

Sports stars and the use of trade marks for merchandise and branding

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IP & IT analysis: What should sports stars bear in mind when registering their nicknames as trade marks for merchandising and branding purposes? Jonty Warner, associate at Mishcon de Reya, examines the use of trade marks in sport and offers guidance on minimising risks in this area.

What are the risks for sports stars and other celebrities of using their nicknames on merchandise and in branding campaigns?

The risks are exemplified by recent reports that Kellogg's are taking infringement action before the Australian courts against tennis player Thanasi Kokkinakis over his use of the nickname 'Special K'. Kellogg's are seeking to prevent Kokkinakis from using the name as part of a branding campaign focusing on clothing and tennis wear.

This highlights the importance of sports stars and other celebrities taking legal advice before using such nicknames commercially. A failure to do so can result in claims for trade mark infringement and/or passing off in the UK. If such claims are successful the defendant can be forced to stop using the relevant trade mark and may also be liable to pay the claimant damages or an account of its profits, as well as legal costs. Conducting relatively inexpensive clearance searches can help to mitigate against these risks.

What steps can they take in order to protect their nicknames and ensure that they are free to use them?

Trade mark clearance searches are key. Individuals can sometimes be averse to incurring the costs of these at an early stage, but spending a relatively modest amount early on can prevent costly and time-consuming disputes further down the line.

We also recommend obtaining registered trade mark protection where nicknames are being used in the course of trade. While celebrities could seek to rely on unregistered rights (ie claims for passing off relying on 'false endorsement' arguments) to prevent third parties from using identical or similar names, such claims can be challenging and are generally highly fact-dependent.

A good example of a celebrity who has taken the recommended steps is David Beckham, who is generally a prolific trade mark filer and has obtained registrations for various nicknames/brands including 'DB07'.

What are the key points to consider when filing a trade mark application for a mark to be used on merchandise?

Applicants should consider whether they wish to file a word mark, logo or both. They should then think about which classes of goods they wish to cover. Key classes include class 9 (apps, video and computer games, software, downloadable publications), class 16 (posters, books, magazines), class 25 (clothing, footwear, headgear) and class 28 (toys, games, sporting goods).

It is also important to consider carefully which territories to file in, taking into account both where the merchandise is going to be sold, and where it is going to be produced (by way of example, goods made in China can be blocked on exit by customs if a third party has a relevant registered trade mark). A European Union Trade Mark (EUTM) application represents a cost-effective way of obtaining protection across the 28 EU Member States, though it is currently unclear how the process of converting EUTMs to UK marks is going to function (and therefore some applicants are choosing to err on the side of caution and file a separate UK application—this can also help minimise non-use issues after five years of registration).

Applicants should also bear in mind that, somewhat perversely, fame can actually hinder a sportsperson/celebrity from being able to register their name or nickname as a trade mark. Following a UK Intellectual Property Office (UKIPO) [decision in 2005 involving the band 'Linkin Park'](#), it is relatively common for UKIPO to reject applications in these

circumstances on the basis that the mark serves solely to designate the subject matter of the relevant merchandise as opposed to its commercial origin. Taking the relevant steps at a relatively early stage in the applicant's career can therefore work in their favour.

Finally, any applications should be filed in the sports star's own name (or in that of their image rights vehicle). As has been reported in the intellectual property press, trade mark registrations for 'JOSE MOURINHO' and 'FERNANDO TORRES' are still held in the name of Chelsea FC—this presents issues, particularly given that Mourinho and Torres left the club in 2015.

What steps can be taken to minimise the risk of disputes with other brand owners?

As discussed above, clearance searches are key. It may be possible to overcome certain non-critical risks by amending the proposed mark slightly (though this may not be feasible if the mark in question is a well-known nickname). If the searches identify any risks which do not have direct commercial overlap with the proposed use of the mark, sports stars/celebrities may wish to consider filing for a relatively narrow specification of goods/services to avoid potential oppositions before the relevant registry.

Interviewed by Sean Delaney.

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