

SPORT AND THE REGISTRATION OF MOVEMENT MARKS

by Christina Michalos

Jonny Wilkinson, the England fly-half, who kicked the winning drop goal and became a media hero during the 2003 Rugby World Cup, undoubtedly now has massively increased merchandising potential. Before he takes a penalty kick Wilkinson carries out a distinctive ritual that involves a series of preparatory movements culminating with his hands clasped before him in a prayer-like gesture. On 25th November 2003 *The Times* newspaper reported that an application may be made on his behalf to register the ritual as a trademark. This raises the question of the protection available for sporting rituals and movements generally.

Images of people have been registered as trade marks for over 100 years. In 1897, a portrait of the mustachioed manufacturer of cough sweets was upheld as a registered trade mark.¹ Today there are a number of celebrities who have their photograph registered as trademarks including the racing driver Damon Hill² and the footballers Alan Shearer³ and Eric Cantona.⁴ In August 2003, Glasgow Celtic succeeded in registering various still images of the team's pre-match huddle as trademarks.⁵ The photographic images that are registered can be viewed by inputting the Trade Mark Number into the online database of registered trade marks maintained by the Patent Office which is freely available via the Internet.⁶

The registration of movements as trademarks is a more modern phenomenon. 'Movement' marks are not common but are not unknown. The Derbyshire Building Society has registered a mark that consists of a knowing tap on the side of the nose with an index finger.⁷ The Bradford and Bingley has a trade mark consisting of two characters in bowler hats slowly raising their hats and replacing them on their heads⁸ and an animated sequence of appearing and

disappearing bowler hats.⁹ Other registered movement marks include: a rotating globe device¹⁰ and a BT logo with a red and a blue arc rotating around it registered by BT¹¹ and a 3D globe breaking apart into segments registered by Kraft¹², presumably for a Terry's Chocolate Orange.

There are many rituals and gestures that are associated with particular sportsmen such as Frankie Dettori's flying dismount and football goal celebrations like Jurgen Klinsman's dive, Aylesbury United's kneeling duck waddle and Mick Channon's windmill. There is no reason in principle why movements or gestures distinctive of one person could not be registered as a trade mark *provided* they comply with the legal requirements.

A trade mark's purpose is to indicate the trade source of merchandise or services. In order to be registered a mark must be capable both of graphical representation and of distinguishing the goods of one manufacturer from those of another.¹³ Moving images and movements are capable of registration if they can be represented graphically as a series of still images and if they are distinctive of trade source.

Registration of human images as trade marks in the UK, whether as a still photograph or a part of a sequence of movements, is subject to the difficulty of the need to overcome the requirement for distinctiveness. This can be problematic as far as the use of a celebrity's image on memorabilia and merchandise is concerned. As Laddie J observed in the *Elvis Presley Trade Marks*¹⁴ case:

When a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source. Similarly the purchaser of any one of the myriad of

¹ Rowland v Michell (1897) 14 RPC 37.

² Trade Mark No.2036489.

³ Trade Mark No. 2117215.

⁴ Trade Mark No. 2120277.

⁵ Trade Mark No.2268621.

⁶ <http://www.patent.gov.uk/tm/dbase/index.htm>

⁷ Trade Mark No. 2012603

⁸ Trade Mark No. 2130164.

⁹ Trade Mark No. 2224649.

¹⁰ Trade Mark No. 2235348.

¹¹ Trade Mark No. 2226440.

¹² Trade Mark No. 2280003.

¹³ *Trade Marks Act 1994*, s.1(1) 'In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. . . .'

¹⁴ [1999] RPC 567 (CA); [1997] RPC 543.

cheap souvenirs of the royal wedding bearing pictures of Prince Charles and Diana, Princess of Wales, wants mementoes with likenesses. He is likely to be indifferent as to the source. Of course it is possible that, as a result of the peculiarities of the way goods are marketed or advertised, an inference of association with a particular trader may be possible to draw. This may be the case when the proprietor's products bear the word "Official". But that does not mean that absent that word members of the public would draw any such inference.¹⁵

In addition, the Trade Marks Registry Works Manual states that in any case where a proposed trade mark consists of an image of a famous living or recently deceased person that objection will be taken under section 3(6) of the 1994 Act (bad faith) unless the permission of that person, or if recently deceased their legal representative, has been obtained.¹⁶

Even if these hurdles can be overcome, registration of a sporting ritual would not give a monopoly right that would stop other people carrying out the same movements on the pitch. A trade mark application must identify the goods or services for which it is sought to register the mark. The mark is only infringed if it is used in the course of trade on the same goods for which it is registered¹⁷ or on similar goods where the use is likely to cause confusion.¹⁸ Use on completely different goods is only an infringement where the trade mark has a UK reputation and the use takes unfair advantage of or is detrimental to that reputation.¹⁹

The protection is limited to use that interferes with the mark as an indicator of trade source. If Wilkinson's pre-kicking ritual were to be registered for sporting articles and licenced to a particular sports manufacturer, another sports manufacturer using the ritual in their advert would infringe the mark. Another rugby player carrying out the ritual on the pitch would not be using the mark to indicate trade source and would not infringe.

Rituals distinctive of a particular sportsman may also be protected by the law of passing off. Passing off arises where one trader makes misrepresentations that

damage the reputation of another. Use of a particular ritual that is associated with one sportsman may amount to a false suggestion of endorsement and be actionable.

Different considerations may apply to innovative sporting manoeuvres that improve existing techniques, such as the Fosbury Flop highjump. In 1996, a group of American lawyers (R. Kunstadt, F.S. Kieff and R.G. Kramer) suggested in an article that such moves should be patentable if they are non-obvious.²⁰ They also suggested that such sporting moves are like choreographic steps and should have copyright protection. If a patent had been obtained for the Fosbury Flop, highjumpers would have needed to apply for licence to use the method. It is doubtful whether permitting such patent protection would be in the long term interests of sport and the improvement of sporting performances.

Following the ECJ decision concerning smell marks,²¹ it remains to be seen how the law will develop insofar as registration of other non-traditional marks is concerned. The registration of moving human images as trade marks and sporting rituals is a relatively untested area. The issue is summed up neatly by the Trade Mark Registry who state in their Works Manual regarding applications to register images of people: 'Such cases raise complex issues.'

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The author is a barrister practising at 5 Raymond Buildings, London, and the author of *The Law of Photography and Digital Images* (Sweet & Maxwell, forthcoming May 2004).

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¹⁵ Ibid at 554.

¹⁶ *Trade Marks Registry Works Manual*, Ch.6 para 9.11.3.

¹⁷ *Trade Marks Act 1994*, s.10(1).

¹⁸ *Trade Marks Act 1994*, s.10(2) and also by use of a sign similar to the trade mark on similar or identical goods for which the trade mark is registered.

¹⁹ *Trade Marks Act 1994*, s.10(3).

²⁰ Robert M. Kunstadt, F. Scott Kieff, and Robert G. Kramer, "Are Sports Moves Next in IP Law?," *National Law Journal*, May 20, 1996.

²¹ *Sieckmann v Deutsches Patent- und Markenamt (C273/00)* [2003] Ch 487; [2003] 3 WLR 424; [2003] ETMR 37; [2003] RPC 38.