

Szwajdler Paweł. The Protection of Sports Trademarks in the Recent Case Law of the Court of Justice of the European Union = Ochrona sportowych znaków towarów w świetle najnowszego orzecznictwa TSUE. Journal of Education, Health and Sport. 2016;6(3):259--264. eISSN 2391-8306. DOI <http://dx.doi.org/10.5281/zenodo.61991>
<http://ojs.ukw.edu.pl/index.php/johs/article/view/3851>

The journal has had 7 points in Ministry of Science and Higher Education parametric evaluation. Part B item 755 (23.12.2015).
755 Journal of Education, Health and Sport eISSN 2391-8306 7

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The authors declare that there is no conflict of interests regarding the publication of this paper.

Received: 05.08.2016. Revised 25.08.2016. Accepted: 06.09.2016.

The Protection of Sports Trademarks in the Recent Case Law of the Court of Justice of the European Union

Ochrona sportowych znaków towarów w świetle najnowszego orzecznictwa TSUE

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Abstract

The main aim of this work is to give an answer to the question: are sports trademarks treated in EU in different way than other trademarks? The author of this article was inspired by two recent judgements of EU Court of Justice. First of them is related to sports shoes and second one to football club crest. Above- mentioned judgement are interesting, because both of them concern marks, which are similar to registered trademarks. Therefore, it is able to show boundaries of the protection of sports trademarks. This paper contains also overall considerations about trademarks, sports trademarks and their protection.

Abstrakt

Głównym celem niniejszego artykułu jest udzielenie odpowiedzi na pytanie, czy sportowe znaki towarowe podlegają w Unii Europejskiej szczególnej ochronie prawnej. Inspirację dla zarysowanych w zdaniu poprzednim rozważań stanowią dwa wyroki Trybunału Sprawiedliwości Unii Europejskiej. Pierwszy spośród nich dotyczy ochrony konturów herbu klubu piłkarskiego, natomiast drugi dotyczy problemów związanych z charakterystycznym znakiem umieszczonym na produktach znanej marki butów sportowych. Omawiane w niniejszej pracy wyroki są wyjątkowo interesujące, ponieważ wiążą się z ochroną znaków li tylko przypominających zarejestrowane ZTUE. Artykuł zawiera również ogólne refleksje na temat znaków towarowych, sportowych znaków towarowych oraz przeciwdziałania ich naruszeniom.

Key word: sport, trademark, sports trademark, EU Court of Justice, intellectual property rights

Słowa kluczowe: sport, znak towarowy, TSUE, prawo własności intelektualnej, sportowy znak towarowy

1. Introduction

It is obvious that improper use of intellectual property rights should be forbidden, but nowadays trademarks can be also overprotected¹, because of the fact that owners of such rights try to protect some marks, which are only similar to their logos. The EU Court of Justice ruled recently in cases related to sports trademarks such as football club crest and logo of producer of sport shoes. Above- mentioned cases, which inspired the author to write this article are interesting, because they let understand, what boundaries of protection of trademarks are. In the beginning of this work, the author would like to describe trademarks and sports trademarks, which are in his opinion special kind of trademarks. The protection of trademarks in European Union is also elaborated in this paper. After showing above-mentioned background, the author considers recent rulings of EU Court of Justice and states that protection of trademarks is not unlimited. The main aim of this work is to give an answer to the question: are sports trademarks treated in EU in different way than other trademarks?

2. The notion of trademark

Trademarks are understood not only as names, words, symbols², but also as shapes, sounds, smells³ and combinations of them⁴, which let consumers distinguish some products from others.⁵ It is necessary to find out that such definition is not suitable in relation to club crests. It is crucial to add that trademarks can be also used so as to discern organizations. The notion of trademark was also regulated in Council Regulation No 207/2009 of 26 February 2009 on the European trademark. Article 1 of this legal act states that trademarks should be unitary and related to goods or services.⁶ It is important to notice that it is not explicitly regulated, what European trademark exactly is. It is justified solution, because it is impossible to define above- mentioned notion in a changing world. Definition of trademark should be created by judges. The main reasons of protecting trademarks are among others identification of products and develop their quality.⁷ In relation to sports shoes both of this reasons are important. Sports clubs should pay attention especially to the first of them. It is also important to add, that trademark is thought to be sufficient to buy a product without checking other features.⁸ In some scholars opinion, trademark should guarantee the same quality, which other products of the same company have.⁹

¹ J. Gordon Hylton, *The Over- Protection of Intellectual Property Rights in Sport in the United States and Elsewhere*, *Journal of Legal Aspects of Sport*, Vol. 21, 2011-2012 p. 44.

² J. Friedmann, *Trademark*, *Fordham Law Review*, Vol. 64, Issue 3, December 1995 p. 730.

³ M. Lemley, *Grounding Trademark Law through Trademark Use*, *The Trademark Reporter*, Vol. 98, Issue 6(November- December 2008), p. 1346.

⁴ Art. 1 of Chinese Trademark Law(May, 6 1930), *China Law Review*, Vol. 5, Issue 2(February 1932), p. 103.

⁵ J. Friedmann, *op. cit.*, p. 731.

⁶ Art. 1 of Council Regulation No 207/2009 of 26 February 2009 on the European trade mark.

⁷ D. Fetterman, *Trademark*, *Washington and Lee Law Review*, Vol. 43, Issue 2(Spring 1986) p. 763.

⁸ L. Heymann, *Trademark as Promise*, *Jotwell: The Journal of Thing We Like(Lots)*, 2013, p. 178.

⁹ A. Natanson, *Licensing Your Trademark*, *The Trademark Reporter*, Vol. 46, Issue 2(1956), p. 133.

It is necessary to notice that only registered trademark can be protected.¹⁰ The reason of this principle is the fact that almost everything can be treated as a trademark and registration can limit improper use of above- mentioned protection.

3. Sports trademarks

Division between sports and others trademarks is not regulated in any legal act. In opinion of this paper author, sports trademarks can be understood in two different ways. First of them is related only to sports organizations or sports clubs. Second is also connected with sports products such as clothes, shoes or other equipment. In this work, last mentioned way of understanding sports trademarks is applied. In USA, trademark protection is not only related to brands of professional leagues, but also to recreational and students' sports organizations.¹¹ Names, logos and even design of helmets or uniforms are under this protection.¹² The example of protected name and logo is word: „Olympic” and five rings.¹³ Protection of names and logos of sports teams and organizations began in 50s, but it was not at first related to theory of trademarks, but to the theory of false advertising.¹⁴ Thanks to this information, it is possible to answer to the question: why are trademarks of sports organizations protected? They are under protection, because above- mentioned entities would like to earn as much as it is possible, thanks to advertisements. Sports clubs would also like to sell their products such as clothes, cups, bags etc. Because of it, they are getting more and more similar to other producers.

4. The protection of trademarks in European Union

In the beginning of this chapter, it is important to consider, that protection of trademarks is limited only to defined territory.¹⁵ Thanks to European regulations, trademarks can be protected in the whole European Union. In European Union, main institution, protecting intellectual property and taking part in process of trademarks' registration, is EU Intellectual Property Office(OHIM).¹⁶ It is important to highlight that OHIM's decisions can be controlled by the Court of Justice of the European Union.¹⁷ OHIM also publishes its proposal of amendments of trademark law.¹⁸ It is crucial to inform that only registered European trademark can be protected in European Union.¹⁹

5. The case C-396/15 P- Shoe Branding Europe versus Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)

In this case, producer of shoes wanted to protect his ability to place two parallel stripes on their products.²⁰ The General Court²¹ and The Court of Justice of the European Union

¹⁰ P. Maier, OHIM and European Trademark Harmonization, Fordham Intellectual Property Media and Entertainment Law Journal, Vol. 23, p. 693.

¹¹ A. Moorman, Sport Logo Trademark Infringement and The Christian Apparel Industry: Legal and Managerial Considerations for Sport Organizations, Journal of Legal Aspects of Sport, Vol. 8 No. 2, Spring/ Summer 1998, p. 60.

¹² Ibidem.

¹³ A. Clement, Contemporary Trademarks and Sport, Journal of Legal Aspects of Sport, Vol. 12, 2002 p. 2 and p. 5.

¹⁴ J. Gordon Hylton, The Over- Protection of Intellectual Property Rights in Sport in the United States and Elsewhere, Journal of Legal Aspects of Sport, Vol. 21, 2011-2012 p. 47.

¹⁵ L. M. van Hoozer, International Trademark Law, Mississippi Law Journal, Vol. 42, Issue 2(Spring 1971), p. 178.

¹⁶ J. Bak, OHIM: The European Community Trademark's PTO, The Journal of Contemporary Legal Issues, Vol. 19, 2010, p. 418.

¹⁷ J. Moskin(Editor-in-Chief), Procedural Issues in OHIM Proceedings and Related Appeals, The Trademark Reporter, Vol. 104, Issue 2(March- April 2014), p. 597.

¹⁸ J. Norton, OHIM calls for surplus to be repaid to TM Owners, Managing Intellectual Property, No. 196 February 2010 p.11.

¹⁹ P. Maier, OHIM and European Trademark Harmonization, Fordham Intellectual Property Media and Entertainment Law Journal Vol. 23, p. 693.

²⁰ Judgement of CJEU (C-396/15 p), paragraphs 2, 7 and 11.

ruled that placing of two parallel stripes infringes trademark of the company, which registered three parallel stripes as trademark.²²

Above- mentioned verdict is not the most important in sports matters, because of the fact that such judgement could have been passed in case without any relation to sport. The most interesting in this sentence is consideration that sports shoes are goods, which are made for average consumer.²³ If the products were aimed at professional sportsmen, then trademark protection could be less severe.²⁴ It should be noticed that trademarks of professional sports products can be less protected than trademarks of sports products for average consumers. It is obvious, because professionals should be more aware of trademarks of different companies. In opinion of this work author, it can be related to the fact, that it exists differences between professional and amateur sport. Professional purchaser of sports equipment should be more conscious and attentive so as to avoid mistakes and misunderstandings. Average consumers should be more protected among others by trademark law. Above- mentioned considerations are related to the fact that sport is getting more and more professional on the one hand and amateurs buy quite professional equipment on the other. It is necessary to highlight that there are differences between equipment used especially by professionals and goods, which are indicated both for professionals and amateurs. In order to draw the boundaries between these two groups of products, it is necessary to consider that clothes, shoes and equipment direct connected with sport (for example balls) are protected in the same way as normal products. Only professional training equipment, which is used almost only in sports clubs, can belong to groups of sports products, which are designed especially for professionals, who are not only athletes and players, but also trainers, referees, umpires etc. It is important to highlight that all products for professionals are not protected as much as items for average consumers. Therefore, it is important to find out that sports products are under the same protection like other products.

6. The case T- 615/14: Fútbol Club Barcelona versus Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)

Second of last European cases related to sport is case T-614/14. In this case, football club demanded protection of contour of its crest. In opinion of sports club' s lawyers, this contour can be linked not only to typical sporting activity, but also to products such as shoes or clothes.²⁵ It is quite important consideration, because of the fact that protection of above- mentioned trademarks can be related not only to sporting activity but also to producing some accessories, which can be made without any connection with sports clubs. It is necessary to consider that utilisation of sports club' s trademark is wider than in the case of sports shoes. According to OHIM' s clerks, contour of crest is not sufficient to recognize sports club, because of the lack of distinctive features.²⁶ The Court of Justice of the European Union agreed with this opinion.²⁷ It is crucial to find out that contour of the crest can be thought to be more distinctive, than parallel stripes, but parallel stripes are identifiable for purchaser of sports shoes.

7. The boundaries of the protection of trademarks

After consideration of above- mentioned cases, it is necessary to find out that it can be protected only trademarks, which are identifiable and able to misinform consumers.

²¹ Judgement of CJEU (C-396/15 p), paragraphs 5 and 6.

²² Judgement of CJEU (C-396/15 p), paragraph 79.

²³ Judgement of CJEU (C-396/15 p), paragraph 24.

²⁴ Judgement of CJEU (C-396/15 p), paragraphs 11-38.

²⁵ Judgement of the CJEU (T-615/14), paragraph 3.

²⁶ Judgement of the CJEU (T-615/14), paragraph 7.

²⁷ Judgement of the CJEU (T-615/14).

Protection of trademarks can be related even to similar trademarks, as if they can misinform average consumer. Such protection is probably unnecessary in the case of equipment produced almost only for professionals. Furthermore, protection of trademarks can be possible, if only distinction of these trademarks is able. It is also important to find out that the difference between sports trademarks and other trademark from a perspective of EU law does not exist.

8. Conclusions

It is important to highlight that there are three categories of sport trademarks. First of them can be related especially to organizations, which are linked to sport activity. Second of this categories is related to professional sport equipment. Third one is connected with products, which can be used both by professional and amateur sportsmen. The strengthened protection of last- mentioned kind of goods is obvious, because less professional buyers are more vulnerable to make a mistake. Trademarks of sports clubs should be also protected, because they are related not only to products, but also to advertising matters. Both of considered in this paper cases are linked to some marks, which are not typical trademarks, but they are only similar to protected marks. In opinion of CJEU, expressed in these cases, the most important in protection of sport trademarks is existence of distinctive features. The second reason of protection of marks, which are similar to some trademarks is ability to misinform consumers. The most important is to notice that sports trademarks are protected in the same way as other trademarks, but they play an important role in the society, because of the presence of professional and avocational sporting activity in the modern world.

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