⁰⁵ Olympic Symbol etc. (Protection) Act 1995, section 8(1), [hereafter: OSPA].

¹⁰⁶ LOGPGA, *supra* note 94, Schedule 3, para. 11.

¹⁰⁷ Johnson, *supra* note 55, p. 137.

¹⁰⁸ Sydney 2000 Games (Indicia and Images) Protection Act 1996, section 8 (1), [hereafter: SGPA].

they had obtained a license to use or if they had been authorized to use the protected rights in some other way. This means that if consumers made any association between the goods or services and the Olympic Games, the advertisement would infringe the special legislation if the association was based on an unauthorized use of the protected Olympic association rights.¹⁰⁹

As mentioned above, a broad definition of what can constitute indicia and images under this Act was made. This provided the Olympic Committee with powerful mechanisms to fight the unauthorized use of the protected rights. Besides providing the event organizers with the traditional remedies of trademark law, the extended protection within this Act introduced a ‘corrective advertisement’ remedy which allowed Courts to order infringers to publish advertisement clarifying to the consumers that they had conducted unauthorized use of the protected rights and thereby illegally associated their goods or services with the Olympic Games.¹¹⁰ This provision was a very powerful threat because, apart from the possibility of having to cease their advertisement¹¹¹ and to pay compensation¹¹² for any damages caused, there was a risk of seriously damaging their image in front of their consumers, a risk that all major companies wish to prevent.

The introduction of this powerful remedy was most likely the key to the success of the Sydney 2000 Games Protection Act in the prevention of illegal association with the Olympic Games by unauthorized use of the Sydney Olympic association rights. This assumption is based on the fact that very few cases concerning infringements of the protected association rights were experienced during the Games in Australia.¹¹³

5.3 The World Cup 2010

South Africa won the bid to host the 2010 FIFA World Cup and to be successful in its bid, the Government had to furnish various guarantees, such as acknowledging FIFA’s intellectual property rights. Numerous legislative provisions were issued in order to protect FIFA’s various interests in South Africa, but no event-specific legislation to protect the 2010 FIFA World Cup from ambush marketing and unauthorized association was adopted. However, provisions already in force before South Africa was elected provided the event organizers with some highly protective pieces of provisions against such infringements. These provisions are sections 9(d) of South Africa’s Trade Practices Act¹¹⁴ and 15A of the Merchandise Marks Act.¹¹⁵ These customised legislations were put into place prior to the 2003 Cricket World Cup and these stringent legislations were one of the main

¹⁰⁹ SGPA, *supra* note 108, section 12.

¹¹⁰ *Ibid*, section 45.

¹¹¹ *Ibid*, section 43, ‘restraining the person from engaging in the conduct’.

¹¹² *Ibid*, section 46.

¹¹³ Dannemann, *supra* note 64, p. 58.

¹¹⁴ Trade Practices Act (No. 76) of 1976.

¹¹⁵ Merchandise Marks Act (No. 17) of 1941.

reasons for South Africa's successful bid to host the 2012 FIFA World Cup.¹¹⁶

FIFA registered a very extensive portfolio of trademarks under the South African Trade Marks Act (No. 194) of 1993, a trademark portfolio that includes marks such as 'South Africa 2010' and 'World Cup 2010'. The use of any of these protected marks could constitute a trademark infringement according to section 34 of the Trade Marks Act.¹¹⁷

According to the Trade Practice Act, no person is allowed to suggest or mislead consumers, through use of marks, signs or any other form of representation, into believing that there is a connection between that person and its goods or services and the FIFA 2010 World Cup.¹¹⁸ Such unauthorized association is deemed to be a criminal offense and can lead to an imprisonment of two and up to five years.¹¹⁹

Section 15A of the Merchandise Marks Act precludes a person from 'using his own mark in relation to a sports event in a way that will achieve publicity for that trade mark and thus derive special promotional benefit from the event, without the prior authority of the organizer of such event'¹²⁰. This is a provision that clearly prevents ambush marketing and will therefore not be covered by the analysis of this thesis. However, some decisions were obtained from the South African Courts before the beginning of the FIFA 2010 World Cup where this provision was used to protect the unauthorized use of expressions registered by FIFA. Even though the cases did not concern the registration of event marks, they serve well to illustrate the stringent and effective South African provisions against ambush marketing. The use of expressions such as 'WORLD CUP 2010' and stylized images of the year 2010 were claimed to be infringements of FIFA's protected properties and it has been discussed whether the South African protection of such protected properties might have been excessive and leading to a restriction that went far beyond the needs of the event organizers. Compared to the World Cup held in Germany in 2006, cases of ambush marketing and unauthorized use occurred in much less volume in South Africa 2010 and the question is whether such decrease in number of ambush cases was made at the expense of free competition and the excessive protection against fair behaviour. However, a discussion around this will not be covered by this thesis since the problematic around ambush marketing has been excluded.

¹¹⁶ <http://www.spoor.com/home/index.php?ipkMenuID=&ipkArticleID=303>, last visited: 2013-05-04).

¹¹⁷ Ibid.

¹¹⁸ Trade Practices Act (No. 76) of 1976, section 9(d).

¹¹⁹ Trade Practices Act (No. 76) of 1976, section 19.

¹²⁰ Merchandising Marks Act (No. 17) 1941, section 15A.

5.4 Framework of Protection to Event Organizers in Brazil

As we all know, Brazil will be the host country for both the 2014 FIFA World Cup and the 2016 Olympic Games. To be the host of the world's two biggest sporting events within a period of two years will certainly put the country under the spotlight. This means that the adoption of event-specific legislation protecting the event properties against unauthorized use of words associated with the event becomes very important.¹²¹

The two previous World Cups held in Germany 2006 and South Africa 2010, adopted different approaches to protect the association rights from unauthorized use and ambush marketing. While Germany adopted a pro freedom of speech approach, specially represented by the 'GERMANY 2006' decision where the Board of Appeal ruled that the indication in question was descriptive and should be left free for everyone to use,¹²² South Africa adopted strict provisions against any form of attempt to create an association with the event by unauthorized use. This last approach will be discussed more in the following chapter. The question is whether Brazil will adopt a protection that will be in favour of the freedom of speech, like Germany, and thereby adopt more lenient measures to protect the words and symbols associated with the event from unauthorized use, or if it will take the same approach as South Africa and adopt a more restrictive protection.¹²³

The Brazilian Industrial Property Law (BIPL)¹²⁴ provides the event organizers with a protection against illegal ambushing activities. Besides that, the same law contains a provision¹²⁵ granting the specific protection of various names and symbols of sporting events in general, and is prohibiting the registration of such words and symbols as trademarks unless authorization has been given from the event organizers.¹²⁶ This provision is part of Brazil's ordinary trademark protection which therefore makes it an important and effective mechanism available to the event organizers to fight the unauthorized use.

There have been discussions on how to interpret Article 124 (XIII) BIPL, whether it is enforceable against any type of use of event names and symbols by unauthorized third parties or only against the use of such names and symbols to identify a competing event. Considering that the provision specifically targets the registration of event names and symbols by unauthorized users, to adopt a broad interpretation in relation to these registration attempts would seem like the best alternative. This would mean

¹²¹ Dannemann, *supra* note 64, p. 71.

¹²² For more information, see chapter 4.2 *Case Law on Event Marks*.

¹²³ Dannemann, *supra* note 64, p. 72.

¹²⁴ Brazilian Industrial Property Law No. 9.279 of 14 May 1996, [hereafter: BIPL].

¹²⁵ BIPL, *supra* note 124, Article 124 (XIII).

¹²⁶ *Ibid.*

that the organizers would be able to prohibit third parties from obtaining registration for trademarks bearing event names or symbols without identifying a competing event. However, that would not be the best alternative from an enforcement perspective. A better alternative would here be to adopt an interpretation that prevents third parties from using event names and symbols only when they are used to identify a competing event.¹²⁷

It is not only the Intellectual Property Law stated above that provides for protection of event specific words and symbols. The Brazilian Sports Act (BSA)¹²⁸, also known as the ‘Pelé Law’, provides for protection for the names of sporting entities and professional athletes, names and nicknames, independently of registration and for an undetermined period of time. This protection can be found in Article 87 BSA.

These two laws are part of the traditional legal measures within the Brazilian Intellectual Property Law and apart from the protection provided by these laws, Brazil is also a member of the Nairobi Treaty that provides a protection of the Olympic symbol.¹²⁹ Shortly after being nominated as the host of the 2016 Olympic Games, Brazil adopted an Olympic Act¹³⁰ that provides the organizers with an enhanced protection of the various names and symbols that can be related to the Olympic Games. These measures complement the already existing rules. Article 6 of this Olympic Act¹³¹ is the provision that grants a protection for symbols that are related to the Games in Rio de Janeiro 2016. The same provision also includes a protection of terms such as ‘Olympic Games’, ‘Rio 2016’ and ‘Rio Olympics 2016’.¹³²

Furthermore, the provision prohibiting unauthorised use is to be found in Article 7 of the Olympic Act.¹³³ This provision prohibits the use of any of the protected symbols and words for both commercial and non-commercial purposes, which means that any type of unauthorized use, even if it does not involve any risk of confusion, is automatically prohibited. The only time such use will be permitted is when the right holders of the exclusive Olympic properties have granted an authorization. In this case, the right holders are the IOC and the organizing Olympic Committee, which is no different from the previous event-specific legislations.¹³⁴

Finally, in relation to the 2014 FIFA World Cup, which is the world’s largest single sporting event, there is a special legislation that protects the official event properties beyond the ordinary trademark laws. In May 2012

¹²⁷ Dannemann, *supra* note 64, p. 73.

¹²⁸ Pelé Law No. 9.615 of 24 March 1998.

¹²⁹ <http://www.rio2016.com/en/copyright>, ‘Frequently asked questions- 6. Which laws protect Olympic and Paralympic property?’, last visited: 2013-04-10.

¹³⁰ Federal Olympic Act, Law No. 12.035 of October 2009.

¹³¹ *Ibid.*

¹³² *Ibid.*, Article 6.

¹³³ *Ibid.*, Article 7.

¹³⁴ *Ibid.*

the Brazilian Senate approved a Bill¹³⁵ giving FIFA the guarantees needed to organize the 2014 World Cup and Article 3 of this Bill defines FIFA as the sole and exclusive proprietor of all rights associated with the 2014 FIFA World Cup in Brazil.¹³⁶ Article 3 para. 1 grants FIFA and its partners the exclusive right to use an extensive number of terms, such as ‘World Cup 2014’, ‘Cup 2014’ and ‘Brazil 2014’.¹³⁷ This exclusive right to use granted by this provision is limited in time and will only be applicable until thirty days after the end of the World Cup.¹³⁸

There have been discussions regarding the fact that both the Brazilian Olympic Act¹³⁹ and the Senate Bill No. 394 grant the event organizers with the exclusive rights over terms, which, according to ordinary trademark law, are considered to be descriptive and lacking the distinctive character needed in order to obtain such a protection. The events in question have not been held yet but, in view of this, they might face some constitutional challenges. Interested parties might file constitutional challenges against this extended protection, claiming that granting such exclusive rights over terms that does not fulfil the required criteria goes against the right of freedom of expression, since the terms will not be freely available for all to use. However, we will have to see whether these claims will occur and, if they do, whether the Brazilian Supreme Court will have the necessary interest and desire to issue a decision in favour of the claimants before the two biggest events Brazil has ever hosted and thereby jeopardize the important engagement of the sponsors. The FIFA World Cup might be the largest single sporting event but it is still a privately funded event. Without the significant financial contributions provided by the various sponsors, the organizers would not be able to cover the costs needed to host such an event. By granting the use of the 2014 World Cup protected terms and symbols to the sponsors, FIFA secures the financial contribution needed.¹⁴⁰

5.5 Other Major Sporting Events

It is not only for the Olympic Games and for the FIFA World Cups that event-specific legislation is adopted. Such special legislations are also adopted to protect the event properties of other sporting events. In the following, I will include some of the other sporting events that have adopted

¹³⁵ Senate Bill No. 394/2009. For date of approval of the Bill see:

http://espn.go.com/sports/soccer/story/_/id/7913981/brazilian-bill-gives-fifa-guarantees-2014-world-cup-preparations, last visited: 2013-04-29.

¹³⁶ Senate Bill No. 394/2009, Article 3, and Annex 1 of:

http://www.fifa.com/mm/document/affederation/marketing/01/37/85/97/2014_fifapublicgui_delines_eng_04042013.pdf, last visited: 2013-04-29.

¹³⁷ Section 2, Official Marks, Protected Terms, page 6 of:

http://www.fifa.com/mm/document/affederation/marketing/01/37/85/97/2014_fifapublicgui_delines_eng_04042013.pdf, last visited: 2013-04-29.

¹³⁸ Senate Bill No. 394/2009, Article 3 paragraph 1.

¹³⁹ Federal Olympic Act, Law No. 12.035 of October 2009.

¹⁴⁰ Dannemann, *supra* note 64, p. 78-79.

such legislation in order to compare the different protections of the ‘City + Year’ identifications.

5.5.1 The Commonwealth Games

The Commonwealth Games is an association of independent sovereign states spread out over every continent. The Commonwealth Games is an unique, multi-sports event which is held every fourth year and is often referred to as the ‘Friendly Games’ involving athletes from the Commonwealth of Nations. It started out as an event with only single competition sports but today teams sports such as Rugby 7’s¹⁴¹ and Cricket have been introduced. The Commonwealth Games was first held in 1930 in Hamilton, Canada. Since then, numerous countries have had the chance to host the Games where Melbourne was elected as host city in 2006 and Glasgow will be hosting the upcoming Games in 2014.¹⁴² This chapter will look at the protection afforded to these two events.

The protection afforded to sporting events in Australia to prevent infringements of the protected trademarks is particularly impressive since it is possible to make a claim under federal law concerning intrusions that are prohibited.¹⁴³

Australia has had some form of protection against ambush marketing and unauthorized use of the protected event properties for a number of years. This protection prohibits any form of false representation of the protected trademarks of a sporting event without approval, which extends to preventing any person from making an association between their goods or services and the event in question in such a way that is likely to create a reaction by the relevant people to believe that there is an authorization for the association.¹⁴⁴

As previously mentioned, special provisions to restrict unauthorized use and ambush marketing was enacted during the Olympic Games in Sydney 2000, but there was no *sui generis* right to prohibit unlawful association with the Games. An enactment of such special extended protection was probably seen as unnecessary as it could be prevented under the federal trade practice law.¹⁴⁵ However, when Melbourne was elected to host the 2006 Commonwealth Games a legislation was enacted containing specific protection against persons trying to make an association with the Games without authorization.¹⁴⁶

¹⁴¹ The type of Rugby game played with 7 players from each team – 7 a side.

¹⁴² www.thecgf.com/games/story.asp, last visited: 2013-05-03.

¹⁴³ Johnson, *supra* note 55, p. 137.

¹⁴⁴ *Ibid.*

¹⁴⁵ *Ibid.*, p. 138.

¹⁴⁶ Commonwealth Games Arrangement Act (No.57)(Vict).

Not only did they enact a *sui generis* protection but once more there was a federal law enacted to protect the indicia and images related to the Games, a law which was called Melbourne 2006 Commonwealth Games (Indicia and Images) Protection Act 2005 (MCGPA).¹⁴⁷ The protection within this Act is extended to terms such as ‘Melbourne 2006 Games’, ‘M2006’, ‘Melbourne 2006 Cultural Program’ and other similar phrases,¹⁴⁸ and prohibits any use of a combination of these protected terms and phrases.¹⁴⁹ The prohibition adopted through this Act precludes any unauthorized person from using the protected indicia or images for commercial purposes.¹⁵⁰

The protection afforded to the Commonwealth Games was similar to the protection granted to the Sydney Olympic Games. However, the main difference between the two regimes is that the MCGPA includes a presumption of infringement when an application of the protected indicia or images has been made by a person for the primary purpose of advertising or promotion to enhance the demand for the goods or services.¹⁵¹

In 2014, it is time for Glasgow to be the host city of the Commonwealth Games. Just like before most of the other major sporting events, a condition was put on the Glaswegian organizing committee by the Commonwealth Games Federation to put in place legislation to protect against ambush marketing and prevent unauthorized association with the Games. As a result of this obligation, the Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009 (GCGA) was adopted.

This Act grants a special and exclusive right to the organizing Committee of the Glasgow Commonwealth Games¹⁵² over the so-called Glasgow Commonwealth Association Rights. This means that the organizing committee holds the exclusive right of use of any kind of representation likely to suggest to the public that there is an association between the Games and the goods or services provided.¹⁵³ The use of certain images or words in advertisement would be an example of such an association. This means that a person other than the organizing committee, or any other authorized user, may not use the protected symbols or phrases for commercial purposes. However, as in all of the aforementioned special legislations, the organizing committee can grant its sponsors a written permission to use the Association Rights in relation to the Games.¹⁵⁴ There is no provision within the Act that specifies how or to whom authorization may be granted but it is envisaged that consent will normally be granted only to the official sponsors of the event.

¹⁴⁷ Melbourne 2006 Commonwealth Games (Indicia and Images) Protection Act 2005 (No. 68), [hereafter: MCGPA].

¹⁴⁸ MCGPA, *supra* note 147, section 7(2).

¹⁴⁹ *Ibid*, section 7(3).

¹⁵⁰ *Ibid*, section 12.

¹⁵¹ *Ibid*, section 10.

¹⁵² Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009, section 2, the company named Glasgow 2014 Limited, [hereafter: GCGA].

¹⁵³ GCGA, *supra* note 152, section 4(1).

¹⁵⁴ *Ibid*, section 6(1).

It is not possible to outline all the situations when an association could be deemed to have been created. The evaluation will therefore depend on the specific circumstances and the overall impression given during the potentially infringing companies advertising of its goods or services. The organizing committee will most certainly make the evaluation of the potential infringement on a case by case basis. However, a list of expressions have been included in the Guidance of the Act¹⁵⁵ that are likely to be considered to be an association with the Games and therefore are more likely to be seen as an infringement of the protected Association Rights. It can be any expression that uses a combination of any of the words in the list included in the Guidance, such as ‘Glasgow 2014’ or ‘Games 2014’.¹⁵⁶ Just like all the other event-specific legislations, the duration period of this Act is limited in time and it ceases to have effect six months from the date of the closing ceremony in 2014.¹⁵⁷

5.5.2 New Zealand

Over the last couple of years, a number of major sporting events have taken place in New Zealand. Events such as the Netball World Championships in 2007, the World Rowing Championships in 2010, the Rugby World Cup in 2011 and the upcoming Cricket World Cup in 2015 have led to an adoption of specific provisions in order to prevent different forms of infringements of the protected rights belonging to the event organizers.¹⁵⁸ The new legislation is not tied to a particular event but can be used whenever an appropriate event comes along.¹⁵⁹

For the Major Event Management Act 2007 (no.35) (MEMA) to apply to an event, the event in question needs to be declared a major sporting event by the Governor General.¹⁶⁰ For it to be considered as a major sporting event, certain considerations as to the benefits from such a declaration must be considered, such as that the event will attract a large number of international people and therefore generate significant tourism opportunities for New Zealand or if it requires a high level of professional management and co-ordination.¹⁶¹ Furthermore, the most important part is that such a declaration may only be made in relation to an event that takes place, or at least in part in New Zealand.¹⁶²

¹⁵⁵ Guidance of the Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009.

¹⁵⁶ Guidance of the Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009, p. 2.

¹⁵⁷ GCGA, *supra* note 152, section 19(1).

¹⁵⁸ Johnson, Phillip, *supra* note 55, p. 142, footnote 110.

¹⁵⁹ *Ibid*, p. 142.

¹⁶⁰ Major Event Management Act 2007 (no.35), section 7(1) and section 4, [hereafter: MEMA].

¹⁶¹ MEMA, *supra* note 160, section 7(4)(a) and (c).

¹⁶² *Ibid*, section 7(3).

The protection against unauthorized association allows the Governor General to declare certain words to be major event words. It is not specified which words that can be protected by the MEMA but any word or word combination that relates to the event can be declared as a major event word.¹⁶³ These words can be protected from unauthorized commercial exploitations at any time from the start of the protection period, which is defined on a case by case basis, and for up to 30 days after the event has finished.¹⁶⁴ This is called the major events protection period.¹⁶⁵ In relation to the words protected as major event words, a person is prohibited from making any representation, which is likely to suggest to consumers that there is an association between the event in question and the goods or services provided during the protection period.¹⁶⁶ As soon as any of the certain designated words are used the Court may presume that it is a representation that is in breach of the prohibition just mentioned.¹⁶⁷

There are a number of exceptions to this provision, such as any representation, which is authorized by the event organizers, or a representation which is a personal opinion made by a natural person for no commercial gain.¹⁶⁸ As an example, the Rugby World Cup was held in New Zealand 2011 and it was declared to be a major event under section 7 MEMA.¹⁶⁹ All combinations of words such as ‘Rugby’, ‘World Cup’ and ‘New Zealand 2011’ and many more are declared to be major event words under section 8 MEMA.¹⁷⁰ Assuming that a New Zealand company named ‘The World’s Best Cup Maker!’, established in 1980, for many years has advertised their business with a slogan saying ‘Maker of all cups and trophies for all sporting events from rugby to synchronised swimming!’ with a logo of a person running with a rugby ball. His company continues to operate and promote itself in the same way during the period when the Rugby World Cup is held in New Zealand. Even if the company did not have the written authorization of the event organizers for the use of its company name, its advertisement, its slogan or its logo, the use is not a breach of section 10 MEMA because of the exception in section 12(1)(d)(iii) MEMA.

The use restrictions of protected event words in New Zealand are very broad and could prevent most types of ambush and infringements. If looking at the protection from an event organizer’s perspective the New Zealand protection represents the gold standard in preventing the unauthorized use of the protected words and symbols. A sponsorship perspective would also make New Zealand the ideal place to host an event like this. Most

¹⁶³ MEMA, *supra* note 160, section 8(1).

¹⁶⁴ *Ibid*, section 9.

¹⁶⁵ *Ibid*, section 4.

¹⁶⁶ *Ibid*, section 10.

¹⁶⁷ *Ibid*, section 11.

¹⁶⁸ *Ibid*, section 12.

¹⁶⁹ Major Event Emblems and Words (Rugby World Cup 2011) Order 2008, section 3.

¹⁷⁰ *Ibid*, section 5 and schedule 2.

importantly, this broad protection is likely to push up the bar for future host countries of other sporting events.¹⁷¹

5.6 Summary – the Common Denominators of the Extended Protections

All of the legislations examined in this chapter do in fact provide the event properties with a protection that goes beyond the protection provided by the ordinary trademark laws, regardless of the nature of the legislation. This means that even if the legislation is not part of the federal law and is limited in time, the protection provided will still be extended in comparison to the protection provided by ordinary trademark law. That this extended protection indeed is more powerful can, in particular, be deduced from the fact that there is no requirement that the use of the mark must be misleading or deliberate for it to constitute an infringement of the protected event mark. In the presented legislations, it is sufficient that the public have been given the impression of an existing relationship between the company and the event in question. In other words, even if there is no risk of confusion to the consumers, the use might still be found as infringing these special legislations. The only time an exception will be made is if the use has been authorized by the event organizers in some way. These facts are all common denominators of the various event-specific legislations examined in this thesis.

The host countries have, however, not been as coordinated when it comes to the remedies provided by their event-specific legislations. Some of the countries have chosen not to distinguish between the remedies provided by their ordinary national trademark laws while other countries consider the unauthorized use to be a more serious offense that requires stronger measures. The organizers of the London Olympic Games chose to keep the traditional legal remedies for a trademark infringement while the Sydney Olympic Games was, besides the traditional remedies, provided with the so-called ‘corrective advertisement’ remedy which was a very powerful threat since it could seriously damage the company’s image in front of their consumers. However, the most powerful remedy ought to be the one provided by the South African legislation where an unauthorized association with the sporting event was deemed to be a criminal offence that could lead to imprisonment.

¹⁷¹ Johnson, *supra* note 55, p. 143.

6 Analysis

When an application for a Community trademark registration is filed, it is quite clear what this mark needs to fulfil in order to obtain such a registration. It needs to be a sign capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of others.¹⁷² It is also stated that the sign needs to have a distinctive character and not be exclusively descriptive of the goods and services provided.¹⁷³ Even if these clear requirements are stated, the assessment of an application for registration is not always an easy task. Some marks are obviously not fulfilling the requirements while others might be more ambiguous, and to draw a line between these two might be hard.¹⁷⁴

As mentioned earlier in this thesis, two tests, the distinguishing and protective functions, have been identified as underlying the application of the absolute grounds of refusal in Article 7(1)(b)-(c) CTMR. The purpose of these tests is to help the courts in their assessments of the various registration applications. It is not stated which test should take precedence and the CJEU has not been consistent in its approach to which one of the tests should be the governing one. This has led to some cases having different outcomes, as illustrated with the analysis of the cases in Chapter 2.1.3 of this thesis.

Although the CJEU, primarily, seem to think that descriptive marks should be kept freely available for the public to use, it still considers it important to take into account the distinguishing function before delivering a decision. If the relevant consumers would perceive the descriptive mark as an indication of origin, the distinguishing function of the mark could be enough for the CJEU to make an exception to the refusal ground in Article 7(1)(c) CTMR.¹⁷⁵

The importance of the protective function seemed to be contradicted in the ‘BABY-DRY’ case, where the CJEU held that when assessing the registrability of marks composed of words, it is important to determine the descriptiveness in relation to the mark as a whole from the relevant consumers point of view. In other words, the CJEU here stressed the importance of the distinguishing function.¹⁷⁶ The fact that the CJEU, in a third case, chose to yet again give primacy to the protective function has left some uncertainty regarding which one of the tests should take precedence and it has still not been settled.¹⁷⁷

¹⁷² Article 4 CTMR together with Article 7(1)(a) CTMR.

¹⁷³ Article 7(1)(b)-(c) CTMR.

¹⁷⁴ Davis, *supra* note 10, p. 211-212.

¹⁷⁵ *Joined cases* Case C-108/97 and Case C-109/97 *Windsurfing Chiemsee*, *supra* note 31, para. 25 and 37.

¹⁷⁶ Case C-383/99 P *Baby-Dry*, *supra* note 5, para. 40-44.

¹⁷⁷ Case C-191/01 *Doublemint*, *supra* note 42, para. 32.

The CJEU has had plenty of opportunities to explain the proper means of the interpretation of the two tests but have continuously failed to establish a coherent overarching framework for the operation of the tests. By examining the result of the case law from the CJEU it seems like it has divided the assessments in two steps, where the first step would be to consider whether the sign is distinctive in accordance with Article 7(1)(b) CTMR, where the consumer interpretation is paramount. The next step would then be to examine whether the sign is descriptive and should be left free for everyone to use in accordance with Article 7(1)(c) CTMR. However, to treat the provisions disjunctively is regarded as inadequate by some because it pays insufficient attention to the clear overlap between the scope of the distinctiveness and descriptiveness provisions.¹⁷⁸

The question of how these provisions should be interpreted still remains and there are a variety of ways of approaching it. One way of approaching this question would be to argue that the interests of other traders should be dealt with separately from the question of consumer reaction. In support of this it has been argued that the effect of a registration on other traders remains the same regardless of the level of consumer recognition of the mark. This means that the interpretation of Article 7(1)(b)-(c) CTMR should be done so that the provisions collectively serve a distinguishing function only but still preclude from registration marks that would lead to excessive negative impact on the commercial practice of the traders.¹⁷⁹

Another possible interpretation is that neither of the two functions are relevant in this assessment. This is a market-oriented approach that promotes efficiency by leaving considerations regarding competition to the marketplace. On this view, a registration application would be assessed under Article 7(1)(b)-(c) CTMR solely in terms of its possibility of fulfilling the essential functions of a trademark and the needs of other traders will not be taken into account at this stage.¹⁸⁰

The alternative that has the advantage of being consistent with the CJEU's decision in the 'BABY-DRY' case is the one that recognises the interdependence between the two provisions. This would mean that a unified test of distinctiveness would be established, which takes into account a range of needs and interests of other traders and the consumers.¹⁸¹

Many alternative approaches have been outlined by various scholars and others that have been debating this question, but the real concern is that the CJEU has not provided a clear view as to how the provisions in Article 7 CTMR, as a whole, should be interpreted. The jurisprudence of the CJEU seems to be based on vague ideas and principles that most likely is not a product of the concept of the purpose of the distinctiveness provisions. What these results are based on is hard to determine and the CJEU has not

¹⁷⁸ Handler, *supra* note 48, p. 309.

¹⁷⁹ *Ibid.*, p. 312.

¹⁸⁰ *Ibid.*

¹⁸¹ *Ibid.*

sought to identify the needs and interests of the parties that are affected by such trademark registrations and where these needs should be adapted within the Community trademark registration system. An answer to the question will be found only when the CJEU directly engages with this task. Once it has delivered a clear answer, a coherent framework for the interpretation of the distinctiveness provisions in Article 7 CTMR is likely to emerge.¹⁸² Until then we will have to deal with the fact that it is not clear when an exception from the fulfilment of the required distinctive character can be made.

When it comes to trademarks relating to various sporting events, the organizers have, because of numerous reasons, been wanting to protect them from use which could jeopardize the existence of the event. Because of this, the organizers have tried to obtain a trademark registration to protect their various symbols from the harmful use. However, when it comes to the protection of valuable words and phrases that most likely would be associated with the event in question, just as much as the protected symbols, it has come across some obstacles regarding the fulfilment of the requirements in order to obtain a trademark protection. Words or phrases such as ‘London 2012’, ‘Rio 2016’ and ‘World Cup 2014’ are all lacking the distinctiveness needed in order to obtain an ordinary trademark registration since they purely describe something happening in the city during a certain year.

The Olympic rings are probably one of the most recognizable symbols in the world and therefore it is unsurprising that various companies want to associate their businesses with this valuable brand. Most of the event related symbols, terms and logos are already registered as Community trademarks and protected by specific legislations such as the Nairobi Treaty that protects the Olympic symbol and the Olympic Charter, which protects the other Olympic properties. These legislations give the properties the same protection as an ordinary trademark protection, since these symbols and specific words are the permanent properties that do not change between events. However, these legislations do not include a protection of the event-specific ‘City + Year’ identifications, which are, according to the IOC and FIFA, very valuable indications to each one of the events and because of this need to be protected as official trademarks. To obtain a protection for these identifications, the event organizers have started to enact the so-called *sui generis*, extended protection, legislations in which they have introduced a protection for ‘Listed Expressions’. When considering the 2012 London Olympic Games, these expressions could be words like Games, Two Thousand and Twelve, 2012 and Twenty-twelve and the use of any of these expressions in itself or in a combination with words like London, Medals, Gold, Silver or Bronze could be seen as an infringing association with the event.¹⁸³

¹⁸² Handler, *supra* note 48, p. 312.

¹⁸³ www.london2012.com/documents/brand-guidelines/guide-to-protected-games-marks.pdf, last visited: 2013-05-07.

Before each new major sporting event, the *sui generis* protections have, up until today, provided the event organizers with a stronger protection with the consequence of restricting the possibility to use certain marks. As the two major events in Brazil have not been held yet, the extended protection in relation to the 2012 Olympic Games are to be considered the most restrictive legislation in their scope. Even simple messages such as ‘Visit London with us in 2012’ would most likely create an association with the event that could be regarded as an infringement of the 2006 Act. The only way to ‘legally’ make an association with the Games would be to become an official sponsor. However, to become an official sponsor of a major sporting event is not an easy task since there is only room for one official sponsor from each market segment, meaning that the competition between potential sponsors will increase and, in turn, lead to higher amounts of money paid to become an official sponsor of the event. To grant exclusivity will therefore be the key to success since this will lead the organizing committees to make the most money out of their agreements with official sponsors.¹⁸⁴

Despite some concerns about the potential anti-competitive effects and restrictions to the freedom of expression, which are commonly attached to *sui generis* legislations, it seems that this type of legislation would be found unconstitutional and furthermore regarded as infringing competition rules only if it introduces restrictions that are unjustifiable and thus will harm the public interest. However, the event organizers are most often in possession of good arguments to justify these special legislations where the main one is that without such exclusivity over terms commonly associated with the event, sponsorship would lose its value and events might lose the financial source which in turn would jeopardize the existence of the event itself. One could expect that the organizing committee have weighed the benefits and burdens of such an event before enacting special legislation and before bidding to host a major event have concluded that the benefits outweigh the burdens.¹⁸⁵

The fact that the cases discussed in the previous chapters all refused registrations of the word marks applied for because of their descriptive nature, there are still questions that were not addressed. The answer to the question of who actually coined the expression ‘World Cup’ could have changed the understanding of the Courts but instead this question remained unanswered. If competitors had already used the expression before FIFA organized their first championship, it would be unfair to grant an exclusivity of the expression to FIFA through a trademark registration. Such monopolization of the term would then be completely unjustified. Conversely, if FIFA was the organization that coined the expression as an indication of its international football event, it would be fair to grant an exclusivity over the expression. Either way, several years have now passed since the Board delivered the ‘World Cup’ decisions and to claim exclusivity over the expression would now be too late, even if the term was found to be

¹⁸⁴ <http://www.london2012.com/about-us/our-brand/using-the-brand/#who-allowed-to-use-Games-Marks>, last visited: 2013-05-07.

¹⁸⁵ Dannemann, *supra* note 64, p. 66-67.

coined by FIFA. The expression has now become a customary term that identifies various international sporting competitions and to monopolize these words would therefore be excessive because that would oblige earlier users to suddenly refrain from their use. Through the analysis of the cases from Germany and the U.S it seems clear that the courts are of the understanding that descriptive marks, and marks that have become customary terms to identify an event, should be left free for others to use. However, this has not yet been discussed by the CJEU and it remains uncertain whether the courts at the European level will adopt a similar understanding.¹⁸⁶

The ‘City + Year’ identifications belong to a group of marks that have been widely discussed. This group of marks are often referred to as event marks, which some scholars think should be recognised as a new category of trademarks that should enjoy the same protection as ordinary Community trademarks in order to provide an enhanced protection over the marks of various sporting events, without the need of enactment of special legislation. The same scholars are using the advertising function of the event marks as an argument in favour of registrability of this category of marks, since a use of the event marks by non-official sponsors might lead the consumers to think that there is a relationship between the event and the company. A false association like this might negatively affect the investments made by official sponsors and in order to avoid this negative effect, the advertising function of event marks needs to be protected.¹⁸⁷ However, this approach has been heavily criticised. A large part of the doctrine argues that event marks should not be treated any differently to ordinary trademarks, which means that event marks, such as the ‘City + Year’ identifications, as any other mark, should fulfil the requirements for registration stated in the CTMR in order to be eligible for registration. This argument has been debated in relation to marks such as the ones discussed in the ‘World Cup’ cases and the ‘USA03’ case where it was said that these signs could not be registered due to the fact that they were descriptive and devoid of any distinctiveness and thus could not fulfil the indication of origin requirement. To grant an exclusive right over a descriptive mark by approving trademark application could lead to negative effects on competition since this might hinder others from use of the commonly coined terms, which should be free for everyone to use. Some scholars therefore insist on the ‘need to keep free’ principle, or in other words the protective function, in order to regulate these registrations. On the other hand, the question is whether this potential risk of restricting the competition would be reason enough not to protect the legitimate interest of the event organizers.¹⁸⁸

It has been shown that it is not always an easy task to determine whether a descriptive mark such as the ‘City + Year’ identifications should be granted a trademark registration or not with different interests making it hard to assess. Traditional legal measures, such as the ordinary trademark laws, are

¹⁸⁶ Dannemann, *supra* note 64, p. 38-40.

¹⁸⁷ *Ibid*, p. 45-48.

¹⁸⁸ *Ibid*, p. 50-53.

not always sufficient enough to combat the most sophisticated forms of unauthorized use of the event properties and it is argued, by the event organizers and its official sponsors, that a *sui generis* legislation is needed in order to increase their legal certainty. The event-specific legislation will provide the organizers with effective means to combat the unauthorized use of the words and symbols which are associated with the event in question. However, the biggest problem with a legislation like that is that it can bring concerns about anti-competitive behaviour where competition authorities might interpret the effect of granting the exclusive rights over descriptive words to event organizers as a strategy to avoid competition, which might lead to an abuse of a dominant position through the monopolization according to Article 102 TFEU. This is an argument that might be used by the non-sponsors in their attempt to stop the desired event-specific legislation. In this situation it is vital to remember that major events might not survive without the investments from their sponsors. Therefore, it is important for the legislators to take into consideration that reasonable restrictions of the use of the 'City + Year' identifications, even if they are descriptive and should be left free for others to use, might be necessary in order to guarantee the value and attractiveness of the events.¹⁸⁹

When the legislators are trying to satisfy different interests, the problem that arises is how the assessment of what a reasonable restriction is should be performed. The enactment of the enhanced protection at the various sporting events stated in previous chapters have, ever since the Sydney Olympic Games in 2000, included a controversial association right which has not been covered by the protection provided by the legislations protecting other event symbols. The protection of these association rights empowers the organizing committee to stop companies from making an unauthorized association to the event. Before the 2012 London Olympic Games was held, a woman wanted to register 'GREAT EXHIBITION 2012' as a trademark for her business. Her aim was to organize live art and community events to celebrate all that is remarkable about the United Kingdom, and this event was to take place in August in 2012, at the same time as the Olympic Games. Her registration application was denied on the grounds that it seemed to be making an association with the Games. The organizing committee argued that in accordance with the LOGPGA, they could use 'association' in the broadest of terms. If this was a reasonable restriction is hard to say but the introduction of the protection of the association right has created heavy debates. Some are arguing that if there is no confusion around whether or not you are a sponsor, there should not be a problem since people are not stupid, and if no such confusion exists, the general public should know that there is no connection between the company and the event. This extended protection has therefore been criticised and said to be a step too far in some cases.¹⁹⁰

¹⁸⁹ Dannemann, *supra* note 64, p. 62-66.

¹⁹⁰ Smith, Adam. *Ramping up trademark protection at the Olympics*, World Trademark Review, October/November 2011, p. 43-44, [hereafter: Smith].

What is left to discuss is the big question if the extended protection of the association rights, such as the ‘City + Year’ combinations, really is needed and if it is desirable? Even if the answer to the question is clear in some of the Member States of the EU, the issue is yet to be decided on at a Community level. The understanding of the CJEU will certainly have a great impact throughout the Member States since they are obliged to adapt to the decisions made by the CJEU. In other words, even if the Member States by law prohibit the registration of event marks, National Courts would not be able to stop the enforcement of a legally granted Community trademark, even if it concerns a mark that is descriptive. A survey involving countries from around the world was made to investigate the desirability of recognising event marks as a new category of trademarks. This survey showed that an enhanced protection for event marks could be justified only if it provided a balance between the interests of all parties. Trademark and competition law should not be amended merely for major sporting events. If enhanced protection was to be found as needed it should preferably be limited in time and only apply under certain circumstances.¹⁹¹

Most of the host countries discussed in this thesis chose to adopt *sui generis* protections for the protection of their events, which were limited in time. Interestingly, New Zealand was the only country that informed about that they provided for specific protection of event marks, not in the form of an event-specific legislation that is limited in time but included the special protection for trademarks in connection to major sporting events in the federal law as long as the event could be classified as a ‘major event’ under the MEMA. The same applies to South Africa and its protection under the Merchandise Marks Act.¹⁹²

The consequence of granting a ‘special’ treatment to event marks might have an influence on the assessment regarding the registrability of trademarks by opening the gates to a trademark protection to marks that are not distinctive enough and which, in a normal case, should remain free to the public. However, this could lead to other industries pushing for the same treatment. This is why an event-specific legislation, which is limited in time and only applies to a specific event, is preferable to recognizing event marks as a new category of trademarks.¹⁹³

¹⁹¹ Dannemann, *supra* note 64, p. 67-69.

¹⁹² *Ibid.*, p. 69-70.

¹⁹³ *Ibid.*

7 Conclusion

When applying for a Community trademark registration, certain requirements need to be fulfilled in order to obtain the registration applied for. These requirements are clearly stated in the Community Trade Mark Regulation. However, what is not as clear is how the provisions regarding the registration should be interpreted. Two tests have been identified but the outcome of the various CJEU decisions have been inconsistent regarding which one of the tests that should take precedence. This has led to some confusion on how to interpret the provisions and until the CJEU directly engages with the task to solve the question, a coherent framework will be missing. Just by analyzing the decisions delivered by the CJEU up until today, my conclusion would be that the only time an exception from the required distinctive character can be made is when a descriptive mark, according to the consumer perception, can be perceived as an indication of origin.

When entering the realm of sports, traditional legal measures are not always sufficient to protect valuable marks and to combat the unauthorized use made of these marks. The event organizers of the major sporting events have, therefore, been pushing hard to enact an extended protection in order to protect terms and symbols related to the events, and to be able to guarantee the necessary exclusivity to their official sponsors. There is no legal protection for events as such and there have been lively discussions regarding the registrability of event marks and whether or not they should fulfil the same requirements as any ordinary trademarks.

After a thorough analysis, I can conclude that there is no need for an extended permanent protection to protect the event organizers from unauthorized use. Considering the detrimental effects such protections could lead to in the existing trademark systems, the benefits of such legislations do not outweigh the burdens. However, in order to not jeopardize the existence of the major sporting events, financial support needs to be secured, which means that a temporary extended protection like the event-specific legislations would be a fair solution. Before the adaption of such legislation, it needs to be carefully analysed since that kind of protection could lead to a restriction of the freedom of expression and anti-competitive behaviour.

The same caution should be applied to the creation of a new category of trademarks. To accept event marks as a new category, the registration requirements of such marks would be more lenient. Since this new category would be protected under ordinary trademark law, the monopoly granted over such terms, that should be kept free for everyone to use, would be eternal. This is not only unnecessary but also undesirable from a legal point of view. Furthermore, it is only fair to conclude that event marks should fulfil the same requirements as ordinary trademarks in order to be eligible for a registration. This means that the protection of the 'City + Year'

identifications should only be justified if it fulfils the requirements stated in the Community Trademark Regulation. Even if this is the case, marks like that will continue to be protected by enactments of event-specific legislations because of its great value to the event organizers.

Bibliography

Legislative Material

Brazilian Industrial Property Law No. 9.279 of 14 May 1996, [Brazil].

Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark.

Commonwealth Games Arrangement Act (No.57)(Vict) [Australia].

Federal Olympic Act, Law No. 12.035 of October 2009, [Brazil].

Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009, [UK].

Guidance of the Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009, [UK]

London Olympic Games and Paralympic Games Act 2006, [UK].

Major Event Emblems and Words (Rugby World Cup 2011) Order 2008, [New Zealand]

Major Event Management Act 2007 (no.35), [New Zealand].

Melbourne 2006 Commonwealth Games (Indicia and Images) Protection Act 2005 (No. 68), [Australia].

Merchandise Marks Act (No. 17) of 1941, [South Africa].

Nairobi Treaty of the Olympic Symbol, available at:

http://www.wipo.int/export/sites/www/treaties/en/ip/nairobi/pdf/trtdocs_wo018.pdf, last visited: 2013-05-10.

The Olympic Charter, available at:

http://www.olympic.org/Documents/olympic_charter_en.pdf, last visited: 2013-05-10.

Olympic Symbol etc. (Protection) Act 1995, [UK].

Pelé Law No. 9.615 of 24 March 1998, [Brazil].

Senate Bill No. 394/2009, [Brazil].

Sydney 2000 Games (Indicia and Images) Protection Act 1996, [Australia].

Trade Practices Act (No. 76) of 1976, [South Africa].

Literature

Amis, John., Cornwell, T. Bettina., *Global Sport Sponsorship*, 2005, Oxford International Publishers Ltd.

Bently Lionel., Sherman, Brad., *Intellectual Property Law*, 3rd edition, 2009, Oxford University Press Inc., New York.

Davis, Jennifer, *Intellectual Property Law*, 4th edition, 2012, Oxford University Press.

Firth, Alison., Lea, Gary., Cornford, Peter., *Trade Marks, Law and Practice*, 3rd edition, 2012, Jordan Publishing Ltd.

Johnson, Phillip, *EIPR Practice Series; Ambush Marketing: A Practical Guide to Protecting the Brand of a Sporting Event*, Book 1 2007, 2008, Sweet & Maxwell Limited, London.

MacQueen, Hector., Waelde, Charlotte., Laurie, Graeme., *Contemporary Intellectual Property – Law and Policy*, 2008, Oxford University Press Inc., New York.

Articles

Dannemann Lundgren, Felipe. *Event Marks: A Necessary Form of Protection against Ambush Marketing?*, 2010, a thesis submitted to the Munich Intellectual Property Law Center, available at: http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1742420, last visited: 2013-05-10.

Handler, Michael, *The distinctive problem of European trade mark law*, E.I.P.R. 2005, 27(9), 306-312.

Smith, Adam. *Ramping up trademark protection at the Olympics*, 2011, October/November, World Trademark Review.

Vivlund Martina. *Event Marks: Trademark Abuse or Necessary Form of Protection in View of Ambush Marketing*, 2012, Lund Student EU Law Review, available at: [http://www.jur.lu.se/Quickplace/eu_law_review/Main.nsf/0/BE6BEFE32576AABCC125799E00316E6D/\\$file/Volume%201%20Full%20Version.pdf](http://www.jur.lu.se/Quickplace/eu_law_review/Main.nsf/0/BE6BEFE32576AABCC125799E00316E6D/$file/Volume%201%20Full%20Version.pdf), last visited: 2013-04-22.

Electronic Sources

<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2008:313:0049:0049:EN:PDF>, last visited: 2013-05-21.

http://espn.go.com/sports/soccer/story/_/id/7913981/brazilian-bill-gives-fifa-guarantees-2014-world-cup-preparations, last visited: 2013-04-29.

http://www.fifa.com/mm/document/affederation/marketing/01/37/85/97/2014_fifapublicguidelines_eng_04042013.pdf, last visited: 2013-04-29.

www.london2012.com/documents/brand-guidelines/guide-to-protected-games-marks.pdf, last visited: 2013-05-21.

[http://www.london2012.com/about-us/our-brand/using-the-brand/#who-allowed-to-use Games Marks](http://www.london2012.com/about-us/our-brand/using-the-brand/#who-allowed-to-use-Games-Marks), last visited: 2013-05-07.

http://www.olympic.org/Documents/olympic_charter_en.pdf. last visited: 2013-05-21.

http://www.riksdagen.se/sv/Dokument-Lagar/EU/EU-forslag/Proposal-for-a-REGULATION-OF-T_H1B6161/, last visited 2013-05-22.

<http://www.rio2016.com/en/copyright>, last visited: 2013-04-10.

<http://www.spoor.com/home/index.php?ipkMenuID=&ipkArticleID=303>, last visited: 2013-05-04.

www.thecgf.com/games/story.asp, last visited: 2013-05-03.

http://www.wipo.int/treaties/en/ip/nairobi/trtdocs_wo018.html, last visited: 2013-05-21.

Table of Cases

EU

European Court of Justice

Joined Cases C-108/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehor Walter Huber*; C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs BmbH v Attenberger*, *Windsurfing*, [1999] ECR I-2779, referred to as: *Windsurfing Chiemsee* .

Case C-383/99 P, *Procter & Gamble CO v. OHIM*, [2001] ECR I-06251, referred to as: *Baby-Dry*.

Case C- 273/00, *Sieckmann v Deutsches Patent- und Markenamt*, [2002] ECR I-11737.

Joined Cases C-53/01 *Linde AG*, C-54/01 *Winward Industries Inc.* and C-55/01 *Rado Uhren AG*, [2003] ECR I-03161, referred to as: *Linde et al.*

Case C-191/01, *OHIM v Wrigley*, [2003] ECR I-12447, referred to as: *Doublemint*.

Court of First Instance

Case T-118/06, *Zuffa v OHIM (ULTIMATE FIGHTING CHAMPIONSHIP)*, ECR II-00865.

Office for Harmonisation in the Internal Market

OHIM – First Board of Appeal, decision R 931/2005-1 - ULTIMATE FIGHTING CHAMPIONSHIP (30 January 2006)

OHIM First Board of Appeal, decision R 1466/2005-0 1- WORLD CUP 2006 (20 June 2008).

OHIM First Board of Appeal, decision R 1467/2005-1 - GERMANY 2006 (30 June 2008).

OHIM First Board of Appeal, decision R 1468/2005-1 - WM 2006 (30 June 2008).

AG Opinions

AG Jacobs in Case C-191/01 P *Doublemint* [2003] ECR I-12447, opinion delivered on 23 October 2003.

US

Federation Internationale de Football Association v Nike, Inc., 285 F. Supp.2d 64 (D.D.C 2003).