

Protection, Commercialisation and Enforcement of Intellectual Property Rights in Professional Tennis

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1 Introduction

Intellectual property (IP) rights have always played an important role in the development of sports generally, as well as tennis specifically, and have assisted in developing the global sports industry into the US\$350 billion business that we know today.¹ As the fourth most popular sport in the world, the value of the global tennis market achieved US\$914.53 million in 2021 and is anticipated to grow by 3.01 per cent year upon year, reaching a projected value of US\$1,092.47 million in 2028.²

One of the reasons why IP rights play such an important role in the development of sports is because it is highly innovative and constantly evolving, for example, with the rise of eSports, which now reaches a global audience of 500 million.³ Particular examples of where IP rights play a role in tennis can be seen with inventions such as Hawk-Eye Live, which will imminently completely replace (human) lines-people. Tennis apps are hugely popular among tennis players and fans alike and perform a variety of functions, from monitoring live scores and finding tennis partners to tracking and improving performance and finding sponsorship opportunities. Virtual reality trainers are also revolutionising the

¹ Business Research Company, 'Sports Global Market Report 2022: By Type, Revenue Source, Ownership' (February 2022), cited in Jacques de Werra, 'Reference Guide to Sustaining Sport and Its Development through Intellectual Property Rights', 4, available at: www.wipo.int/documents/d/sports/guide-sustaining-sport-ipr-2022.

² 'Global Tennis Industry Research Report 2023, Competitive Landscape, Market Size, Regional Status and Prospect' (18 January 2023), available at: www.researchreports.world.com/enquiry/request-sample/22376172?trk=article-ssr-frontend-pulse_little-text-block.

³ De Werra, 'Reference Guide', 4.

tennis world. Many tennis players now complement their on-court training with technology such as virtual reality trainers which scan and process a player's biomechanical data and calculate the optimal pattern of movements.

In June 2022, the Association of Tennis Professionals (ATP) Tour released its 'One Vision' plan, a long-term transformational strategic plan designed to take tennis to new heights from 2023. The plan recognises that nowadays tennis is much more than a sport – it is an entertainment business and 'superstar players' are one of the factors setting up the sport for success in the digital age.⁴ The plan acknowledges that times have moved on, and live tennis matches are not enough; they cannot be the only product that the industry offers. A fan experience must be heightened because tennis is competing with other entertainment platforms such as Netflix, social media platforms and music streams, as well as other sports. And tennis players can no longer be seen as just playing the sport, they must also be building rapport with and entertain a global audience. Building this rapport can be achieved by tennis players significantly investing in their personal branding strategies and by recognising that their audience is not merely interested in live coverage from the tennis court, but the real-life dramas of the individual sports stars, their background stories and sneak peaks into their private lives. This is why documentaries such as Netflix's *Break Point* (which has been showing the behind-the-scenes moments of numerous successful tennis players both on and off the court) are becoming increasingly popular.

Given the ever-growing attention around the private lives of tennis stars, brands will inevitably want to increase their investment into them through sponsorship deals and this is where IP comes in – it is increasingly more important for tennis stars to have a strong brand protection strategy (trademark applications for their names or nicknames is a good starting point) so that they have more control over how their names/brand is being used and how stars can leverage income from that personal brand. The efficient protection and enforcement of IP rights is of significance for the commercial success of the tennis industry and allows all participants therein to prosper: individual players, tennis clubs, tournament organisers and sponsors. This chapter explores the importance of protection, commercialisation and IP rights in the context of professional tennis. While the chapter provides a brief overview of relevant IP rights, the particular emphasis is on trademarks and brand

⁴ Available at: <https://onevision.atptour.com/onevision/>.

protection, given that brands are at the heart of commercialisation. The chapter will then highlight legal and contractual issues pertaining to commercialisation, as well as other matters pertinent in the context of enforcement. The reader is advised that the chapter is aimed at providing a basic introduction to this highly complex area. It is therefore highly advisable to seek specialist advice when considering IP protection and strategy.

2 Overview of IP Rights

The following sub-section will explore in brief the different IP rights relevant to the tennis industry. While trademarks and copyright are traditionally considered the most important categories of IP rights for the tennis industry, there are a broad range of other relevant intangible rights.

2.1 *Territoriality of IP Rights*

As a preliminary matter, it should be noted that all IP rights are territorial in nature. As far as registered trademark rights are concerned, it is therefore necessary to obtain protection in all countries in which the rights are commercialised or intended to be commercialised in the future. While the basic concept of IP rights is similar worldwide, there are significant differences between the various legal systems. The registration and protection of IP rights are governed by local law in each country. Unless otherwise indicated, the following sections will refer to the position under EU and/or UK IP law.

2.1.1 Ownership of IP Rights

Ownership of IP rights in the tennis industry, as in other sports industries, is complex due to the many stakeholders involved and the variety of contexts in which IP rights can be monetised. Individual tennis players are arguably the most important category of stakeholder in the tennis industry as they constitute the backbone of the industry. Individual tennis players are increasingly aware of the importance of building a personal brand, own registered or unregistered IP rights, and can often be involved in IP issues.

National, regional and international tennis federations as well as other sports governance bodies may also own and control certain IP rights, in particular relating to events, and play a huge role in promoting and

implementing sport development activities. Furthermore, a broad range of players in the private sector may own IP rights due to the activities they are involved in and the goods and services they provide. Such activities include the organisation of tennis tournaments, the broadcasting of tennis events, the management of rights related to individual tennis players and sports events, the manufacture and commercialisation of sporting goods, the operation of tennis clubs and other tennis venues, and the sponsoring of individual tennis players, tennis organisations, tennis tournaments and venues.

When considering an IP protection strategy, it is important to carefully consider who should own the relevant IP rights and, where multiple stakeholders are involved, to ensure that relevant agreements are put in place to govern the relationship between the parties. By way of example, many tennis players, either alone or through their sponsors or management companies, have registered trademarks for their names, nicknames, initials, portraits, signatures or other distinctive features. It is crucial to consider in advance what will happen to any trademarks in the event that a relationship, such as a sponsorship agreement, is terminated. One of the most famous cases in tennis related to the famous RF logo, which was undoubtedly always associated with Roger Federer. The rights in the logo initially belonged to Federer's long-term former sponsor, Nike. When the relationship terminated in 2018, Federer was unable to commercialise the logo for two years even though these were his own initials. It was only in or around February 2020 that Federer managed to acquire those rights. His initials are found on many clothing items and have a high brand value.⁵

3 Trademarks

Trademark protection is crucial for all stakeholders in the tennis industry, including athletes, national and international tennis federations and, in particular, sporting goods manufacturers.⁶

⁵ See e.g. Dan Parkes, 'Important Lessons for Athletes from the Nike/Federer "RF" Logo Dispute', *Law in Sport* (8 August 2018), available at: www.lawinsport.com/topics/item/important-lessons-for-athletes-from-the-nike-federer-rf-logo-dispute; LGV Avvocati, 'Roger Federer Takes "His" RF Logo Back', *Lexology* (17 March 2020), available at: www.lexology.com/library/detail.aspx?g=e472a59f-bee0-4eda-b071-a5a4d1b30eea.

⁶ Désirée Fields, 'Protecting Tennis and Sports Brands Holistically, beyond Words and Logos', *Pinsent Masons* (25 August 2022), available at: www.pinsentmasons.com/out-law/analysis/protecting-tennis-sports-brands; Désirée Fields, 'Maximising Your Brand

3.1 *What Is a Trademark?*

A trademark is any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings.⁷ As such, the primary purpose of a trademark is to indicate the origin of the good and services concerned. The registration of a trademark conveys exclusive rights on the trademark owner to use and enforce the trademark. There are certain signs that cannot be registered as trademarks, as defined under national legislation or case law. If a sign applied for which an application is made falls within one of those defined categories, it is likely to be refused by the relevant trademark office. Most commonly, trademark applications will be refused if their subject matter cannot be clearly identified, or they lack distinctive character, are descriptive of the goods and services applied for, or have become customary in trade.⁸ Particular challenges can arise in the context of event-related trademarks, which may often be considered non-distinctive – for example, because they refer to a particular sport, location and/or the year in which the event takes place (e.g. the US

Value as a Tennis Player', Pinsent Masons (27 June 2022), available at: www.pinsentmasons.com/out-law/analysis/maximising-brand-value-tennis-player.

⁷ Trade-Related Intellectual Property Rights (TRIPS) Agreement, Art. 1(1); Council Regulation No. 2017/1001/EC (EUTMR), Art. 4, clearly provides that a trademark must function as a source identifier: 'An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the Register of European Union trademarks ("the Register"), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.' Similar provisions are found in the national legislation of individual EU Member States, as well as UK Trademarks Act 1994, s. 1.

⁸ TRIPS Agreement, Art. 1(1); EUTMR, Art. 7(1), provides: 'The following shall not be registered: (a) signs which do not conform to the requirements of Article 4; (b) trademarks which are devoid of any distinctive character; (c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service; (d) trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.' However, it is possible to overcome a refusal under Art. 7(1)(b), (c) or (d) if 'the trademark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it'; similarly, UK Trademarks Act 1994, s. 3.

Open). There are also other grounds for refusal which are outside the scope of this chapter.⁹

Trademarks are widely regarded as the strongest form of IP protection as they are capable of being protected indefinitely, provided that the trademark owner keeps using it and pays the renewal fees when they are due, whereas all other IP rights have limited life spans. Registered trademarks provide the strongest form of protection against third-party infringements. Some countries, such as the United Kingdom, equally recognise unregistered trademarks which may become enforceable by means of an action of passing off. In addition to requiring proof of reputation and goodwill in a trademark, it is also necessary to show that there has been a misrepresentation that could mislead the public, as well as proof of damage, such as financial loss or damage to goodwill. An action for passing off can therefore be both difficult to prove and expensive.

3.1.1 Types of Trademarks

Trademarks may be categorised into so-called ‘traditional’ and ‘non-traditional’ trademarks. Both are explored in the following sub-sections.

3.1.1.1 Traditional Trademarks Traditional trademarks are those that all businesses have or should have, and which are encountered on a daily basis, namely, word marks (e.g. Lacoste, Roger Federer, Wimbledon), logos or figurative marks (e.g. the Lacoste crocodile) or a combination of words and images (e.g. the Wimbledon logo which contains the words ‘The Championships Wimbledon’ or Fred Perry’s signature).

Slogans (such as the famous phrase ‘You cannot be serious’, coined by John McEnroe) may also be viewed as a type of word mark.¹⁰ However, slogans are generally very difficult to register because trademark offices and courts tend to find they lack distinctiveness if they are no more than a mere advertising message extolling the qualities of the goods or services in question, unless it can be shown that they have acquired distinctiveness through use in the sense that consumers would immediately recognise the

⁹ EUTMR, Art. 7.

¹⁰ John McEnroe’s famous catch phrase ‘YOU CANNOT BE SERIOUS’ was registered with the US Trademark Office until September 2014 in relation to T-shirts under US Trademark Registration No. 3379565.

slogan as referring to particular goods or services provided by one undertaking, or alternatively if they possess some unique qualities.¹¹

3.1.1.2 Non-Traditional Trademarks As their name suggests, non-traditional trademarks are quite unusual. However, they are increasingly being considered by all types of businesses as part of a comprehensive brand protection strategy. Non-traditional trademarks encompass other aspects of a brand, such as colours, shapes, sounds, smell, tastes, movements/gestures and holograms. The increase in applications for non-traditional trademarks in the European Union is in part attributable to the fact that until recently it was only possible to register a trademark if it was capable of being represented graphically. For example, a sound mark would have to be represented by notes, clefs and ledger lines, which meant that it was often difficult to capture the essence of a sound. However, amendments to the relevant trademark legislation recognised technical advancements. Hence, it is now possible to submit sound or video files for a trademark application.

Nonetheless, it is often an uphill struggle to obtain protection for non-traditional trademarks because trademark offices usually find that such marks are not capable of indicating origin unless there is something unique about them.

3.1.1.3 Colour Marks Colour marks constitute one of the most common applications for non-traditional trademarks. According to EU case law, single colours can be registered if they have acquired distinctiveness. Colour combinations can also be protected, provided that the application for registration includes a systematic arrangement associating the colours

¹¹ The Court of Justice of the European Union (CJEU) has provided a helpful list of criteria that should be used when assessing the distinctive character of a slogan. See *Audi AG v. Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case C-398/08 P, ECLI EU:C:2010:29, at para. 47; *Smart Technologies ULC v. Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-523/09, ECLI EU:T:2011:175, at para. 37. An advertising slogan is likely to be distinctive whenever it is seen as more than a mere advertising message extolling the qualities of the goods or services in question because it: (i) constitutes a play on words; (ii) introduces elements of conceptual intrigue or surprise; (iii) has some particular originality or resonance; (iv) triggers in the minds of the relevant public a cognitive process; (v) contains unusual syntactic structures; and/or (vi) uses linguistic and stylistic devices, such as alliteration, metaphors, rhyme, paradox, etc.

in a predetermined and uniform way.¹² When assessing whether the mark has a distinctive character, trademark offices will consider whether, in the perception of the relevant public, the colour is capable of identifying the source of the goods or services and distinguishing them from competing products. This is balanced against a general interest not to unduly restrict the availability of colours for other traders who offer goods or services of the same type. Applications covering a large number of goods or services are less likely to be granted protection as opposed to those that are more specific. In addition, there are only a limited number of colours in internationally accepted codes, meaning that strong evidence would be required to show that the public expects goods sold under a particular colour to represent the goods of a discreet trader.

In tennis, undoubtedly, the most historic and iconic colour scheme is the dark green and purple which has been associated with the Wimbledon Championships for more than 100 years. For many years, the All England Lawn Tennis and Croquet Club (AELTC) has faced numerous issues in relation to preventing unauthorised third-party use of their signature colours. In 2016, the AELTC was successful in registering two colour trademarks for both vertical and horizontal green and purple stripes in the United Kingdom.¹³ Prior to this registration, the club had to rely on the law of 'passing off' to prevent third parties from piggybacking on the goodwill of the Championships by using those colours to imply an association with Wimbledon, when no such association existed.

3.1.1.4 Shape Marks Trademark offices are generally reluctant to grant registrations for shape marks as these are often perceived as falling more within the scope of design rights or patents. It is often only possible to get a shape mark over the line if it also includes distinctive verbal elements. In particular, signs cannot be registered if they consist exclusively of:

- (i) signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering the service, or other characteristics of the goods; and

¹² *Heidelberger Bauchemie GmbH's Trade Mark Application*, Case C-49/02, ECLI EU: C:2004:384.

¹³ UK Intellectual Property Office, Trademark No. UK000003095408, available at: <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003095405>; <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003097108>.

- (ii) the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods.¹⁴

While adding further elements to a mark may mean that it does not consist ‘exclusively’ of one of the features set out in (ii) above, such shape marks may still be ineligible for registration if the shape of the goods merely denotes those goods to the relevant customer; because, for example, the shape is seen to be descriptive or non-distinctive.¹⁵ Additionally, applications to register shape marks based on their verbal descriptions may be rejected if they lack clarity, precision and objectivity.¹⁶ Examples of successful sports-related shape mark applications include the World Cup Trophy owned by FIFA.¹⁷ The AELTC recently sought protection for its trophies, albeit it elected to file these applications in the form of logo marks as opposed to shape marks, presumably because registration is usually easier to obtain for logo than shape marks.¹⁸

As with most non-traditional trademarks, the important point to remember is that the sign for which protection is sought must deviate significantly from the norms and customs in the sector.¹⁹ It is possible to imagine that there could be other tennis-related shapes, such as the umpire’s chair and related accessories, that could potentially qualify for registered trademark protection if they depart from the norms and customs of the sector. It is more likely, though, that elements like this

¹⁴ EUTMR, Art. 7(1)(c) and (e).

¹⁵ See *Lego Juris A/S v. OHIM*, Case C-48/09, ECLI EU:C:2010:516.

¹⁶ In *Dyson v. Registrar of Trade Marks*, Case C-321/03, ECLI EU:C:2007:51, the CJEU held that Dyson could not register the concept of ‘a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner’, as this could take on any number of different appearances. Similarly, in *JW Spear & Son Ltd v. Zynga Inc.* [2014] 1 All ER 1093, the manufacturers of Scrabble were prevented from registering the shape of a Scrabble playing tile, described as ‘a three dimensional ivory-coloured tile on the top surface of which is shown a letter of the Roman alphabet and a number in the range of 1 to 10’. This mark was held not to be a ‘sign’ as it potentially covered many different signs achievable through the permutations, presentations and combinations of the numbers and letters on each tile.

¹⁷ EUIPO, ‘Trademark without Text’, No. 009096736, available at: <https://euipo.europa.eu/eSearch/#details/trademarks/009096736>.

¹⁸ The registration of EUIPO is available at: <https://euipo.europa.eu/eSearch/#details/trademarks/018975150> and equally at: <https://euipo.europa.eu/eSearch/#details/trademarks/018974902>.

¹⁹ *Jaguar Land Rover Ltd v. Office for Harmonisation in the Internal Market (Trade Marks and Designs)*, Case T-629/14, ECLI:EU:T:2015:878.

would be protected by registered designs and/or copyright, and not by reference to trademark law.

3.1.1.5 Sound Marks An example of a sports-related sound mark that has been registered successfully by FC Barcelona is for the spoken word BARCA.²⁰ Looking at the field of tennis, there may be certain unique sounds that could be registrable as trademarks. For example, a number of tennis players are known for their very distinctive grunts and would be instantly recognisable – for example, Andrey Rublev’s ‘Bwehhhh’. The question is whether there is any commercial value in protecting such a mark. It is possible that such a mark could increase the value of a fashion-related trademark. For example, if a tennis enthusiast were to visit a clothing store and heard the distinctive grunt of their favourite player in the background, this may well awake positive emotions or memories and entice the tennis enthusiast to purchase something from that particular player’s clothing range.

3.1.1.6 Smell and Taste Marks Smell and taste marks are quite rare. Even so, in 1996, the EU Intellectual Property Office (EUIPO) accepted: ‘The smell of fresh cut grass’ in respect of ‘tennis balls’.²¹ This registration has since expired.²²

3.1.1.7 Motion, Gesture Marks and Holograms An increasingly popular category of non-traditional trademarks in the sports sector is the motion or gesture mark. In particular, there is a sub-category of motion marks, known as gestures, which are unique identifiers of certain athletes. To be registrable, such motions would normally need to be relatively short and repetitive and not purely functional. A recently high-profile case arose when Usain Bolt applied to register his famous ‘lightning bolt’ gesture in the United States for which he already had long-standing trademark protection in relation to clothing, sports equipment and other merchandising classes in the United Kingdom and European Union.²³

²⁰ EUIPO, ‘Trademark without Text’, No. 01770361, available at: <https://euipo.europa.eu/eSearch/#details/trademarks/01770361>.

²¹ WIPO, ‘Smell, Sound and Taste: Getting a Sense of Non-Traditional Trademarks’, *WIPO Magazine* (25 February 2009), available at: www.wipo.int/wipo_magazine/en/2009/01/article_0003.html.

²² EUIPO, ‘The Smell of Fresh Cut Grass’, registration available at: <https://euipo.europa.eu/eSearch/#basic/1+1+1+1/100+100+100+100/000428870>.

²³ Désirée Fields, ‘Bolt Trademark Could Inspire Tennis Stars to Follow’, Pinsent Masons (23 August 2022), available at: www.pinsentmasons.com/out-law/news/bolt-trade-mark-

In tennis, Niclas Kroon was known for the ‘Vicht’ salute as a form of celebration and went on to register rights to an associated trademark in 1988. Kroon held rights in the mark together with Mats Wilander. However, when they forgot to renew the registration, Lleyton Hewitt, who had adopted this symbol himself, took advantage and registered the mark for clothing and accessories.

4 Scope of Trademark Protection

Trademarks are not protected in relation to everything but in respect of particular goods and services that fall into different Classes of the Nice Classification system.²⁴ There are forty-five Classes in total: thirty-four Classes of goods and eleven Classes of services. Each Class has a general Class heading which relates to a longer alphabetical list of goods and services. The Nice Classification is updated annually, albeit it is not always adept at keeping up with the pace of new technological developments.

The Classes of goods and services relevant to the tennis sector will very much depend on the individual or business concerned. For example, a tennis player might wish to protect its name and, if applicable, logo very broadly in relation to a range of goods and services in order to keep the door open for future merchandising opportunities. While the scope of trademark protection may differ in each case, the following Classes tend to be the most popular in the tennis/sports industry, depending on the nature of the trademark owner’s business/activities:

- **Class 3:** Cosmetics, toiletry preparations; perfumery, essential oils;
- **Class 9:** Computer software; mobile applications; eyeglasses;
- **Class 12:** Vehicles;
- **Class 14:** Jewellery, precious and semi-precious stones; horological and chronometric instruments;
- **Class 16:** Paper and cardboard; printed matter; photographs; stationery;

tennis; equally, EUIPO, ‘Trademark without Text’, No. 008669236, available at: <https://euipo.europa.eu/eSearch/#details/trademarks/008669236>; and EUIPO, ‘Trademark without Text’, No. 009787573, available at: <https://euipo.europa.eu/eSearch/#details/trademarks/009787573>.

²⁴ The current version of the Nice Classification system is available at: www.wipo.int/classifications/nice/nclpub/en/fr/.

- **Class 18:** Leather goods; luggage and carrying bags; umbrellas and parasols;
- **Class 21:** Household or kitchen utensils and containers; cookware and tableware; glassware, porcelain and earthenware;
- **Class 24:** Textiles and substitutes for textiles; household linen; curtains of textile or plastic;
- **Class 25:** Clothing, footwear, headwear;
- **Class 28:** Games, toys and playthings; video game apparatus; gymnastic and sporting articles;
- **Class 35:** Advertising; business management, organisation and administration; office functions; organisation of promotional events;
- **Class 38:** Telecommunications; broadcasting;
- **Class 41:** Education; provision of training; entertainment; sporting and cultural activities;
- **Class 43:** Services for providing food and drink; temporary accommodation.

The foregoing are mere examples of what may be included within these Classes. In practice, they include many more items. Again, it is highly advisable to seek the advice of a trademark lawyer to ensure that a comprehensive specification of goods and services is included with any application.

4.1 *Designs*

Design rights are intended to protect the appearance of a product in whole or part. In the European Union and United Kingdom, designs can be either registered or unregistered. Design rights are of particular importance in the sports industry to protect innovative shapes and designs of products in 2D or 3D, such as the design of shoes, trophies and mascots. Unregistered design protection protects against unauthorised copying of the design and the mechanism in place arises automatically. Unregistered UK design rights provide protection for the lesser of (1) fifteen years from the end of the calendar year when the design was first recorded in a design document or (if earlier) from when an article was first made to the design; or (2) ten years from the end of the calendar year when articles made to the design were first made available for sale or hire.²⁵ EU unregistered design rights last for three years.²⁶

²⁵ Copyright, Designs and Patents Act 1988, Pt III, s. 216(1).

²⁶ Council Regulation No. 6/2002 of 12 December 2001 on Community Designs, OJ L 3, 5.1.2002, Art. 11.

In the European Union and United Kingdom, it is possible to apply for registered designs as long as they are (1) novel; (2) of individual character; and (3) not excluded by statute.²⁷ Unlike trademarks, registered design protection lasts for a maximum of twenty-five years, provided renewal fees are paid every five years. The protection of designs at the international level can benefit from the World Intellectual Property Organization's (WIPO) international protection Hague System.²⁸

4.2 Copyright

Copyright is intended to protect original artistic, musical, dramatic and literary works, including computer programs, certain databases, sound recordings, films, broadcasts and typographical arrangements of published works. It arises automatically upon creation of the work. Copyright in relation to artistic, musical, dramatic and literary works lasts for seventy years from the death of the author. Sound recordings are protected for seventy years from the date of publication, whereas broadcasts are protected for a period of fifty years from the date of making.²⁹

It is important to note that copyright does not protect the idea itself, but only the expression of an idea. Therefore, it only protects against the copying of a work and not the independent development of the same idea. The copyright owner is entitled to prevent the unauthorised use of the work, for example, making copies.

The sports industry is an image industry which is built on images of athletes and teams. Accordingly, copyright is an important means of protecting the visual content associated with sports events. However, there is a lack of harmonisation of copyright protection internationally, which gives rise to challenges. The main areas in which copyright is relevant in the tennis industry include: (1) protection of sports performances and of the recording of sports performances; (2) protection of broadcasters; (3) protection of organisers of sports events; and (4) protection of databases relating to sports events.³⁰

²⁷ Ibid., Art. 4(1); UK Registered Designs Act 1949, s. 1B ff.

²⁸ De Werra, 'Reference Guide', 21; WIPO, 'Hague System – The International Design System', available at: www.wipo.int/hague/en/; WIPO, 'Sport and Design', available at: www.wipo.int/web/sports/design.

²⁹ UK Copyright, Designs and Patents Act 1988, ss. 12–15.

³⁰ De Werra, 'Reference Guide', 20–30.

4.3 *Image Rights/Rights of Publicity*

The image of tennis players can be protected by so-called ‘image rights’ or ‘rights of publicity’ which play a very important role in the sports industry. Image rights are not recognised everywhere in the world and the scope of protection can differ significantly depending on the legal system in question. Broadly speaking, the term ‘image rights’ covers all the identifying features of an individual (such as names, initials, signatures, voice, body features and achievements). Some of these elements can also be protected by other IP rights, in particular trademarks or copyright. The commercialisation of image rights can yield significant revenues for prominent tennis players. Image rights can also provide tennis players with a means of preventing the unauthorised commercial use of their image or other personal features.

4.4 *Patents*

Given that the sports industry is very much driven by innovation, patents are also of prime importance in the tennis industry. While individual athletes might not own patent rights, they rely extensively on technology to improve their performance. By way of example, many tennis players, such as the top German player Alexander Zverev, use virtual reality trainers alongside their normal on-court training.³¹ The sports goods industry also invests heavily in technological developments. Perhaps the most famous example is electronic line calling, such as Hawkeye, that is phasing out the need for human lines-people.

Patent protection provides inventors with a twenty-year monopoly³² over inventions and protects new and inventive technical features of products and processes. In order to attract patent protection, an invention must be new, involve an inventive step, be capable of industrial application and not be specifically excluded from protection.³³ Examples of matters that are excluded from protection are computer programs, business methods and methods of medical treatment.³⁴ Patents are difficult and expensive to maintain.

³¹ Improvr, available at: <https://goimprovr.com/>.

³² UK Patents Act 1997, s. 25.

³³ *Ibid.*, s. 1.

³⁴ *Ibid.*, ss. 1(2) and 4(A).

4.5 *Trade Secrets/Confidential Information*

Trade secrets or confidential information are not strictly speaking IP rights, but serve to protect sensitive information, which can be commercial, technical or both in nature. They play a very important role in the tennis industry, giving a competitive advantage to athletes and the highly innovative sporting goods industry which relies on trade secrets and confidential information to commercialise its products. Accordingly, robust protection of trade secrets is very important in this sector. Protection of confidential information is implemented by local IP laws.³⁵ Generally speaking, in order to be considered enforceable, the information concerned must (1) be confidential in nature; and (2) have been imparted in circumstances in which an obligation of confidence arises. Furthermore (3), its unauthorised use must be to the detriment of the person imparting it.

5 Commercialisation of IP Rights

Just like other sports industries, the reason why the tennis industry is so dependent on the efficient protection of IP rights is because it derives a significant part of its revenues from control over IP rights relating to events and institutions which allow commercialisation of said rights internationally. In addition to IP laws, contract law plays an important role in the commercialisation of tennis-related IP rights because this area is heavily underpinned by contracts in a wide variety of contexts, including sponsorship, endorsement and broadcasting agreements.

5.1 *Sponsorship Agreements*

Sponsorship is a prime source of revenue for a number of stakeholders in the tennis industry and refers to a form of marketing whereby a sponsor (usually a business organisation) pays for marketing rights to associate itself with the particular event, activity, venue, content, organisation, individual athlete or sporting team being sponsored. Sponsorship can offer businesses exposure for a brand, the chance to reach new audiences and reinforce, or change, existing consumer perceptions while providing those sponsored with much-needed revenue. However, there are risks and pitfalls inherent in any sponsorship arrangement to navigate. For

³⁵ TRIPS Agreement, Art. 39.

example, the actions taken by those sponsored as well as event organisers will be linked to the sponsor and the sponsor has no control over the same. Thus, negative behaviour by a sponsored party could significantly impact the brand value of the sponsor.³⁶

Stakeholders first need to have a clear understanding of what they want to achieve from the sponsorship relationship. There are many commercial factors to be considered, such as whether the relationship provides the right exposure, reaches the right audience, and fits with the brand values of the sponsors and those being sponsored. Planning the communication and implementing a clear branding strategy, as well as a carefully drafted sponsorship agreement, can make all the difference. A formal, written sponsorship agreement is a major tool in safeguarding any brand. A contract that gives sponsors robust protection will include morality clauses, which will specify prohibited behaviours that trigger other rights under the contract – such as the right to suspend payments or terminate the agreement. Robust termination provisions within the contract are important, as are *force majeure* clauses that account for unforeseeable events that prevent performance of the contract.

Other important aspects of a title sponsorship agreement will include payment provisions that facilitate staggered payments, which are weighted against large upfront payments. Exclusivity clauses will help protect the investment made by the sponsor in the event and can be supported by further contractual safeguards against ‘ambush marketing’ activities – where other brands look to unfairly piggyback on an event to leverage marketing of their own brand. IP and associated rights will shape the strategy around any potential co-branding activities. Each stakeholder will aim to ensure that they have as much control as possible over how their brand is used and monitor that any brand guidelines are strictly adhered to.

5.1.1 IP Provisions in Sponsorship Agreements

There are certain key considerations in respect of IP rights that need to be taken into account when considering sponsorship agreements.

5.1.1.1 Details of IP Rights Exploited during the Sponsorship The sponsorship agreement should clearly set out the details and ownership of all IP rights to be exploited during the sponsorship, as well as the

³⁶ Désirée Fields and George Campbell, ‘How to Maximise Your Title Sponsorship of Tennis Events’, Pinsent Masons (13 June 2022), available at: www.pinsentmasons.com/out-law/analysis/title-sponsorship-of-tennis-events.

owner of the relevant IP rights. This can be particularly difficult where IP rights are created jointly, such as a new logo, or where IP rights incorporate features of a tennis player. By way of example, Lacoste owns trademark registrations for logos associated with Daniil Medvedev and Novak Djokovic, both of which incorporate their personal name.³⁷ A prudently drafted sponsorship agreement would need to deal with not only the current trademark ownership arrangements, but also include provisions about rights ownership following the termination of any sponsorship agreement.

When reviewing a sponsorship agreement, the parties need to consider whether the name and logo that constitute the IP subject matter of the sponsorship are registered or whether it is desirable to do so. While it is advisable to obtain registrations for all IP rights, there may be some situations where a combined mark simply consists of a side-by-side placement of the parties' existing trademarks. In a scenario like this, options include registering ownership of the combined logo in both parties' names or dealing with ownership and use as part of ordinary licensing arrangements. Where a logo has been created by a third party, it is also necessary to ensure that any rights in the logo have been assigned to the entity or person intending to use and register the mark.

5.1.1.2 Licensing Arrangements The sponsorship agreement needs to clearly set out the licences that each party grants to the other to use its intellectual property rights. By way of example, the sponsor may require a licence from the athlete to use their trademarks, names and likeness, as well as any specific marketing assets created for a sponsorship campaign for the purposes of certain marketing activities. In turn, the sponsored party will expect a licence from the sponsor to use its trademarks in a number of ways, for example, on clothing or otherwise publicising the sponsorship. The licence terms pertaining to IP would include terms such as: (1) the types of usage which are permitted; (2) whether the licence is exclusive or non-exclusive; (3) whether either party has the right to grant sub-licences; (4) who is entitled or required to take action against third-party infringement of IP rights; and (5) any approval

³⁷ See e.g. EUIPO, 'International Trade Mark Registration No. 1720387 for a logo incorporating Daniil M', available at: <https://euipo.europa.eu/eSearch/#details/trademarks/W01720387>; and EUIPO, 'International Trade Mark Registration No. 1360540 (based on EUTM Registration No 016792591) for the silhouette of Novak Djokovic incorporating his full name', available at: <https://euipo.europa.eu/eSearch/#details/trademarks/016792591>.

requirements for use of IP rights. It is important to bear in mind that there may be jurisdictional differences in legal protection and formalities, especially in relation to personality rights. It is also important to include details regarding the duration of the licensing arrangement, the territories covered and robust termination provisions. Licence agreements further include financial terms, which could include lump-sum payments, royalty percentages and others.

5.1.1.3 Ambush Marketing Ambush marketing is a marketing strategy in which a non-official advertiser ‘ambushes’ an event to compete for exposure against official sponsors. Ambush marketing campaigns are usually clever, carefully thought out and entertaining, and are therefore often more memorable than ‘regular’ advertising. Some forms of ambush marketing are legal, some are illegal and some tread a fine line between the two. The concept itself refers to a situation where a non-sponsoring company attempts to deflect attention to itself and away from the sponsoring company, which undermines the effectiveness of the sponsorship communication and also the value of the sponsorship.³⁸

By way of example, in 2011, Heineken was the official beer sponsor of the US Open. Stella Artois chose to advertise their brand on the rail station platform closest to the Bille Jean King National Tennis Centre, with large posters featuring tennis themes, such as: ‘Your trophy awaits’; ‘A Perfect Match’; and ‘The top-seeded Belgian’. This led to confusion as to who was the official sponsor.³⁹

The legal, statutory and regulatory framework in relation to ambush marketing differs from country to country and is outside the scope of this book. There is no single law protecting against ambush marketing. However, IP rights such as trademarks, copyright and designs may be of assistance. Additionally, there are certain contractual provisions that may be included in sponsorship agreements and practical steps that can be taken. Indeed, sponsorship agreements should set out who is expected to act against ambushers, who should pay for related fees and expenses, and whether a sponsor is due any compensation if ambushing occurs. There are a number of steps that can be taken to mitigate the effects of ambush marketing, such as renaming a tournament with the main

³⁸ Phillip Johnson, *Ambush Marketing and Brand Protection: Law and Practice*, 3rd edn (Oxford University Press, 2021), 656.

³⁹ Jess Blissett, ‘The Impact of Ambush Marketing on Official Partnerships’, *Sporting Her* (2 January 2022), available at: <https://sportingher.com/the-impact-of-ambush-marketing-on-official-partnerships/>.

sponsor's brand, operating a 'clean venue' policy or restricting external non-sponsored goods to be brought into the venue.

5.2 *Endorsement Contracts*

The terms 'sponsorship agreement' and 'endorsement contract' are often used interchangeably and as a result their contractual mechanisms and content tend to be similar. However, while a sponsorship deal is primarily focused on a financial transaction, an endorsement deal usually involves a contract between an individual athlete and a company, whereby the athlete actively endorses a particular product, for example, by appearing in marketing campaigns and being a brand ambassador. The provisions relating to the licensing of IP rights would closely mirror those in sponsorship agreements, as explained above.

5.3 *Merchandising Agreements*

A merchandising agreement grants a licence to a third party to use IP rights for the creation of consumer products in respect of distribution, sale and marketing. By way of example, all tournaments offer a wide range of branded products to tennis enthusiasts during the event and, in the case of prestigious Grand Slams, all year long. A merchandising agreement includes the same terms as other licensing agreements in the sports industry. Additionally, a robust merchandising agreement will also include quality control provisions allowing a licensor to examine the quality of the licensed merchandise and related advertising before the parties' mutual release and during the term of the merchandising agreement. This is crucial for the licensor in order to be able to control its reputation and brand image, as inferior merchandise could devalue a brand. This is particularly vexing in situations where products might not be fit for purpose and give rise to product liability claims.

5.4 *Broadcasting Rights Agreements*

Broadcasting rights, also known as media rights, generate the highest revenue for sports organisations and are highly sought after by broadcasters who make lucrative offers for the exclusive right to broadcast sporting events live. By way of example, Sky Sports entered a blockbuster deal with the ATP and WTA at the end of 2023 to broadcast live tennis tournaments in the United Kingdom and Ireland for forty-eight weeks of

the year. The deal covers eighty tournaments a year, with the broadcaster reportedly paying £10 million per year for the rights.⁴⁰

The grant of broadcasting rights is complex and can involve granting rights in all media for one or more territories or a split according to the types of rights and media involved. There are different legal and regulatory frameworks for broadcasting in television and television available over the Internet. This complexity is further exacerbated by the range of IP laws governing broadcasting, which vary significantly from country to country. Copyright and related rights govern the relationship between sports organisations and broadcasters.⁴¹

Piracy in live sport broadcasting is a growing issue, which disincentivises investment. It is estimated to cost event organisers up to €28 billion in lost revenue each year. Illegal streams of live sports events can also harm end users by exposing them to identity theft, malware or theft of credit card details and other personal data. Existing legislation is not necessarily robust enough to protect event organisers, broadcasters and their significant investment.⁴² It is therefore crucial that sports bodies and owners of broadcasting rights for sports events invest in monitoring for illegal streaming and consider the options they have for enforcing their rights against infringers in the context of their commercial objectives.⁴³

⁴⁰ 'Tennis Gets Major Boost in UK with Blockbuster New Sky Sports Deal', tennishead (27 November 2023), available at: <https://tennishead.net/tennis-gets-major-boost-in-uk-with-blockbuster-new-sky-sports-deal/>.

⁴¹ The Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations of 1961 establishes minimum standards of international protection for broadcasting organisations. Under the Convention, broadcasting organisations have the right to authorise or prohibit certain acts, namely: (i) the re-broadcasting of their broadcasts; (ii) the fixation of their broadcasts; (iii) the reproduction of fixations of such broadcasts; and (iv) the communication to the public of television broadcasts if such communication is made in places accessible to the public against payment of an entrance fee. The Rome Convention provides that the term of protection provided by signatories must last at least twenty years computed from the end of the year in which (i) the fixation was made – for phonograms and for performances incorporated therein; (ii) the performance took place – for performances not incorporated in phonograms; or (c) the broadcast took place – for broadcasts. However, many national laws provide for a longer term protection.

⁴² Gill Dennis and Tom Nener, 'Action Needed to Protect Value of Sports Broadcasting Rights amidst Piracy Risk', Pinsent Masons (23 March 2023), available at: www.pinsentmasons.com/out-law/analysis/protect-value-sports-broadcasting-rights-amidst-piracy-risk; Tom Nener, 'Delay in EU-Wide Legislation to Tackle Live Sports Piracy "Harmful to Rights Holders"', Pinsent Masons (24 May 2023), available at: www.pinsentmasons.com/out-law/news/delay-in-eu-wide-legislation-to-tackle-live-sports-piracy-harmful-to-rights-holders.

⁴³ Julian Diaz-Rainey and Tom Nener, 'Sports Bodies Have Options for Tackling Illegal Streaming, Say Experts', Pinsent Masons (2 June 2023), available at: www.pinsentmasons.com/en-gb/out-law/news/sports-bodies-have-options-tackling-illegal-streaming?utm_

6 Enforcement of IP Rights

Obtaining relevant IP protection and putting contractual arrangements in place is only part of a balanced brand protection strategy. IP rights do not enforce themselves and it is up to IP rights owners to take appropriate steps against third-party infringements and misuse of such rights. Failing to properly police IP rights and take appropriate enforcement action can significantly reduce the value of a brand.

6.1 *Monitoring Infringements*

To identify infringements, brand owners must monitor third-party uses and infringements and take appropriate enforcement action where such infringements are identified. There are a variety of different services available to monitor third-party infringements, including trademark watches, domain name watches and company name watches. Subscribing to such services will allow brand owners to identify any trademarks, domain names or company names applied for or registered by third parties that are in contravention of identical or similar trademarks and which are lawfully registered.

Infringement often takes place online – for example, on social media platforms. Combatting infringement of IP rights online can be challenging and requires a clear enforcement strategy. IP rights holders can undertake manual searches online on an ad hoc or regular basis, although this is unlikely to eradicate the problem. Online platforms are typically fitted with reporting tools and take-down procedures so that IP rights holders can complain of IP infringements. However, the manual approach and reporting has the downside of potentially missing infringements.

There are comprehensive brand protection solutions which allow rights holders to monitor and enforce the use of their IP rights online through a single platform that can be used to identify potential infringements. These platforms can be utilised to issue take-down notices. These services also have the added benefit of maintaining a record of infringing activity which can be used to provide proof of infringements on a platform existing in real time. Many of the brand protection solutions are equally able to provide more sophisticated brand protection

[source=vuture&utm_medium=email&utm_campaign=newsletter%20-%20english&utm_content=your%20weekly%20round-up%20-%20rest%20of%20the%20world%20\(109\)](https://doi.org/10.1017/9781009597616.004).

solutions, such as monitoring of online abuse of athletes on social media (which is becoming an increasingly serious issue).⁴⁴

6.2 *Enforcement Action*

The appropriate cause of action depends in large part on the type of IP right involved, the nature of the infringement and jurisdictional variations. Examples include litigation against trademark, design and copyright infringement (using the same or similar logo) and counterfeiting (imitating of genuine goods), as well as piracy (i.e. unauthorised copying, use, reproduction or distribution of materials protected by copyright). In respect of registered IP rights, in particular trademarks and designs, it is also possible to take action before the relevant IP registries in extra-judicial proceedings. Registered IP rights, in particular trademarks and design rights, are likely to be the most frequently invoked and strongest enforcement tools in combatting IP infringements. Other proceedings can include domain name complaints and company name complaints. The available enforcement actions and associated procedures will differ depending on the country in question.

6.2.1 *Cease and Desist Letters*

Regardless of the cause of action involved, it is usually recommended to send a 'cease and desist' letter to the infringing party to put them on notice that they are using certain IP rights without consent and request that they cease using these immediately and refrain from using them in the future. Indeed, in some cases, especially in court proceedings, it is mandatory to send a letter before issuing proceedings to avoid adverse consequences. The content of 'cease and desist' letters may indeed be prescribed by regulations – for example, the Civil Procedure Rules in the United Kingdom.⁴⁵ Making a mistake may severely impact the ability to take legal action and/or succeed with any legal claim.

6.2.2 *Issuing Substantive Proceedings*

Where a 'cease and desist' letter is ignored, taking enforcement action is usually the only means of challenging a potential infringer. The precise

⁴⁴ Associated Press, 'Tennis Players to Get Protection from Online Abuse through New Monitoring Service' (20 December 2023), available at: www.tennis.com/baseline/articles/tennis-players-social-media-online-abuse-protection-threat-matrix-service-ai-signify-group. See Chapter 8 of this volume on safeguarding.

⁴⁵ Civil Procedure Rules, available at: www.justice.gov.uk/courts/procedure-rules/civil.

enforcement action to be taken will depend on the circumstances of the case and the IP rights involved. It is outside the scope of this chapter to discuss all potential actions in detail. A brief summary of potential available enforcement mechanisms relating to trademarks is set out below.

6.2.2.1 Trademark Oppositions All trademark applications are examined by local trademark registries. In some countries, such as Australia and the United States, the examiner may raise earlier third-party rights as a bar to registration. In other jurisdictions, like the European Union and the United Kingdom, it is entirely up to the earlier rights holder to take action. Trademark applications are published for opposition purposes following a successful examination process. Trademark oppositions can be filed both on the basis of absolute grounds, such as where the trademark concerned is descriptive and non-distinctive and should be free for all traders to use; or on the basis of relative grounds, such as where the trademark is identical or confusingly similar to an existing registered mark or conflicts with existing prior common law rights established under the tort of passing-off. The length of an opposition period differs from country to country. The process of any opposition proceedings will also differ depending on the country in question, but it involves (1) filing an opposition notice and grounds of opposition; (2) filing a defence; (3) evidence rounds; (4) final submissions and/or hearing; and (5) issuance of a decision.

6.2.2.2 Trade Validity and Revocation Actions A registered trademark does not guarantee indefinite rights. A trademark registration can be challenged on various grounds, including invalidity of the mark (where a third party seeks a declaration that the registration is invalid) or revocation (where a third party seeks the revocation of the trademark on the ground that it has not been used, has become generic or is likely to mislead the public). Such challenges are often brought against registered trademarks as part of a wider infringement dispute. It is therefore crucial for IP rights owners in tennis to take the necessary steps to ensure their IP rights remain valid and enforceable by regularly reviewing their trademark portfolios.

6.2.2.3 Revocation A revocation action can be brought in respect of an entire registration or for specific goods and services. Revocation actions may be brought where a trademark has not been used, has

become generic or may mislead the public. Where a party has not put a mark to genuine use within a five-year period, it will need valid reasons for that non-use. A trademark must be used in relation to each of the goods and services for which it is registered. By way of example, the EU General Court has upheld an EUIPO Board of Appeal decision confirming that an EU trademark registration for the figurative sign NOAH owned by former Grand Slam Champion and tennis legend Yannick Noah remained registered in respect of 'polo shirts' and 'sweaters'. In reviewing the Board's decision, the General Court conducted an extensive analysis of the law surrounding genuine use. Notably, the General Court found that use in a slightly different form from its registered form, insofar as the mark included the first initial of Yannick Noah's name followed by a full stop, did not alter its distinctive character. The General Court also confirmed that the mark was used in relation to the marketing of sweater vests, which was sufficient to maintain the registration for the broader category of 'sweaters'. Further, given the consistent marketing strategy of limited-edition clothing, the General Court found that the mark had been put to genuine use for 'polo shirts' and 'sweaters'.⁴⁶ However, Yannick Noah did have his rights cut down considerably in scope.⁴⁷

Prominent sportspeople are increasingly cultivating a brand during their active years that they can continue to commercially exploit into retirement. This case highlights the risk athletes face by losing trademark rights if they do not put those marks to 'genuine use' in respect of the goods or services for which they were registered. Accordingly, athletes should think carefully about the scope of trademark rights they will need during and after their careers and ensure that their trademark protection extends to all relevant goods and services. Careful consideration should also be given to whether the mark used is sufficiently similar to the one registered in order to be able to fend off any potential non-use cancellation actions. Athletes are therefore advised to develop a strategy to ensure 'genuine use' is made of their trademark rights.⁴⁸

6.2.2.4 Invalidity Invalidity actions can be broadly brought on two grounds. First, bad faith is an absolute ground of refusal and so if it can be

⁴⁶ *Noah Clothing v. EUIPO*, Case T-562/22, EU:T:2024:23 (24 January 2024).

⁴⁷ Désirée Fields, 'Yannick Noah Case Highlights Athlete Brand Longevity Challenge' (2024) 35 Ent L Rev 1.

⁴⁸ Désirée Fields, 'Yannick Noah Case Highlights Athlete Brand Longevity Challenge', Pinsent Masons (16 January 2024), available at: www.pinsentmasons.com/out-law/news/yannick-noah-case-highlights-athlete-brand-longevity-challenge.

shown on the balance of probabilities that a party has not registered a trademark in good faith, it will be invalidated. It is on the party alleging bad faith to prove it. Persuasive evidence will be required. The owner of an earlier trademark can also challenge a later trademark registration if this is identical or similar to its own trademark and registered in relation to identical or similar goods and services (and there exists a likelihood of confusion where these are similar). Where a third party registers an identical or similar trademark in respect of dissimilar goods and services, it will be crucial for IP rights owners to demonstrate a reputation in a mark and that the later registration takes advantage of the earlier mark or is detrimental to its distinctive character or repute. This is likely to be easier for sizeable brands, but will be more difficult for smaller, newer brands.

6.2.2.5 Trademark Infringement Proceedings Unlike trademark opposition proceedings, which are concerned with preventing the registration of a trademark, trademark infringement proceedings are concerned with the use of an identical or similar trademark in relation to identical or similar goods or services in the course of trade without the proprietor's consent. Trademark infringement proceedings can be brought by the trademark owner. A licensee can also bring infringement proceedings in its own name in certain circumstances, which is often detailed in applicable licence agreements. It depends on the individual IP rights owner and the licensing relationship as to whether the licensor prefers to remain in control of all enforcement actions or put the burden on a licensee.

6.2.2.6 Domain Name Complaints All domain name registrars must follow the Uniform Domain-Name Dispute-Resolution Policy (often referred to as the UDRP). Disputes alleged to arise from abusive registrations of domain names (e.g. cybersquatting) may be addressed by expedited administrative proceedings initiated by a trademark rights holder through the filing of a complaint with an approved dispute resolution service provider. Generally speaking, a trademark owner can either file a complaint against a domain name registrant in a court that has jurisdiction or submit a complaint to an approved dispute resolution provider. The appropriate provider will depend on the domain name involved.⁴⁹ In order to succeed in a domain name complaint, it is

⁴⁹ ICANN, 'Uniform-Domain Name Dispute Resolution Policy', available at: www.icann.org/resources/pages/help/dndr/udrp-en.

necessary for the complainant to establish that: (1) the disputed domain name is identical with, or confusingly similar to, the complainant's trademark rights; (2) the respondent has no rights or legitimate interests in the disputed domain name; and (3) the disputed domain name has been both registered and used in bad faith by the respondent.⁵⁰ For example, Grand Slam Tennis Properties Ltd⁵¹ successfully obtained transfer of the domain name *tennisgrandslam.net* on the basis that it established that the term 'Grand Slam' had been used by the operators of the four prestigious Grand Slam tournaments since the 1930s, and that the public referred to the events as such and that in addition the respondent had taken advantage of the complainant's trademark without the licence of the complainant or other justification in bad faith.

6.2.2.7 Company Name Complaints One possible and effective way to stop a company that has registered the same or a very similar company name in the United Kingdom with UK Companies House is to submit a complaint to the Company Names Tribunal.⁵² Like domain name complaints, it is crucial to establish rights in the name and substantiate the claim that the company name has been registered in bad faith. Similar types of procedures may also be available in other countries.

6.3 Remedies

It is important to note that in proceedings before IP registries, there are no remedies as such. The result of such proceedings is that the registry will determine whether the relevant IP right has been infringed and the third-party application will be refused, allowed to proceed or declared invalid. There may also be a small costs award. However, a successful claim before IP registries will not automatically lead to an alleged infringer stop using the particular mark in question. Therefore, if an infringer decides to continue using a mark without registration, the only redress is often to bring legal action in the courts, which tends to be a time-consuming and expensive process.

⁵⁰ *Grand Slam Tennis Properties Ltd v. Contact Privacy Inc. Customer 0152960105 / Darryl Cazares, Grand Slam Nutrition Corp.*, Case D2020-1034.

⁵¹ Grand Slam Tennis Properties Ltd was established in 2009 to administer the intellectual property associated with the four prestigious tennis tournaments known as the Grand Slams.

⁵² A list of decisions issued by the Company Names Tribunal is available at: www.gov.uk/government/publications/company-names-tribunal-undefended-decisions-and-orders.

If an IP owner is successful, the courts may award a variety of remedies. The available remedies depend on the type of IP rights that was infringed and the specifics of the situation. Ultimately, the IP rights owner will be keen to maintain brand value for commercialisation purposes and be compensated for any losses incurred as a result of an infringement.

6.3.1 Injunctions

The most common remedy for all IP infringements is an injunction. This is a court order requiring the named persons to refrain from using the IP rights in question. There are different types of injunctions. An interim injunction can be granted as an emergency measure prior to the commencement of or during proceedings while the case is being decided. However, the courts will carefully weigh up the facts and only grant an injunction where there is a serious issue to be tried and where damages may be an adequate remedy. The courts will also consider the respective inconvenience or loss to each party depending on whether or not the interim injunction is granted.

Perpetual injunctions are typically granted as a final relief by the court, prohibiting the unauthorised use of the IP rights concerned. Failure to adhere to an injunction can result in fines and even imprisonment.

6.3.2 Damages or Account of Profits

Where an IP infringement has occurred, an IP rights owner will be entitled to compensation. Typically, the IP rights owner will be able to elect either damages or an account of profits, but not both. The preferable remedy will depend on the facts of a particular case. Damages are intended to cover the value of the damage caused to the IP rights owner, while an account of profits covers the profits that the infringing party has made as a result of their infringement.

6.3.3 Other Remedies

Other remedies include (1) an award of costs (intended to compensate the successful party for all or part of their costs incurred in the proceedings); (2) delivery up and/or destruction of infringing items; and (3) tracing orders.