



TRADE MARKS & DESIGNS IN SPORTS



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1. Protection of IP rights of Sporting entities

Different kinds of signs to protect:

- ***Names***: “FC Barcelona”; “Real Madrid”...

- ***Colours***:



Protection of IP rights of Sporting entities

-Shields:



-Designs:



FIFA World Cup Brazil 2014



UEFA Euro 2012



Protection of IP rights of Sporting entities

Different time spans

- ***Long term strategy***: Colours / Shield / Name
- ***Short term strategy***: Specific kit for a final or a tournament



Protection of IP rights of Sporting entities

Territorial scope

Where to protect?

- At home
- Where the team plays usually
 - Where goods are sold (merchandising)
 - “Pop-up” markets



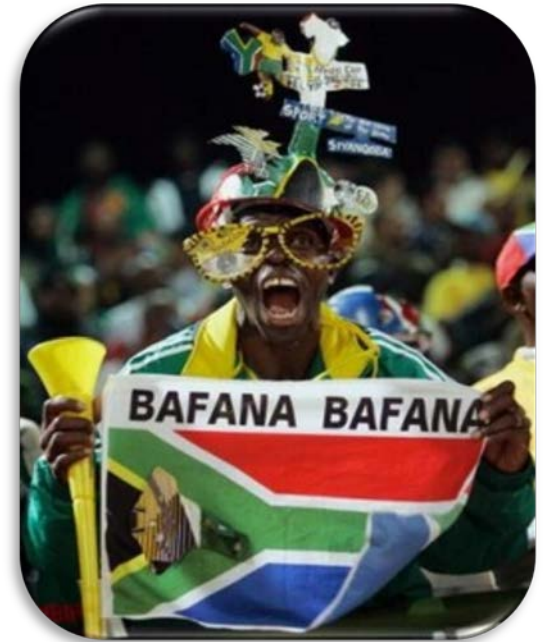
WHO OWNS BAFANA BAFANA?

1. Protection of names, logos and other signs of sporting entities, i.e. clubs etc



WHO OWNS BAFANA BAFANA?

- July 1992: Two Sowetan newspaper journalists coin the name BAFANA BAFANA for the South African national football (soccer) team
- Fans loved the name so much that SAFA eventually adopts the name over time
- SAFA believed it “owned” the name and embarked on a large licensing program





WHO OWNS BAFANA BAFANA?

- January 1993: Stanton Woodrush Pty Ltd (SW) applies to register Bafana Bafana in class 25
- September 1994: official sponsor Kappa Holdings Limited also applies to register Bafana Bafana in class 25
- July 1996: SAFA takes assignment of Kappa's applications
- SAFA takes assignment of "copyright" from journalists
- 1997: SAFA opposes SW application but case never properly adjudicated and marks proceed to registration



WHO OWNS BAFANA BAFANA?

- SCA: SW entitled to mark as it was first to file application to register mark in 1995
- SAFA's only entitlement to mark in 1993, if any, was in reference to the team, not to clothing in class 25
- Mere intention to merchandise with a name insufficient to establish right – must file application
- Making a name popular does not give a person right of property in the mark



WHO OWNS BAFANA BAFANA?

- One can benefit from a name by associating its goods or services with the name, as long as not infringing, passing off or defaming another's rights
- SAFA did not prove reputation in mark as applied to clothing – only the team itself – thus consumers would not be deceived that clothing with BAFANA BAFANA was not produced by SAFA or under its control



WHO OWNS BAFANA BAFANA?

- Consequence: SAFA could not sell BAFANA BAFANA clothing during 2010 FIFA World Cup
- SAFA contemplated changing name due to severe financial consequences
- Fans objected to any change of name
- Ultimately SAFA purchases trademarks from Stanton Woodridge for 5 million Rands



Non-Traditional Trademarks in the United States



Color Marks – Definition

- A **color** is eligible for trademark protection when it:
 - Identifies the source of a product
 - Is nonfunctional; and
 - Is distinctive (either inherently or through an acquired “secondary meaning”).



Color Marks – Functionality

- Functionality of color marks: the restriction of the use of a color may not put one party at a significant non-reputation-based disadvantage
 - Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527 (Fed. Cir. 1994).





Color Marks – N.D. Georgia

Unique Sports Products Inc. v. Ferrari Importing Co. (N.D. Georgia 2011):

- Court held the light blue color mark for tennis-racket grip tape was *non-functional* and thus protectable.





Color Marks

Board. of Supervisors for La. State Univ. v. Smack Apparel Co.
(5th Cir. 2008).



- University color schemes, combined with other identifying indicia, acquired secondary meaning.
- Thus, unauthorized use of school colors constitutes trademark infringement, even if the school is not named, or logos included.



Registered Color Marks

- U.S. Reg. No. 3,707,623 (Bosie State)
- For: “Entertainment services, namely, the presentation of intercollegiate sporting events and sports exhibitions rendered in a stadium, and through the media of radio and television broadcasts and the global communications network
- “The mark consists of the color blue used on the artificial turf in the stadium.”





(U.S. Reg. No. 3,707,623; Specimen of Use)

BOISE STATE FOOTBALL
The Official Athletics Website of Boise State University

BRONCO SHOP
YOUR PURCHASES FUND SCHOLARSHIPS!
your source for authentic bronco apparel
AUTHENTIC BRONCO APPAREL

WATCH LIVE ONLINE!
OREGON vs BOISE STATE
SAT. | SEPT. 20 | 12:30 P.M.
CLICK HERE!

BRONCO VISION

HEADLINES

- ♦ K-State RB charged with abuse of child, dismissed
- ♦ College GameDay Kick-off: Week 4 preview
- ♦ Manual: Drama sets the stage for LSU-Auburn
- ♦ Colorado's FG in OT sinks No. 21 West Virginia
- ♦ Virginia QB Latch admits to violating probation
- ♦ USC's Wright pleads not guilty to felony charge

ESPN.com | Insider

Draw on Your Memory

BRONCO STADIUM "The Blue"
Capacity: 30,000 Opened: 1970

STADIUM SEATING CHART

20th Anniversary and History of "The Blue"

THE HOME OF THE BRONCOS

Brondo Stadium is the home of Boise State University football and the Roady's Humanitarian Bowl, held each December.

TIMELINE



Registered Color Marks

- U.S. Reg. No. 3,579,003
- “The mark consists of the color yellow as applied to plastic baseball bats”
- “The color YELLOW is a registered trademark of The Wiffle Ball, Inc.”





Sound Marks

- Sound marks can be registered/protected if they “identify the services of one person and distinguish them from the services of others.”
 - Sounds that resemble “**commonplace**” sounds require proof of secondary meaning
 - “**Unique, different or distinctive**” sounds do not require proof of secondary meaning

In re General Electric (TTAB 1978)



Registered Sound Marks

- U.S. Reg. No. 1,700,895
- For: “entertainment services in the nature of basketball exhibitions.”
- “The mark consists of the melody "SWEET GEORGIA BROWN".





Registered Sound Marks

- U.S. Reg. No. 3,141,398
- For: “Entertainment services in the nature of on-going television and radio programs featuring sports.”





Registered Sound Marks

The mark is a sound mark which consists of approximately an 8 to 10 second musical phrase. The time signature of the phrase is 4/4 and the approximate tempo is 112 to 116 bpm. The first measure of the phrase starts with a forte fanfare-like 6 note brass motive consisting of the notes C3,D3,Eb3,D3,C3,G3 with a rhythm of (1/8 note rest) 16th note, 16th note, 8th note, 16th note, 16th note, half note. Then on beat 4 there is a low C minor forte sustained chordal hit played by percussion and lower brass and a "filter swept " synthesizer sound. In the second measure there is an "answering" forte fanfare-like 6 note brass motive starting on an upbeat consisting of the notes C3,D3,Eb3,D3,C3,Ab3 with a rhythm of (1/8 note rest) 16th note, 16th note, 8th note, 16th note, 16th note, half note. Then on beat 4 there is a low Ab major with a C in the bass forte sustained chordal hit played by percussion and lower brass. This is followed by a repeat of the first measures melodic content. On beat 4 of the third measure is a series of chords played by high brass (trumpets) . The sequence of chords is, starting on bar 3 beat 3 second 1/8 note, an 1/8 note C minor , then 1/ 4 notes F minor, Eb major and, in a half note rhythm, G major. The melodic content of this chord sequence is an 1/8th note F4, then in quarter notes, G4, Ab4, Bb4 and in a half note rhythm, B4. This then resolves to a chordal hit of a C minor chord with a C5 as the melody note. Last Melody note is doubled on electric lead guitar processed with a "tap delay" that regenerates to fade out".



Registered Sound Marks





Registered Scent Marks



- U.S. Registration No. 2,568,512, registered August 10, 2001 on the supplemental register for a "bubble gum scent" for lubricants and motor fuels for land vehicles.
- U.S. Registration No. 2,463,044, registered June 26, 001 on the supplemental register for a "grape scent" for synthetic lubricants for high performance racing and recreational vehicles.



Other Types of Marks



- Sport Mascots and Uniforms
- Entertainment Services in the form of coordinated choreographed dance routines performed at professional football games
 - Description of Mark: The mark consists of a cheerleader uniform comprising a blue long sleeved, cuffed and colored half blouse which is tied in front, covered by a white-half vest with fringe on the bottom and featuring blue five-point stars outlined in silver, white mini-shorts with a "v" drop front featuring blue five-point stars outlined in silver, and white western boots.



Other Types of Marks

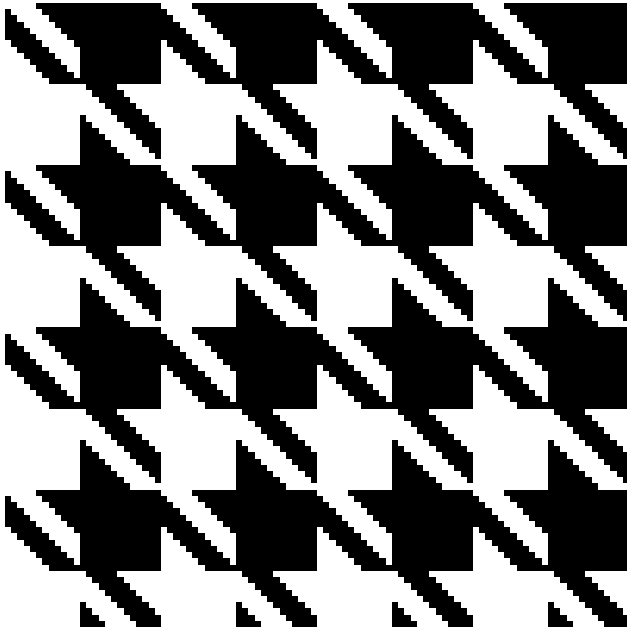
- Blue and White Pinstripe Baseball Uniform
- Entertainment services in the nature of baseball games and exhibitions
 - Description of Mark: The drawing is a two-dimensional representation of the mark, which consists of the design elements and color combinations appearing on a three-dimensional baseball uniform worn by players in applicant's games and exhibitions.





Unprotectable “Uniform”

Bd. Of Trustees of Univ. of Alabama v. Pitts,
107 U.S.P.Q.2d 2001 (TTAB July 23, 2013)





Bd. Of Trustees of Univ. of Alabama v. Pitts cont.

- **TTAB:** University could not have acquired TM rights in the pattern from Coach Bryant or his estate. Although Bryant was often spotted wearing houndstooth-pattered fedoras at football games, no evidence he used the pattern as a TM in connection with any goods or services.





Bd. Of Trustees of Univ. of Alabama v. Pitts cont.

- **Use Merely Ornamental:** pattern used as background design on the apparel that contained one or more of the University's other trademarks; this use not "unique or unusual."
- **"Unusually heavy burden"** to prove secondary meaning: found no evidence that the University ever promoted pattern separately or that the pattern created a separate commercial impression apart from the University's other marks
 - internal graphics standard manuals did not identify the houndstooth design as one of the University's marks
 - significant third-party use



Other Types of Marks

- Building, Store, Stadium, and Arena designs
 - U.S. Reg. No. 2,889,384:



“Entertainment services in the form of professional baseball games providing sports information by means of digital transmission.”

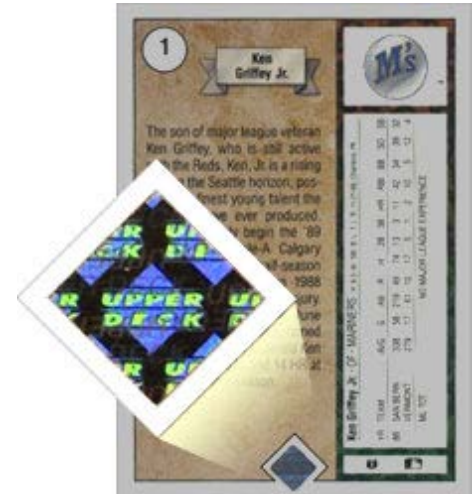






Hologram Marks

- *In re The Upper Deck Company*
 - Court held that a hologram on baseball trading cards could not be protected because it constituted more than one “device” as contemplated by Section 45 of the Trademark Act.
 - Source identification vs. anti-counterfeiting function





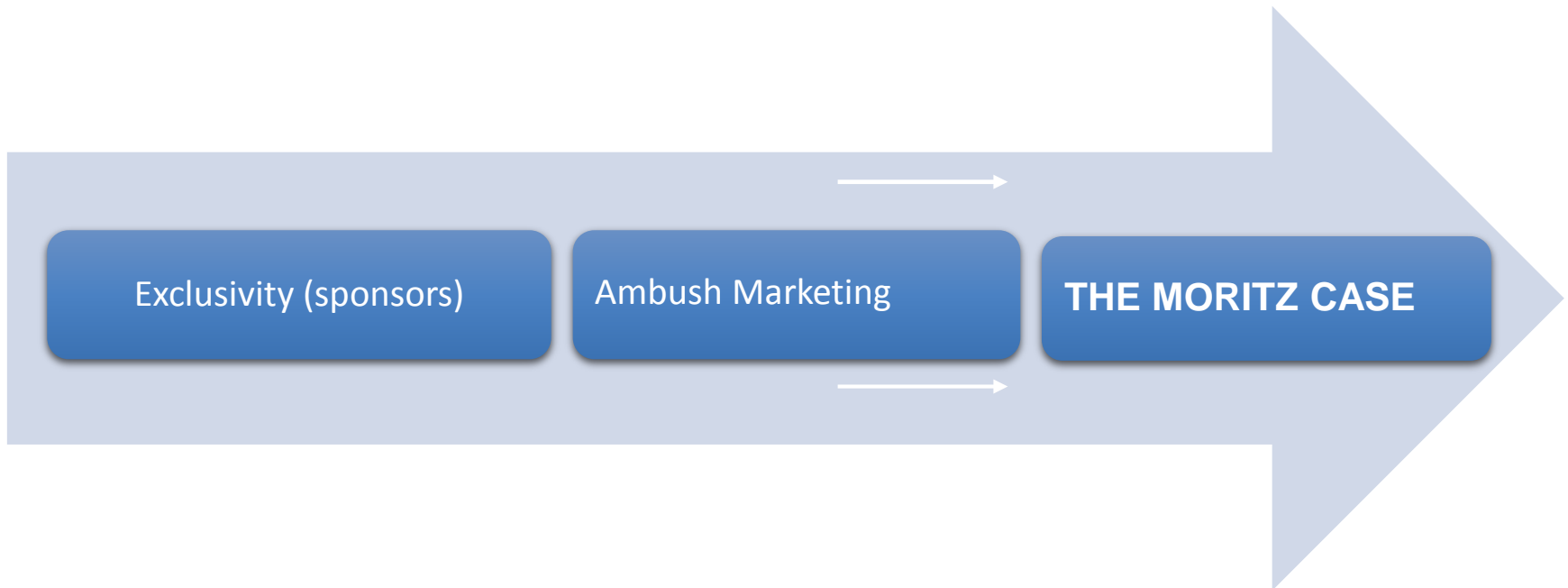
Hologram Marks

- Products made by official university licensees, sold through retail outlets, bear the “Officially Licensed Collegiate Product” (OLCP) hologram tag owned by The Collegiate Licensing Company.





2. Interaction between Sports organizations and sponsors



Interaction between Sports organizations and sponsors

Alcorcón - Real Madrid



VS



4 - 0





Interaction between Sports organizations and sponsors

Exclusivity (sponsors)

Ambush Marketing

Keylor Navas and Neymar cases





Interaction between Sports organizations and sponsors

- **Limitations of use** (*Rule 50 of the Olympic Charter of IOC*):

“1.1 The identification of the manufacturer shall not appear more than once per item of clothing and equipment.(...)”

1.4 Clothing (e.g. hats, sunglasses, goggles) and gloves: any manufacturer’s identification which is greater than 20 cm² shall be deemed to be marked conspicuously.”

Interaction between Sports organizations and sponsors

***ADIDAS** had to restrict the use of the brand's distinctive three-stripe design on apparel because it is greater than 20 cm²:*





RED VS GREEN

2. Interaction between sport organizations and sponsors.



RED VS GREEN

- Sports organizations and sponsors have a symbiotic relationship
- To be successful, sports organizations require financial backing
- To maintain sponsorship, a sponsor wants a good return on investment
- Who should control the teams' brand or image, the sponsor or the team?



RED VS GREEN

- In South Africa – rugby very popular sport – team colour is green.
- ABSA, a bank, is major sponsor and ABSA's corporate colour is red.





RED VS GREEN



Media Release



31 March 2014

Embargo: 12:00 am, 1 April 2014

Absa, SARU announce radical change to Springbok kit





RED VS GREEN



Wilhelm A Markwat

@a_markwat

+ Follow

@OFM9497 don't like the "New" Red and gold, the Green and Gold used to be SA rugby's trademark and is still good for years to come !!

↩ Reply ↻ Retweet ★ Favorite ... More

3:34 PM - 31 Mar 2014

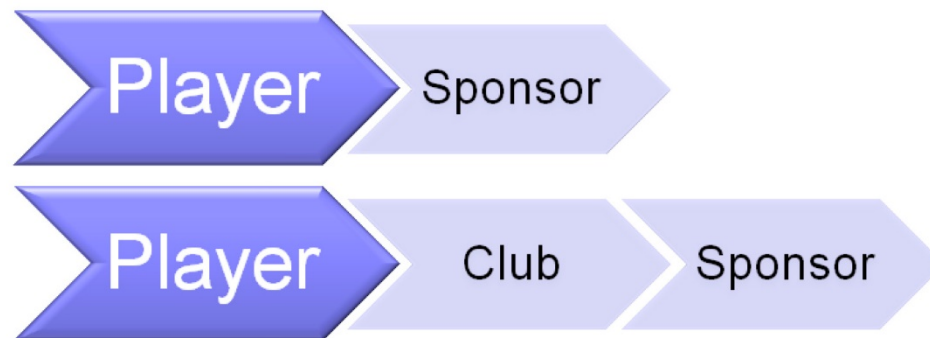
Conclusion: Sponsors and teams working together can get great marketing value for both brands



3. Protection of image of sports players

-**Image** as such and **Name** as a trademark

-**Image rights:**



Protection of image of sports players

-Some conflicts:



Xavi Hernández case:
registration of the
domain name
“xavihernandez.com”

Protection of image of sports players

Iker Casillas case:
“IKER CASILLAS”
CTM Application





HOW MUCH IS AN IMAGE WORTH?

3. Protection of the image of sport players, and licensing of them to sport organizations and sponsors



HOW MUCH IS AN IMAGE WORTH?

- Sponsors choose who they back based largely on image.
- If that image changes negatively, it could be very detrimental to their brand.
- Sponsorship contracts usually have an escape clause to be able to cancel the sponsorship due to certain changes in image.



HOW MUCH IS AN IMAGE WORTH?

- Oscar Pistorius “the blade runner” was the first disabled athlete to win a medal at the regular Olympics
- Oscar had many lucrative sponsors based on his image of overcoming adversity and succeeding and being a “winner”





HOW MUCH IS AN IMAGE WORTH?





HOW MUCH IS AN IMAGE WORTH?

Sponsors themselves
must be careful how
they portray an athlete.

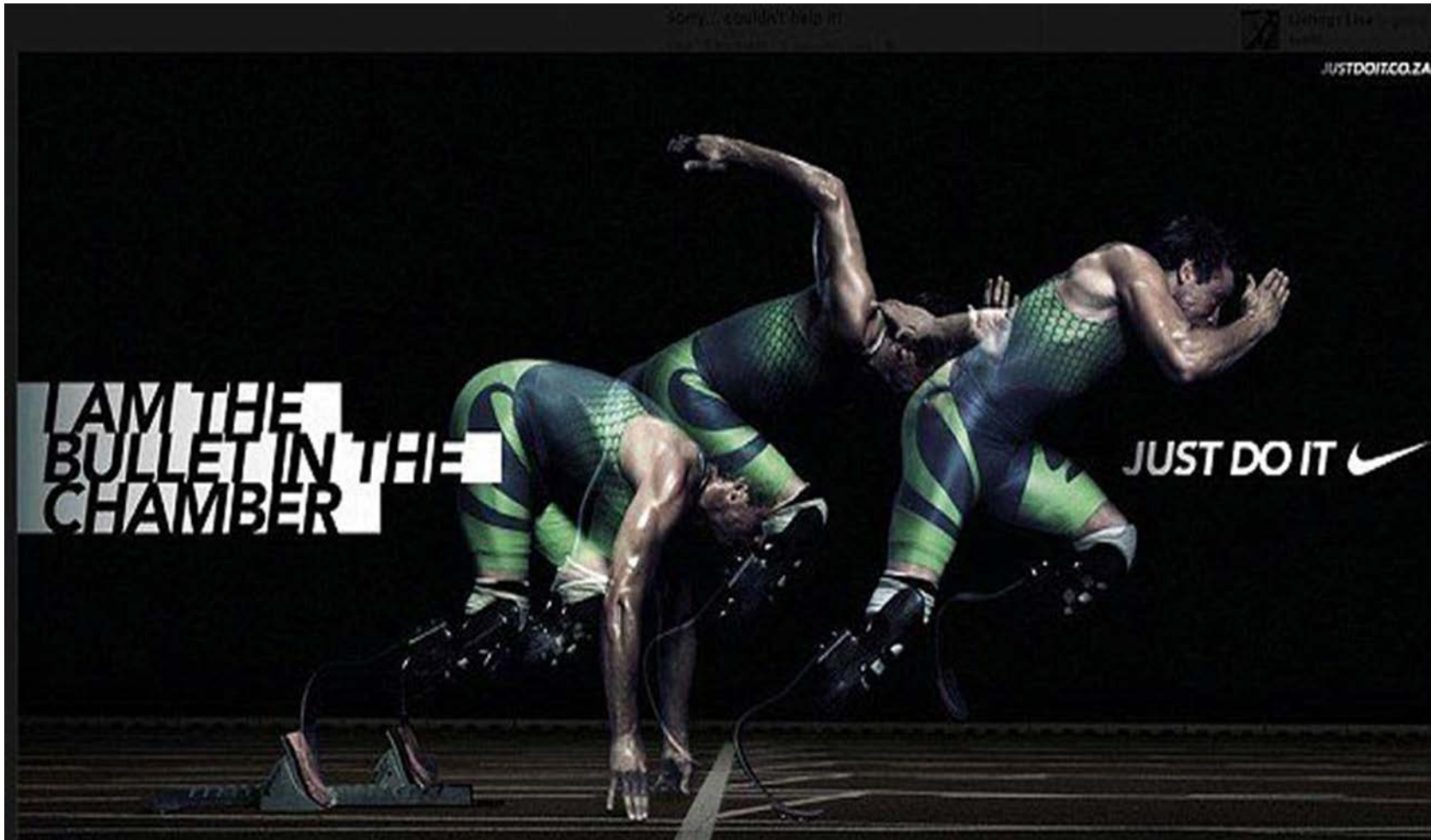


HOW MUCH IS AN IMAGE WORTH?





HOW MUCH IS AN IMAGE WORTH?





HOW MUCH IS AN IMAGE WORTH?





HOW MUCH IS AN IMAGE WORTH?



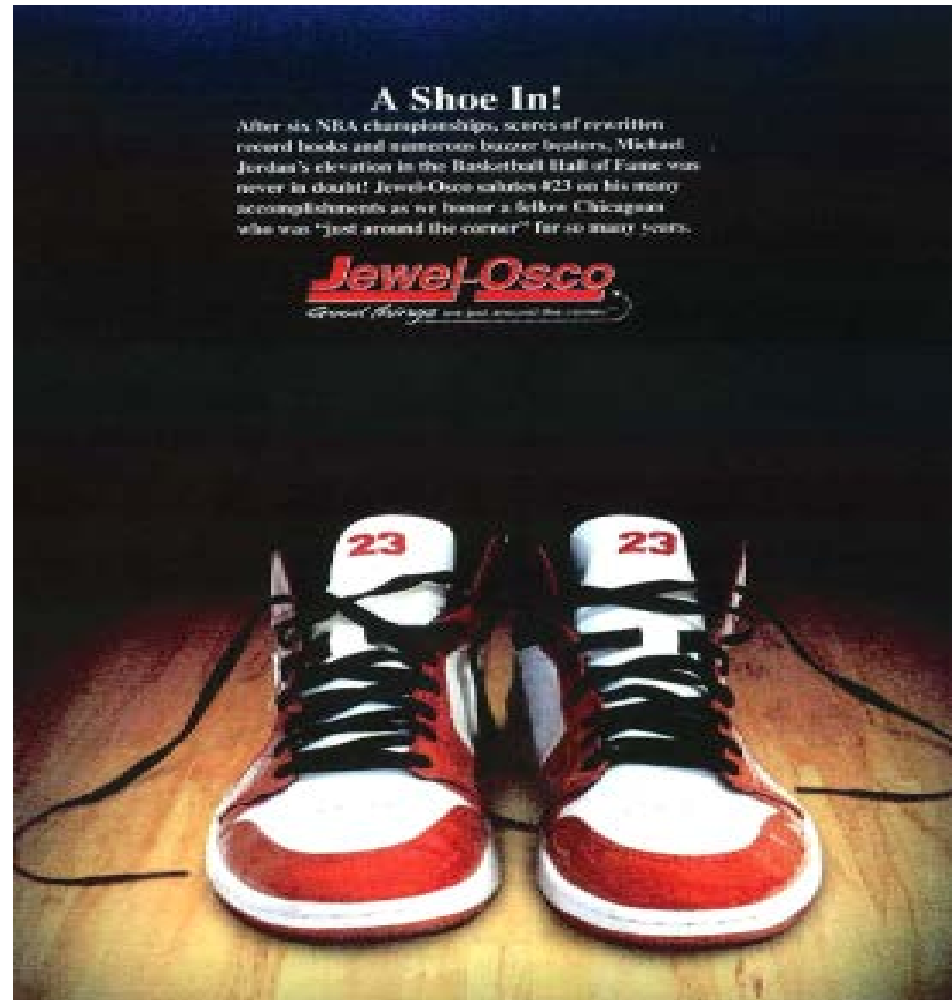


HOW MUCH IS AN IMAGE WORTH?

Can unauthorized “sponsors” use the image of a famous athlete without the athlete’s permission in the form of a “Tribute” ad?



HOW MUCH IS AN IMAGE WORTH?





HOW MUCH IS AN IMAGE WORTH?

- The US Federal District Court held that honouring Jordan's image and legacy was a tribute and constituted free speech which was protected by the First Amendment.
- The US 7th Circuit Court of Appeal held that honouring Jordan's image and legacy as a part of history was clearly for commercial purposes and he must be compensated for the use of image.



Right of Publicity



Right of Publicity – Defined

The right to control the commercial use of one's identity (name, image, likeness, etc.) and prevent others from impermissibly exploiting it.





Trademark Rights v. Right-of-Publicity Rights

	Trademarks	Right of Publicity
What is identified?	“Goodwill” of Seller	“Persona” of human being
Prior exploitation needed?	Yes—used to identify and distinguish goods/services	No—Prior exploitation not required
Test of infringement	Likelihood of confusion, mistake or deception	Identifies the “persona” of plaintiff



Right of Publicity – Scope

- What types of uses are permissible / impermissible
 - “Related Use” Test
 - “Transformative Use” Test
- Both tests balance the right of publicity against free speech considerations



Related Use Test - Rogers v. Grimaldi (2d Cir. 1989)

Is use of the celebrity's identity sufficiently relevant to the underlying work, or is the celebrity identity being used solely to attract attention to the work?



Because film was “clearly related to the content of the movie and [was] not a disguised advertisement for the sale of goods or services or a collateral commercial product,” court found no right-of-publicity violation.



Transformative Use Test – Comedy III Productions v. Saderup (Cal. 2001)



The central purpose of this inquiry is to see “whether the new work merely 'supersede[s] the objects' of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is transformative.”



Keller v. Elec. Arts Inc., 724 F.3d 1268 (9th Cir. 2013)



- Former college football player Samuel Keller brought suit against Electronic Arts, claiming the company used his likeness as a part of an NCAA Football video-game series.
- In general, video games are entitled to the full protections of the First Amendment because, like books and movies, they communicate ideas and social messages with their characters and plot lines (*See Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733, 180 L. Ed. 2d 708 (2011)).





Transformative Use Test – *Keller v. Elec. Arts Inc.*

- 9th Circuit adopted factors from *Comedy III*, considering a work sufficiently transformative and likely to receive First Amendment protection if:
 - The celebrity likeness is one of the “raw materials” from which an original work is synthesized
 - The work is primarily the defendant's own expression, as long as that expression is “something other than the likeness of the celebrity”
 - Creative elements, versus literal and imitative elements, predominate the work
 - If the marketability of the work does not derive from the celebrity’s fame
 - If the artist’s/user’s skill is not subordinated to create a conventional portrait of a celebrity to exploit his or her fame



Keller v. Elec. Arts Inc. – Outcome

- Court held that EA's use of Keller's likeness did not contain sufficient transformative elements such that EA would be entitled to protection of the First Amendment.
- “The right of publicity protects the *celebrity*, not the *consumer*.”





Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757 (D.N.J. 2011)

- Ryan Hart, a former quarterback with Rutgers University's football team sued Electronic Arts for violating his right of publicity in its NCAA Football video-game series.
- NCAA Division Manual Provides:
 - Players are restricted from using their skill to receive pay in any form
 - Athlete permits use of his or her name “to advertise, recommend, or promote... a commercial product or service”
 - Hart adhered to rules





Hart v. Elec. Arts, Inc.

- District Court concluded EA was entitled to First Amendment protection under either the transformative test or either the Rogers's test, and thus was entitled to assert the First Amendment as a defense
- U.S. Court of Appeals for the Third Circuit reversed in *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013)
 - First Amendment protection is afforded to commercial speech; NCAA football is not commercial speech



Hart v. Elec. Arts, Inc., 717 F.3d 141 (3d Cir. 2013)



- Court of Appeals held the NCAA video games did not transform Hart's identity to escape right of publicity laws.
 - “Digital Ryan” plays college football like actual Ryan. A digital re-creation *is not* a transformative use.
- The goal of right of publicity laws is to protect property interest that an individual gains and enjoys in his identity through his labor and effort.



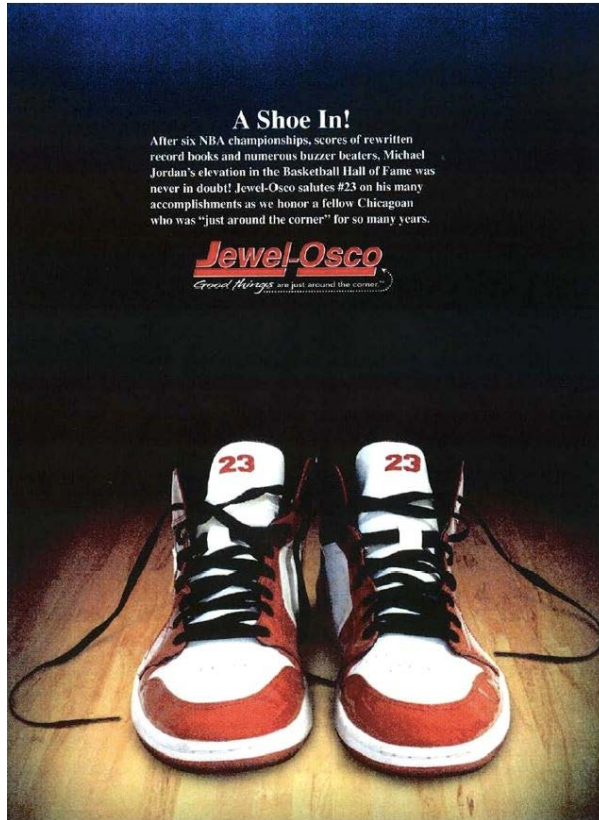
O'Bannon v. NCAA, 2014 U.S. Dist. LEXIS (N.D. Cal. Aug. 8, 2014)

- Injunction entered against NCAA rules that restrict student-athletes from receiving compensation for their names, images and likeness
 - » Rules held to violate Section 1 of the Sherman Act, which makes it illegal to form a contract or conspire to restrain trade or commerce statewide
 - » Starting in 2016:
 - » Athletes may earn money from the use of their names and images in television broadcasts and video games
 - » Universities can establish trust funds to help basketball and football players gain money for television revenue they help create





Advertising and Right of Publicity



Jordan v. Jewel Food Stores, Inc., 743 F.3d 509 (7th Cir. 2014)

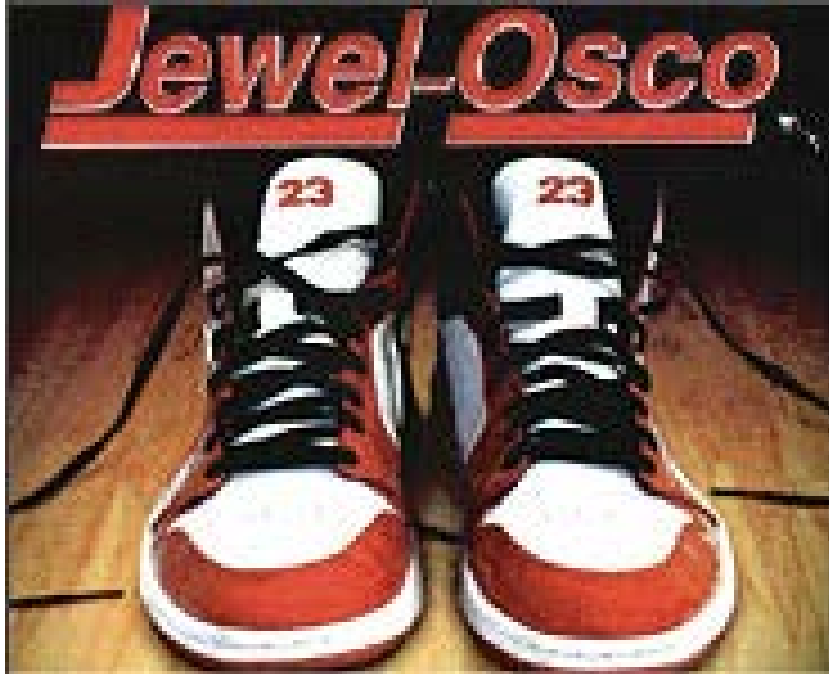
- Time, Inc. produced a commemorative issue of *Sports Illustrated* magazine featuring Michael Jordan's basketball accomplishments.
- In exchange for agreeing to stock the magazine, Jewel Food Stores, Inc. submitted a free, full-page ad congratulating Jordan.
- Jordan claimed the ad misappropriated his identity for the supermarket's commercial benefit



Jordan v. Jewel Food Stores, Inc.

7th Circuit:

- Reversed lower court's decision that the ad was fully protected non-commercial speech
- Ad prominently features the store's logo and creatively links its brand to Jordan
- Ad is commercial speech, thus making it subject to the Illinois right-of-publicity laws and defeating the store's First-Amendment defense



4. Protection of names and logos of special sports events

-Weak elements: South Africa 2010;
World Cup 2010 ...

-Olympic Signs: The “Antic Olimpic”
Case, STS 24.02.09





SAME EVENT, DIFFERENT CITY, DIFFERENT YEAR

4. Protection of names and logos of special sport events like Olympiads, Sport competitions, i.e. NBA, European Champions League, World Champions, etc. Licensing and merchandising of these rights including particular weak elements like city names, years, etc.



SAME EVENT, DIFFERENT CITY, DIFFERENT YEAR

- Success in registering a weak sporting event name depends on the jurisdiction
- Weak marks successfully registered in South Africa for the FIFA World Cup in 2010:
 - South Africa 2010
 - World Cup 2010



**SOUTH
AFRICA
2010**



SAME EVENT, DIFFERENT CITY, DIFFERENT YEAR

- Weak marks registered in Germany for FIFA World Cup in 2006:
 - Fussball WM 2006
 - WM 2006
- But these marks cancelled by Ferrero oHG mbH in response to FIFA's threatened infringement action.





SAME EVENT, DIFFERENT CITY, DIFFERENT YEAR

- Ferrero also successfully opposed following marks before OHIM in most relevant classes:
 - World Cup 2006
 - Germany 2006
 - WM 2006
 - World Cup Germany
 - World Cup 2000 Germany





Trademark – Disparagement

Section 2(a) of the Trademark Act: a registration can be barred or canceled, if it consists of matter which, with regard to persons, institutions, beliefs, or national symbols either:



Trademark – Disparagement

1. disparages (or belittles) them,
2. falsely suggests a connection with them
3. brings them into contempt, or
4. brings them into disrepute (shame or dishonor by the public)



Recent Disparagement Case

Blackhorse v. Pro Football, Inc., 2014 TTAB LEXIS 231 (TTAB June 18, 2014)



- Five Native Americans brought suit against The Washington Redskins football team
- Sought to cancel registrations issued between 1967 and 1990 for trademarks consisting in whole or in part of the term REDSKINS for professional football-related services
- Claimed the marks violate Section 2(a) as disparaging





Blackhorse v. Pro Football, Inc. – Background



- Second-time Board has faced petition to cancel REDSKINS-related marks
- On September 10, 1992, Suzan Harjo and six other Native Americans petitioned to cancel the marks on disparagement grounds
- (*See Harjo v. Pro Football, Inc.*, 30 USPQ2d 1828 (TTAB 1994))
 - Case lasted seven years



Harjo v. Pro Football, Inc., 30 USPQ2d 1828 (TTAB 1994)

- Trademark Trial and Appeal Board held the marks were disparaging and ordered them canceled
- In 2003, U.S. District Court for the District of Columbia reversed, holding that:
 - The finding of disparagement was not supported by substantial evidence
 - Doctrine of laches precludes consideration of the case
- In 2005, the Court of Appeals for the District of Columbia held the District Court used the wrong standard for laches; on remand, the District Court applied new standard, found laches barred the claim
- In 2009, the Court of Appeals affirmed, thus resolving the laches issue, but never addressing disparagement



Blackhorse v. Pro Football, Inc.

– Disparagement Test

Test for disparagement comprises a two-step inquiry:

The Redskins



- *What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations?*
- *Is the meaning of the marks one that may disparage the group at hand?*

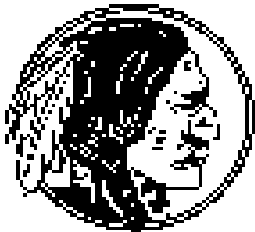


Blackhorse v. Pro Football, Inc. – Part I: Meaning of the Mark

- In this case:
 - Disparagement claim only pertained to the term REDSKINS
 - REDSKINS clearly refers to the football team and carries the allusion of Native Americans
 - Part I of test thus established



WASHINGTON



REDSKINS



Blackhorse v. Pro Football, Inc. – Part I: Evidence



Washington Redskins marching band wore Native American headdresses as part of its uniforms between the 1960s and the 1990s



Redskinettes appeared wearing costumes suggestive of Native Americans, as shown in this 1962 photograph titled “Dancing Indians,” and captioned: “Here are the Redskinettes all decked out in their Indian garb and carrying Burgundy and Gold pom-poms.”



Blackhorse v. Pro Football, Inc. – Part II: Disparagement

- To decide whether REDSKINS may disparage Native Americans, the TTAB looks to the views of Native Americans, **not** to the views of the American public as a whole
 - “[R]easonably determined by the views of a substantial composite” of the group
 - All five petitioners held membership in a Native American tribe and found the term REDSKIN disparaging in any context including for an "NFL team"
 - All have “a legitimate personal interest in the opposition or cancellation”
 - Standing established, but what about part II of test? Disparagement?



Blackhorse v. Pro Football, Inc. – Part II: Evidence

- Evidence to prove disparagement included:
 - testimony and reports provided by the parties' respective experts
 - dictionary definitions and reference books
 - the National Congress of American Indians' ("NCAI") 1993 Resolution 93-11 (for the specific views of Native Americans)
 - the deposition of NCAI Executive Director, Ms. JoAnn Chase
 - various newspaper articles, reports, and official records
 - 19 letters from individuals identifying themselves or family members as Native Americans



Blackhorse v. Pro Football, Inc. – Part II: Evidence Examples



*“Nearly half of all interracial slurs ...refer to real or imagined physical differences. ... Most references to physical differences are to skin color, which affirms what we have always known about the significance of color in human relations. Asian groups were called yellow this and that and **Native Americans were called redskins, red men, and red devils.**”*

- Excerpt noted by TTAB from Sociologist Irving Lewis Allen’s, *Unkind Words: Ethnic Labeling from Redskin to WASP* (Bergin & Garvey 1990) p. 18.



Blackhorse v. Pro Football, Inc. – Part II: Evidence Examples

- Wide, general usage of REDSKINS in the late sixties became very sporadic thereafter, illustrating a drop-off of usage to describe Native Americans
 - "Fort Wicked" Too Tough for Redskins . . ." Headline from *Rocky Mountain News* (October 21, 1931)
 - "Good luck, get a redskin for me." Excerpt from the 1940 movie *Northwest Passage*





Blackhorse v. Pro Football, Inc. – Outcome

TTAB held:



- Petitioners showed, by a preponderance of the evidence that a substantial composite of Native Americans found the term REDSKINS to be disparaging in connection with respondent's services during the relevant time frame of 1967-1990
- The defense of laches does not apply in a disparagement claim where the disparagement pertains to a group in which the plaintiff is a member, or when a broad public policy concern is at issue
- The six registrations at issue must be cancelled as required under Sections 2(a) and 14(3) of the Trademark Act**



Blackhorse v. Pro Football, Inc. – Options for Appealing

- Appeal to the U.S. Court of Appeals for the Federal Circuit in Washington, D.C.
- File a civil action in district court:
 - The U.S. District Court for the Eastern District of Virginia has jurisdiction over civil actions seeking review of TTAB cancellation proceedings
 - Additional evidence implications



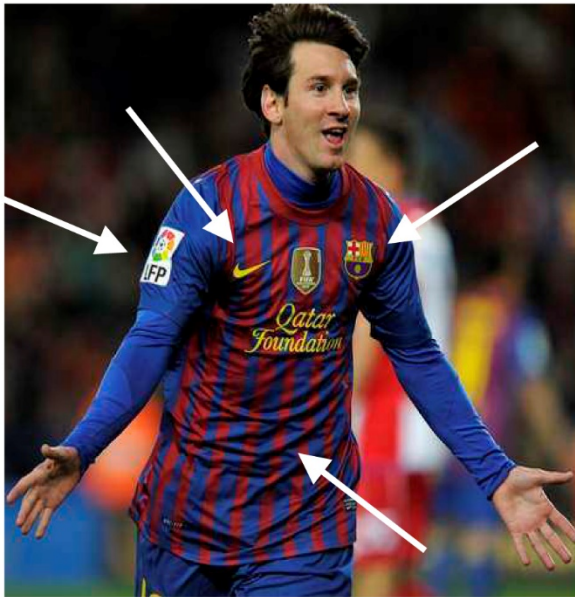
Update: Washington Redskins Appeal



- Complaint filed in the U.S. District Court for the Eastern District of Virginia
- Claims Native Americans did not find the team name disparaging during the relevant time frame between 1967-1990
- Claims the Board violated the team's speech in violation of the First Amendment
- Federal judge entitled to disregard Board's opinion and conduct an independent investigation of the evidence
- While the case is in federal court, marks continue to receive full protection

5. Enforcement of Club's IP rights

- One product, many trademarks of many owners:





Enforcement of Club's IP rights

- Different owners / different strategies / different IP cultures
- Too many “victims” of one illicit act?
 - Standing to sue
 - Right to compensation (damages)



Enforcement of Club's IP rights

Who is the infringer?

- Counterfeiter (*action!*)
- Licensee or former licensee
(*more information*)
- Supporters (*problem!*)



Enforcement of Club's IP rights

Where to enforce?

Permanent strategy

- National market
- "Presence" markets
(where the team plays)
- Relevant markets
(regardless of actual
regular presence)

On the spot strategy

- Occasional presence
- Player's country of
origin

Enforcement of Club's IP rights

Example of urgent enforcement

- Spanish World Cup Equipment 2014
 - Notitia Criminis
 - Court claim
 - Ex parte PI decision





THE SPRINGBOK – NEGATIVE CULTURAL IMAGE?

5. Specificities of the enforcement of the clubs' IP rights: Necessary coordination with other IP owners and potential conflict of interest; enforcement against misuse by supporters; dynamic licensing projects and overruns; the fast changing territorial element



THE SPRINGBOK – NEGATIVE CULTURAL IMAGE?

- South Africa's national rugby team's name is The Springboks, and the logo is a leaping Springbok device
- Springbok symbol originally created in 1906 in relation to rugby but then used in relation to other national teams, but only after first obtaining permission from the South African Rugby Board





THE SPRINGBOK – NEGATIVE CULTURAL IMAGE?

- Springbok emblem protected as follows:
 - Badge under the Heraldry Act in the 1960's
 - 1977: word SPRINGBOK and the LEAPING SPRINGBOK device registered as trademark in class 41 by SA Rugby Board, (an entity related to SA Rugby Football Union –SARFU)
 - Variations of the symbol were subsequently registered in later years in additional classes





THE SPRINGBOK – NEGATIVE CULTURAL IMAGE?

- Springbok was seen to be a symbol of the old Apartheid Regime in SA
- Push to change the symbol by some in government
- Initially the Springbok was saved by Nelson Mandela





THE SPRINGBOK – NEGATIVE CULTURAL IMAGE?

- In later years another push to change symbol (other sports already changed to Protea)
- IP constitutes property and is protected by SA Constitution in terms of Bill of Rights
- SARFU could not be deprived of property without just compensation
- Matter settled with SARFU retaining Springbok but adding the Protea to the logo

