

Can you use TM, names, image or other elements related to a sport event (without the consent of the right owner) ?

Analysis of the latest case law under French law

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Overview

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- Industrial property : are TM related to sport in some way reserved to some rightholder?
- Industrial property : the specific situation of olympic and federal elements
- Industrial property : the specific situation of « necessary references
- The scope of the monopoly of the sport event organizer
- Economical parasitism

Literary and artistic property

Examples

- Slogan, Device
 - “Droit au but” for Olympique de Marseille
 - “Més que un club” for Barcelona FC
- Songs, Anthems
 - Anthem of the UEFA Champions League)
- Photography
- Books and Magazines
- Speeches of the sport personalities
 - Jacques Rogge (CIO), Sepp Blatter (FIFA), Michel Platini (UEFA)
- Stadium’s architecture
- Trophy

Paris Court of Appeal, 9 March 2005, FIFA v.SNC Hachette Filipacchi associés

- The Company Hachette Filipacchi, in 1998, reproduced the World Cup Trophy in many issues of its magazine « Onze Mondial »
- The Court ruled that these reproductions do not benefit from the exception concerning the freedom of information (article L.122-5 of the French IT Code)
- There is no information given to the readers by the company concerning the trophy
- In fact, the Court ruled that the reproduction of the WC Trophy pursues a commercial goal

Court of cassation, 2 october 2007, n° 0514928, Société HFA v.FIFA

- Appeal against the above-mentioned ruling delivered by the Paris Court of Appeal
- At this instance, Company HFA relied upon Article 10 ECHR
- The Court ruled that there is an infringement from HFA since the reproduction of the trophy is not aimed at informing the public of elements in direct connection with the trophy
- THUS, HFA has to ask the consent of FIFA to reproduce the World Cup Trophy in its magazines

ECJ, 9 november 2004, C-444/02, C-338/02 et C-46/02, so-called rulings “Fixtures Marketing”

- The organisers of the English and Scottish league football retained a company to handle the exploitation of the fixture lists outside the United Kingdom through licensing
- Three gambling operators used this information database to offer betting on football championships
- Infringement as regards the *sui generis* right given by the Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases ?
- “A fixture list for a football league such as that at issue in the case in the main proceedings constitutes a database within the meaning of Article 1 (2) of Directive 96/9”

Industrial property : are TM related to sport in some way reserved to some rightholder?

Court of cassation, 17 January 2006, FFF v. SARL Allez les Bleus

- Company « Allez les Bleus » registered the nominal TM « Allez les bleus » in 1997, 1998 and 2000
- Company « Allez les Bleus » registered on 30 July 1999 the complex TM « Allez les bleus » represented by a cock and the national colour
- French Football Federation claimed anterior exclusive rights and brought a lawsuit against the company to obtain the cancellation of the TM
- Ruling of the Court of cassation :
 - TM « Allez les bleus » is distinguishing
 - The register of the TM « Allez les bleus » is not fraudulent
 - The expression « Allez les bleus » forms a part of popular and sports French patrimony
 - Absence of the reputation of the TM « Allez les bleus » at the date of registry

Chambéry Court of Appeal, 10 January 2006, Natale v. FFF et SA Football France promotion

- TM « La France championne du monde 98 » et « Les bleus champions du monde 98 » have been registered on 6 and 17 July 1998
- French Football Federation considered the register of these TM detracted from its rights. The appeal concerns only the TM « La France championne du monde 98 »
- Court of Appeal's ruling :
 - The register of the TM “La France championne du monde 98” is not fraudulent
 - The element is not deceptive and is not unavailable
 - The expression “Championne du monde” is not an appellation which is reserved by the law for the federation
 - Only “Federation” and “Champion de France” are reserved by the law for the federations
 - The federation has not expressed the clear and unequivocal will to register the TM at stake

Industrial property : the specific
situation of olympic and federal
elements

The sport code

- Article L. 131-17 Sport Code

“With the exception of sports authorized Federation at the date of 16 July 1992, only the sports delegatee federations can use the appellation “French Federation of” or “National Federation of” as well as award or make award the appellation “France Team” and “France champion” followed by the name of one or several sports and make it in their statutes, contracts, documents or advertisings”.

- Article L. 141-5 of Sport Code

“ CNOSF is owner of national Olympic emblems and trustee of the Olympic device, hymn, symbol and appellations « Olympic Games » and « Olympics ».

The fact of registering as mark, of reproducing, of imitating, of affixing, of deleting or modifying emblems, device, hymn, symbol and appellations referred to the first paragraph, without the authorization of the CNOSF, is punished by the penalties laid down in Articles L. 716-9 and following of the Intellectual Property Code”.

Court of cassation, 31 October 2006, so-called « Olymprix case »

- Company GELEC registered in 1987 and 1993 two TM « Olymprix » and used them to the organization and the advertising of a annual campaign of special offer (cut-price)
- CNOSF (French NOC) brought a lawsuit against company GELEC to ban the use and to obtain the radiation of the two TM “Olymprix”
- After several years of proceedings, CNOSF won and obtained the radiation of the TM « Olymprix »
- Thus, the TM « Olympic » and « Olympic Games » have the protection granted to the reputed and well known marks :
 - Infringement
 - Article L. 713-5 of the intellectual property Code
 - Article 1382 of the Civil Code

Toulouse Court of Appeal, 6 May 2008

- In July and September 2006, a natural person registered the French TM « France rugby team », while in September 2006, the French Rugby Federation registered the EU TM « France rugby team »
- Court of Appeal's ruling :
 - « Article L. 131-17 of the Sport Code does not restrict its ban to the only appellation of sports team and promulgates a general prohibition, as indicates it the term to award, which is not restrictive ; this text thus has the effect of restricting the modalities of use of the naming France team and of banning its utilisation by quite other that authorized or delegatee federations »
- However, this ruling can raise problems owing to the general prohibition
- What about sports which are not authorized or delegatee by the State (Paintball) ?
- What about other sectors which would like to use this appellation ?

Court of cassation, 15 September 2009, n° 08-15418

- A press company published an issue of its periodical magazine « Têtu » devoted to « Olympic Games of Sex » which used some elements granted to CNOSF. CNOSF brought a lawsuit.
- Court of cassation's ruling :
 - It follows from Article L. 141-5 of the Sport Code « that it is forbidden whoever to register as mark, to reproduce, to imitate, to affix, to delete or to modify the emblems, device, hymn, symbol and appellations at which it aims, for purposes other than of information or criticism, without the authorization of the CNOSF »
 - “ Article L. 141-15 of the Sport Code provides for an autonomous protection's system “
 - Autonomy of the provisions of the Sport Code (article L. 141-15) compared with the provisions laid down in the Intellectual Property Code concerning the TM

Industrial property : the specific
situation of « necessary references »

Relevant case law

- TGI Paris 16 October 2006, *LFP v. Sté Interwetten*
- TGI Paris 28 November 2007, *CNOSF v. Expekt.com Ltd*,
- TGI Paris 30 January 2008, *Sté Juventus FC SPA v. Sté Unibet Ltd*
- TGI Paris 30 May 2008, *FFT v. Sté Unibet Ltd et Sté Expekt*
- TGI Paris 17 June 2008, *SA PSG v. Sté Global Entertainment Ltd*
- CA Paris 14 October 2009, *FFT v. Unibet*
- CA Paris 11 December 2009, *Sté Global Entertainment Ltd v. Juventus FC SPA*
- CA Paris 2 April 2010, *SA PSG v. Bwin International Ltd*

Relevant legal provisions

- Article L.713-6 Intellectual Property Code

“ Registration of a mark shall not prevent use of the same sign or a similar sign as:

a) [...]

b) The necessary reference to state the intended purpose of the product or service, in particular as an accessory or spare part, provided no confusion exists as to their origin.

However, where such use infringes his rights, the owner of the registration may require that it be limited or prohibited”.

Typical facts as far as sport in concerned

- Online gaming operators used the TM of sports actor for their activity such as the name of the sports event, of the sports club
- Sports actors (French Federation, Professional League, CNOSF, Sports clubs) brought a lawsuit against the online gaming operators

The first period

- Distinction between a strictly necessary use and an use as promotional/ advertising
- Case law :
 - ✓ TGI Paris 16 October 2006, *LFP v. Sté Interwetten*
 - ✓ TGI Paris 28 November 2007, *CNOSF v. Expekt.com Ltd*,
 - ✓ TGI Paris 30 January 2008, *Sté Juventus FC SPA v. Sté Unibet Ltd*
 - ✓ TGI Paris 30 May 2008, *FFT v. Sté Unibet Ltd et Sté Expekt*
 - ✓ TGI Paris 17 June 2008, *SA PSG v. Sté Global Entertainment Ltd*

The second period

- Suppression of the distinction
- Banning and sanction of the use by an online gaming operator of the sports actor's name without the consent of the latter
- Paris Court of Appeal, 14 October 2009, *FFT v. Unibet*

The third period (current)

- The use by an online gaming operator is not banned without the consent of the sports actor
 - ✓ Use to designate the teams which are the object of the bet
 - ✓ Use as part of slogan or comments accompanying the bet
- Case law :
 - ✓ CA Paris 11 December 2009, *Sté Global Entertainment Ltd v. Juventus FC SPA*
 - ✓ CA Paris 2 April 2010, *SA PSG v. Bwin International Ltd*

The scope of the monopoly of the sport event organizer

Relevant legal provision

❑ Article L. 333-1 of the Sport Code

“The sports federation, as well as the organizers of sports events referred to in Article L. 331-5, are owners of the exploitation right of the sports events which they organize”

The scope?

- Originally, only the audiovisual rights are concerned by this exploitation right
- Then, the scope has been broadened by the case law
- Recently, three elements have been debated
 - ✓ the sports bet
 - ✓ the itinerary of the sports event
 - ✓ the result of the sports event/match

Relevant case law (1/2)

- ✓ Paris Court of Appeal, 28 March 2001, *Ste Gemka Production SA v. STF & ASO*
 - about the exploitation and the marketing in the form of picture's videogram of the different edition of the sports event

- ✓ Nanterre Bankruptcy Court, 12 December 2002, *ACO & ASAACO v. SARL Dragoon editions*
 - about the publication of a book devoted to the sports event

- ✓ Paris Court of First Instance , 28 January 2004, *FFT v. Hospitality Group*
 - about the marketing of « package » including ticket and public relations' services

- ✓ Court of cassation, 17 March 2004, *Andros v. Motor presse France*
 - about the diffusion of photography realized for the sports event

- ✓ Paris Court of First Instance, 30 March 2005, *STF & ASO v. Financière du Bois de Noe*
 - about the organization of a game devoted to the sports event

Relevant case law (2/2)

- Sports Betting :
 - Paris Court of First Instance, 30 May 2008, *FFT v. Sté Unibet Ltd et FFT c/ Sté Expekt*
 - Paris Court of Appeal, 14 October 2009, *FFT v. Unibet*
- Itinerary of the sports events
 - Paris Court of First Instance, 9 December 2008, *Tour de France et a. v. Eurocycler LLC et a.*
- Sports results
 - Paris Court of First Instance, 30 March 2010, *FFR v. Fiat France et a.*

Legal monopoly of the sports organizer

Paris Court of First Instance, 30 May 2008, *FFT v. Ste Unibet Ltd et FFT c/ Ste Expekt*

- Unibet and Expekt organized any bets on the French Open Tennis Tournament “Roland Garros” without the consent of the French Tennis Federation
- French Tennis Federation brought proceedings against Unibet and Expekt owing to the violation of the legal monopoly provided for in Article L. 333-1 of the Sport Code
- The Court ruled that Unibet and Expekt have infringed the exploitation right recognized to sports organizers by the Sport Code

Legal monopoly of the sports organizer

Paris Court of Appeal, 14 October 2009, *FFT v. Unibet*

- Appeal against the above-mentioned ruling
- The Court of Appeal upheld the CFI's ruling about the violation of the legal monopoly
 - confirmation by the legislator (Article 63 of the New Law on Online Gambling)
- The Court broadly interprets the scope
 - Sports betting
 - All economic activity connected with or peripheral to the sports event

Legal monopoly of the sports organizer

Paris Court of First Instance, 9 December 2008, *Tour de France et a.V. Eurocycler LLC et a.*

- A travel Agency used the characteristic elements of the Tour de France in order to present its products and in particular it organized travels based on the itinerary of this cycling event
- The organizer of the Tour de France brought a lawsuit against the travel Agency owing to the violation of the legal monopoly

Legal monopoly of the sports organizer

Paris Court of First Instance, 9 december 2008, *Tour de France et a.V. Eurocycler LLC et a.*

- The Court ruled
 - On the photography of the Tour de France : violation
 - On the use of the itinerary of the Tour de France : no violation
- The Court narrowly interprets the scope
 - Legal monopoly has to be narrowly interpreted
 - Legal monopoly is confined to live exhibition

Legal monopoly of the sports organizer

Paris Court of First Instance, 30 March 2010, FFR v. Fiat France et
a.

- Fiat published an advertising to promote the “Fiat 500” in taking a leaf out of the sports actuality and in particular of the result of the match France-England of the 6 Nations 2008
- Fiat did not use official elements concerning the sports events or concerning the teams which took part in it
- French Rugby Federation brought a lawsuit against Fiat

Legal monopoly of the sports organizer

Paris CFI, 30 March 2010, FFR v. Fiat France et a.

- According to the Court :
 - The scope of the legal monopoly does not include the result of the sports event
 - The advertising of the Fiat is not illegal since they did not use official elements
 - The legal monopoly must be narrowly construed

Economical parasitism

Court of Appeal, Aix-en-Provence, 3 April 2006

- Each sports club holds a complex TM including its name, any colours and a logo
- Marketing of a sport clothing line which included the slogan « 100% Sedanais », « 100% Nantais », « 100% Parisien », « 100% Lensois » et « 100% Marseillais » and also the both main colour of each clubs
- According to the Court, there is no economic parasitism as :
 - The customers represented by the supporters are not the ownership of the clubs
 - The clubs have no private right on the colour which represent them
 - There is no likelihood of confusion as the supporters know the products of the clubs

Court of Cassation, 3 October 2006

- Sports clubs « Sedan-Ardennes » brought a lawsuit against the company Sport Conseil owing to the confusion which exists between the products commercialized between both companies
- The Court ruled that the unfair competition is not proven as “ *the simple use of similar colours, even if it applies to products of the same type and targets the same public, is not sufficient to establish the existence of an unfair competition* ”