



CHRIST
(DEEMED TO BE UNIVERSITY)
BANGALORE · INDIA

INTELLECTUAL PROPERTY RIGHTS COMMITTEE | SCHOOL OF LAW, CHRIST (DEEMED TO BE UNIVERSITY) |
SECOND EDITION 2021-21 | VOL-4

INTELLECTUALIS

Crossing the Finish line: IPR in Sports



INDEX

EDITORS' NOTE.....	3
GUEST LECTURE ON FILING OF TRADEMARKS REGISTRATION APPLICATION IN INDIA: PRACTICE AND PROCEDURE.....	4
IPR REWIND.....	15
IS COPYRIGHT THE MASTER CHIEF OF ESPORTS LAW?.....	16
BROADCASTING OF SPORTS EVENTS: AN IPR PERSPECTIVE	19
ANALYSING COPYRIGHT/TRADEMARK CASES RELATED TO SPORTS MERCHANDISING.....	23
PRIZED FIGHT! THE PAY-PER-VIEW MODEL AND THE PROBLEM OF COPYRIGHT INFRINGEMENT IN MIXED MARTIAL ARTS.....	27
CASE INGOTS	31
TRADE SECRETS AND INDUSTRIAL ESPIONAGE IN MOTORSPORT	32
THE ROLE OF TRADE SECRETS IN PROFESSIONAL SPORTS: AN ANALYSIS OF THE US LEGAL REGIME	35
IPR REWIND.....	39
COMMERCIALIZATION OF IP IN THE SPORTS INDUSTRY.....	40
COMMERCIALIZATION OF IP IN THE SPORTS INDUSTRY.....	44
.....	44
CAREFULLY LAUNCHED AMBUSH ATTACKS: TRAVERSING THROUGH SPORTS SPONSORSHIPS, AMBUSH MARKETING & IPR	45
ANALYZING THE ROLE OF PATENTS IN SPORTS.....	48
WHEN IPRs AND THE OLYMPICS OVERLAP: AN ANALYSIS	51
CASE INGOTS	55
UNDERSTANDING LICENSING IN THE WORLD OF SPORTS.....	56
THE INTERNATIONAL SCENARIO ON TRADEMARK PROTECTION OF SPORTS ASSOCIATIONS AND BRANDS	60
PERSONALITY RIGHTS IN SPORTS AND INTELLECTUAL PROPERTY	65

EDITORS' NOTE

Dear Readers,

We proudly present the second edition of Volume 4 of Intellectualis, with the theme 'Crossing the Finish Line: IPR in Sports'. With the Olympics, the various Champion Leagues and World Cups happening, the buzz around sports is on a high crest. Channeling some "moment marketing" of our own, we've compiled this issue to highlight the often overlooked tryst between IPR and Sports. In addition to various riveting articles on topics ranging from mixed martial arts to sports merchandising, this edition also features a report of an engaging guest lecture on Trademark Filing, with the illustrious Mr. Vijay Kumar Makyam. Other recurring features include short & exciting case summaries in the form of case ingots and a recap of recent events through IPR Rewind.

We hope that you take the time to read what our e-newsletter has to offer. We would like to extend our gratitude to the student body of School of Law, CHRIST (Deemed to be University) for their overwhelming response to the newsletter. We would also like to thank our Chairpersons, Dr. Avishek Chakraborty and Dr. Aradhana Satish Nair for constantly supporting us and guiding us through the drafting of this newsletter.

We hope you enjoy reading this Edition!

EDITORS

Nidhi Rachel Kurian

([linkedin.com/in/nidhi-rachel-kurian-7010b5198](https://www.linkedin.com/in/nidhi-rachel-kurian-7010b5198))

Pemmaraju Lakshmi Sravanti

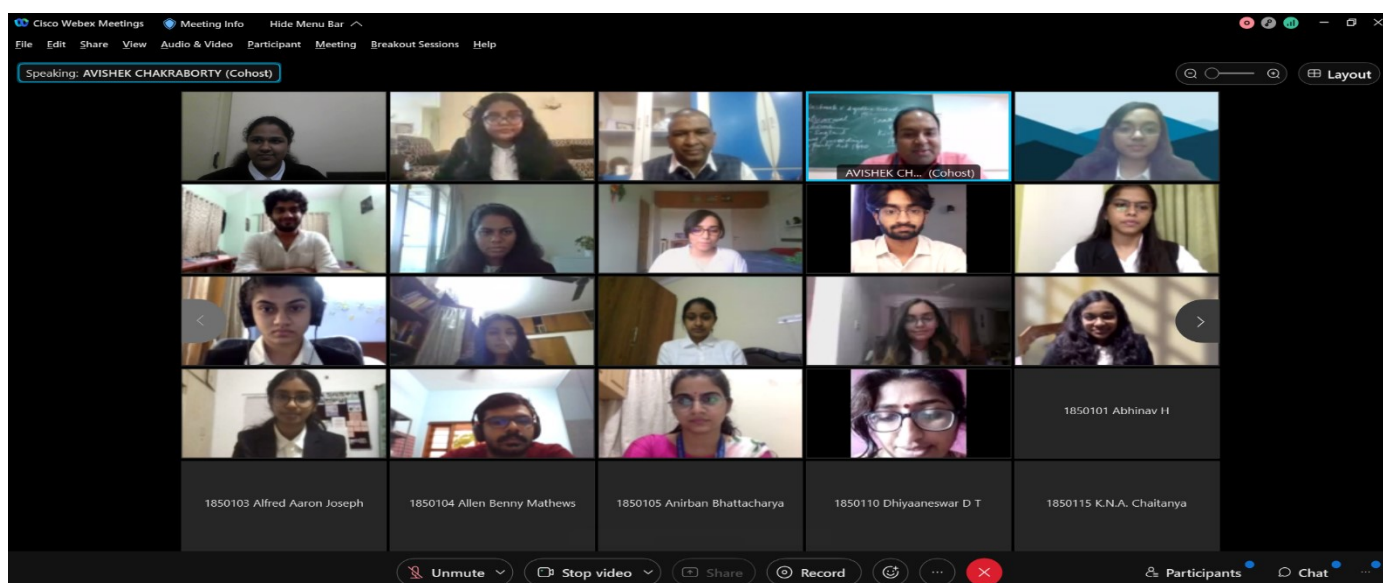
([linkedin.com/in/sravantipemmaraju-b78460166](https://www.linkedin.com/in/sravantipemmaraju-b78460166))

FACULTY CONVENERS

Dr. Aradhana Satish Nair, Dr. Avishek Chakraborty & Ms. Aditi Singh Kavia

GUEST LECTURE ON FILING OF TRADEMARKS REGISTRATION APPLICATION IN INDIA: PRACTICE AND PROCEDURE

- Report by Anjali Saran and Nachiket Jonnalagadda



The Intellectual Property Rights Committee commenced its Guest Lecture series with an online Webinar on “Filing of Trademarks Registration Application In India: Practice and Procedure on the 28th of October from 3:00 PM to 5:00 PM. It was an absolute delight to listen to Mr. Vijay Kumar Makyam, one of the most distinguished IP lawyers in the country, throw light on Trademark Law and all the other crucial aspects and intricacies associated with them. After graduating in law from Osmania University, Mr. Vijay Kumar has also pursued a diploma and an LLM from Osmania University

and National Law School Bangalore. In addition to being the founding member and partner of I-WIN IP services and IP Markets Hyderabad, Mr. Vijay has held several distinguished positions such as being the technical member of the trademarks at the Intellectual Property Rights Board. He has also been a member of the International Trademark Association, AIPPI and the Anti-Counterfeiting Committee.

Understanding Intellectual Property and Trademarks

Mr. Vijay began the webinar by mentioning the vast intricacies of trademarks by displaying a video that discussed many hidden meanings of famous logos such as Coca-Cola, BMW and Hyundai. To develop a better understanding of trademarks, the definition of property was discussed. There must be certain rights such as the right to lease, use, right to inherit, right to own, and so on must be associated with the object for it to be known as property. The speaker cited the example of a stone on the road to further illustrate this statement. There are two kinds of property: real estate, property like land and buildings attached to the earth, and personal property movable in nature. This includes vehicles, mobile phones, laptops etc.

Furthermore, there are two definitions of property. These are tangible and intangible properties. Tangible properties can be touched and felt, while intangible properties cannot be felt. Only its value can be perceived—for example, stocks. Intellectual Properties are a type of intangible property. For instance, if a person claims to have written a book, it can be touched and felt. So the question arises that the book, which is an intellectual property of the author, be recognized as an intangible object. Mr. Vijay clarifies this by stating that it is not the book that the author can claim as his intellectual property. However, instead, it is the said book's distribution and reproduction rights, which is

considered the author's intellectual property and not the physical copy of the book itself. Therefore the product made is not protected per se but rather the right to recreate the same.

Importance of Protecting Intellectual Property

Various theories or justifications speak about the importance of protecting one's intellectual property. the most prominent one is the "Labour Theory." This states that all labour that has been invested in creating a product must be rewarded and protected. Another prominent theory is the personality theory. This theory aims to protect the personality or personal element of a product. Certain products or creative works have the creator's element. An example provided was Ram Gopal Varma, a famous film director whose projects are usually in crime or romance. Therefore such films are associated with him. This personal element is protected under copyright law.

The knowledge-based economy was referred to understand the necessity of the protection of copyrights and trademarks. The world has moved from a natural-resource based economy to a knowledge-based economy. A natural resource economy is an economy that focuses on the accumulation of natural resources.

On the other hand, a knowledge-based economy is a type of economy that focuses on knowledge

primarily from patents and copyrights over technology and creative works. This transition occurred due to western influence. It is pertinent to note that Intellectual property is nothing new in India. It has been embedded into our culture and traditions for an extended period. India had eventually signed the TRIPS agreement, which promoted the use and protection of Intellectual Property.

Functions & Types of Trademarks

The Speaker explained the functions of Trademarks in detail. The primary function of a trademark is to differentiate one product from another in a market. For example, a soap manufacturer like Lux or Cinthol has a trademark that distinguishes it from other brands without any confusion. If such confusion persists, it is not an effective trademark. The second function of a trademark is to identify the source of the product. For example, one can distinguish between the quality of different brands of shoes with the help of a trademark.

The session then proceeded with the different types of trademarks- conventional and non-conventional. Conventional trademarks refer to trademarks such as logos like the golden arches of Mc Donalds, brand names like Nike and Mercedes Benz and slogans and phrases like “Just do it” of Nike etc. Unconventional trademarks refer to not very common trademarks, such as

scents, taste, sound, etc. The best example is the Harley Davidson motor vehicles exhaust sound, which has been trademarked as some malfunctioning motorcycles produce a similar sound. Chemical names such as Paracetamol and COVID cannot be registered as trademarks

The purpose of trademark law is to regulate trademarks and cut down on anti-competitive practices adopted by qualified traders to avoid consumer deception, provide remedy in case of a violation, and register a trademark. The law in India is governed by international treaties and conventions and local laws. The speaker referred to the Paris convention of 1883, the Nice classification, TRIPS agreement, the Vienna classification for figurative elements and the Madrid Protocol.

In India, trademarks were initially protected under the Registration Act of 1909; trademark law was first enacted in 1940. It was replaced by the Trade and Merchantile Act 1958 after a report made by Dr. Rajagopalachari. After the TRIPS agreement was signed in 1995, India opted for new legislation, the Trademark Act of 1999. A common mistake made is making the trademark descriptive at the time of registering a trademark. This is mentioned under section 9 of the Trademark Act. If a product is descriptive, it violates the freedom of speech and expression of a person. In addition to this, the trademark cannot be obscene or prohibited by law, for example

naming liquor after deities. A trademark, once registered, is valid for ten years, and upon the end of this tenure, it can be renewed.

Trademark Registration Applications

In the next segment of the seminar, the application of trademarks was discussed. Certain conditions must be fulfilled to register a trademark. There are two types of applications. These are based on the use in commerce and the proposed use of the trademark. A notarized affidavit is required for the former.

In contrast, no such affidavit is required for the latter while applying for a trademark. Trademarks have been divided into 45 classes—1 to 34 trademarks for products while 35 to 45 for services. The same name or mark is available for different types of classes. It is not restricted to a particular class after registration. This classification was first introduced in the city of Nice in France. Therefore, this classification is known as the Nice classification. India expanded their trademarks by including service marks upon signing the TRIPS agreement.

The session then proceeded with a brief on the different types of trademarks. In the case of *Abercrombie and Fitch v Hunting World Inc*, Justice Henley established the different types of trademarks. According to Justice Henley, if any term that is not mentioned in the English dictionary is used to describe a product is called a

distinctive mark which shall be protected under copyright law. If a word in the dictionary but is used to denote a different product rather than its definition (for example, apple being used for electronics instead of fruits) is considered an arbitrary mark and shall also be protected under copyright law.

Another type of trademark is a suggestive mark. These are trademarks that require a certain amount of comprehension to decipher their meaning. An example of Infosys, derived from two words, “Information” and “Systems” was cited. These marks are considered to be distinctive and shall be protected under copyright law. Descriptive marks, which describe the product, cannot be registered unless proven. Such a description attributes as a distinguishing factor and acquires a secondary meaning. Well-known names and domain names are also protected under copyright law. It has also recently been seen that ICAN offers domain names to distinguish it from generic domain names such as .com..net, etc. (ad works)

Another type of trademark discussed is associated trademarks. These are trademarks that have the same registration or name for a multitude of products. Certification trademarks are marks that are given to people who fulfil a specific condition. An example of this would be ISI mark, Agmark and so on. The final type of trademark is a collective mark. These types of marks are

registered by a group of people or an industry in its entirety.

Acquiring a Trademark

The speaker then proceeded to address the two methods acquisition of trademark. The first is by associating the mark to the product or service. This automatically provides common law rights recognized under section 27 and section 134 of the Trademark Act. Furthermore, Section 28 protects rights given to a registered trademark, while section 29 talks about the infringement of trademarks. Section 31 states that if a person uses a mark before registration, they cannot be sued for infringement and are exempted under the Act. India being a large sub-continent, if two people use the same trademark, there is a very slim chance that either party could sue one another for trademark infringement. Section 12 of the Act provides for a clause that mentions fair and concurrent use of the trademark to prevent such a scenario. This only applies in the scenario mentioned above if either party is unaware of a similar trademark being used. If there has been prior knowledge, this clause cannot be invoked. Trademarks, irrespective of being registered or not, can be used. For trademarks that are not registered, the symbol “TM” is to be used. If the mark is registered, the symbol “R” is to be used. This to negate the common myth that trademarks cannot be used without registration.

When a trademark application is filed, it is mandated by law to use the symbol consistently everywhere. There shall be no protection offered if the trademark usage is found to be inconsistent. The trademark must be an adverb. If any other form such as the noun or verb form is used, the mark becomes a generic mark. The best example is Xerox, which has become a generic mark. People used the term Xerox to denote printing instead of referring to the Xerox machine itself. The mark must also be policed online as well as offline. This means that the owner of the mark is responsible for ensuring that no other person uses the trademark that has been registered. If there is no policing that occurs, then no protection shall be granted to the same mark.

Procedure of Filing an Application for Registration and Tackling Subsequent Problems

The final leg of the webinar focused on the procedure of filing a trademark application. Upon filing the trademark application, the application shall be scrutinized and any figurative element its classification according to the Vienna classifications. Then it is sent for examination where its validity under section 9 and section 11 of the Trademark Act is determined. Then the applicant must wait for four months in case any objections regarding the trademark arise as per section 21 of the Trademark Act. Once the notice

is filed, a counter-statement must be filed to the Trademark Office. This must be supported by the evidence of opposition under rule 44 through rule 47. If there are any objections, they can be raised and must be answered within one month. If the reply is not satisfactory, a hearing shall be called, overseen by the registrar. It must be noted that the registrar's decision is not final; it can be contested under section 91.

In case registration has been refused, the applicant can appeal it to the High Court. However, if accepted, the trademark shall be published in the journal. The aggrieved party can file a complaint to the High Court to rectify the mark. Any contribution or failure to observe the register is one of the grounds to remove the mark from the registry. Any error or defect in the mark can also be considered grounds to remove it from the registry. Under trademark law, the owner is provided with the exclusive right of the trademark. Section 31 mentions certain exemptions. These include bonafide use of place and name. The Trademark Act does not recognize counterfeiting marks.

The speaker also spoke about the concept of trademark search, which is done every three months to identify whether other parties have created similar marks. If any similarities are found, the parties must be notified of the same. This search must be done on every possible

database. An individual must look for any trademark of similar shape, name, corrupted names, visual equivalents. Once an application is filed, a formality check is issued. The application can also be amended two times, that is, before and after registration. Another video was displayed explaining that if there is a strong law in place, the deceptive similarity cases of trademarks can be easily tackled.

Furthermore, Mr. Vijay provided various examples of deceptively similar trademarks and the court's verdict in these cases. An illustration cited was that of Coronil. Patanjali adopted the name Coronil; however, another product of the same name has been in use since 1993 by the plaintiff. This was a registered trademark. However, the court held that the plaintiff registered the logo mark and not the word mark so Patanjali could use Coronil. So the registration of both word and logo marks is necessary while registering or filing an application for a trademark.

Another example discussed was the case of *Daimler Benz Akitgesellschaft v Hybo Hindustan*. The defendant used a similar logo to that of the plaintiff for their product which was undergarments. The plaintiff brought a suit against the defendant as such use resulted in the dilution of the brand. However, another example is the similarity between the drug Falcogo and Falcitab, two drugs from different companies that

treated the same disease. The court, in this case, held that if the drug is to be treated for the same disease, this naming allowed; however, it cannot be allowed if either of the drugs were used to treat different conditions as it would mislead the consumer and pose a threat to their lives. The court began taking much consideration to determine whether certain trademarks are deceptively similar.

In *Syed Mohammed v Sulochana*, the court held that the prior user could stop a new user from using the trademark even if the new user were to register the mark. The registration of the law merely provides for rights to use the trademark. However, prior use of the mark is a principle established under common law, and this has precedence over the registration.

Finally, Mr. Vijay stated the remedies offered by the law to the aggrieved party whose trademark rights had been violated. The remedies include; injunctions, no further use of the trademark by the offender, damages or accounts of damages.

After Mr. Vijay Kumar enlightened the audience with his presentation, there was a Q&A session to engage with the audience. The audience dropped off questions in the chatbox, which Mr. Vijay answered. The questions were as follows:

1) Is there a special procedure required to make your trademark universal, or just registering

a trademark in your country's jurisdiction is enough to make it apply globally?

Ans: Mr. Kumar started his answer by pointing out that each country is a sovereign in itself. Therefore, there's no concept of a globally applicable Trademark or Global registration. So either a person can file for registration under the Paris System or they can file applications in each country individually. Furthermore, he stated that under the Madrid System of classification of trademarks, an international application can be made for the registration of a trademark and that one application can be used for filing a trademark registration in 90+ countries; however, the person will have to pay the fees for each country separately. When a Trademark is registered in India, it cannot be protected in other countries; however, some countries like India recognise trans-border reputation. When there is a brand that is globally renowned, then India may not offer that particular company's trademark to anyone in anticipation of the company coming to India, or the brand may itself stop the Indian office from giving away their trademark to others due to their popularity. He also talked about the case of *N.K. Dongre v. Whirlpool Corporation*, wherein trans-border reputation was recognized, and the Court granted an injunction order. However, in the *Toyota v. Prius* case, the Court held that unless the trademark has been used in India, the trademark will not be protected in India, even if it's an international brand. Therefore, no global registration exists. He also said

that if the trademark is a logo or an artwork, then under the Berne Convention, it is automatically protected in 164 countries, but as a Copyright and not as a Trademark, and that artwork cannot be reproduced.

2) If a common word is registered as a trademark, what is the relief available to the person who merely used it as a tag for a brand name?

Ans: Drawing an analogy from this question, Mr. Kumar spoke about the famous case of *Cadila Healthcare Ltd. v. Gujarat Co-operative Milk Marketing Federation Ltd.*, wherein the term 'Sugar-free', used by the petitioners for their popular product, was also being used by Gujarat Fertilizers for their product. Cadila Healthcare asked the defendants to use other words like 'no sugar' or 'less sugar', but it was in vain. Ultimately, the case went to the Supreme Court, where the Court held that if a particular organization has adopted a descriptive term to be used as their trademark, then they should be tolerant enough to let it be used in other classes. He also suggested that if the person does not agree to the same, he can either file for Rectification before the Registrar or file an infringement suit before the High Court to cancel it.

3) How can the shape of an object be successfully protected under the Trademarks Act?

Ans: For this question, Mr. Kumar stated that the definition of a trademark under Section 2(1)(zb) of

the Act itself protects things that are not only graphically represented, including the shape of the product. For example, if a person wants to protect the shape of a bottle for his/her product, then they can file an application for the same. He went ahead to give the example of the famous trademark of a bottle, which belongs to Coca-Cola. He also pointed out how earlier, every 14 years, the bottle design had to be changed or registered till the company decided to get a trademark for the shape. Therefore, shapes are protected under the Act. However, if that shape is technically required to make a product, then the application may be rejected.

4) Can a suit for infringement of intellectual property rights be filed after submitting a mere application to the Registrar? Which approach do Indian Courts employ? Is it a registration approach or an application approach while adjudicating a trademark infringement suit?

Ans: Mr. Kumar, as his answer to the first half of the question, noted that until a trademark has been registered, an infringement suit cannot be filed, however, a passing off suit may be filed under section 134 for an unregistered trademark. For filing an infringement suit, a right on the trademark has to be acquired under section 28.

For the second part of the question, Mr. Kumar answered that if a trademark is unregistered or is a pending application, then a passing off suit will be filed, and if the trademark is registered, then an

infringement suit can be filed. Sometimes, a combination of a passing off suit and an infringement suit may be filed when applicants state their trademark has been used. Infringement because the exact mark has been used, and passing off because the exact same design, logo, and style have been used, with changes in the name.

5) If there has been an unintentional abandonment of a trademark, what remedy is available to the proprietor of the trademark? Does the word go in the public domain?

Ans: Mr. Kumar answered this question by stating that the Trademark Registry faces this situation every year, wherein trademarks have been abandoned and a new application has to be filed in their stead. However, in 2017, about 2 lakh odd applications were abandoned for not filing a response to the examination report. At that point, a petition was filed in Court, where the petitioner stated that there is no surety of the objection letter being delivered to them, in the absence of which, they presume that their trademark has been accepted. This is a violation of the principles of natural justice which stipulates that they receive a fair chance of presenting their side. A show cause hearing must be called for and if the person does not appear for it, then his mark may be abandoned. This judgment led to all the abandoned trademarks being restored. Therefore in case of unintentional abandonment, a show-cause notice will be given to give an opportunity of hearing to the parties after which it may be restored.

6) Can a proprietor protect their trademark by registering it before they start using the trademark?

Ans: Mr. Kumar answered this question in the affirmative. As pointed out in his presentation, There are two kinds of applications, Used and Proposed to be Used. Even if a person wants to start an entity, they can get the name registered. If the registration is filed before the commencement of a business, the person has to file a Statement of Use in the US. In India, however, a period of five years is given to use the trademark. If the business has not commenced in those five years, then somebody interested in the same mark can file for a rectification application, get the mark cancelled in the proprietor's name and register it in their name. Therefore, the time frame in India is five years. Further, if a person is the promoter or Director of a company, they can file a trademark under their personal name, and once the company starts, they can get it transferred to the company's name.

7) In an action for infringement, can the infringer rely on the defence that there are other infringers of the proprietor's trademark?

Ans: Mr. Kumar answered this question in the negative. He further explained his stance through an illustration where he said that, if ten people are committing an illegal activity like murder, then the eleventh person cannot use this as an excuse to escape punishment. It is not a valid defence. Therefore, if ten

people are infringing a trademark, the eleventh person will also be an infringer. Such a defence cannot be taken and cannot free the defaulter from liability.

8) In what ways would you say that the trademark registration process of India has an edge or is different from the trademark registration process in foreign jurisdictions?

Ans: Mr. Kumar answered this question by stating that the laws have been harmonized worldwide after the TRIPS agreement. They are not very different from one another. For example, in India, a time frame of four months is given as an opposition period, while in the US, only one month is given, and in another country, it could be another time frame. However, the process is the same; from making an application, to its examination, its publication, proposition, and registration.

9) Sometimes smaller companies register a logo that is deceptively similar to another larger company, but it never gets detected because it is of a much smaller reputation and in another country. Will it still be considered Trademark infringement if they are never prosecuted?

Ans: Mr. Kumar answered that it wouldn't be considered as an infringement because, under Section 12 of the Act, Honest and Concurrent Use of a trademark is also allowed. Mr. Kumar also went on to give an example of a case which he had himself handled. A trader in Hyderabad had a trademark of

KLM Fashions, which stood for Kids, Ladies, Men Fashions and has been using it since 2014. All of a sudden, in 2019, a famous shopping mall came up with a brand called Keep Loving More, KLM Fashions. When the latter advertised, it was a huge campaign, with newspapers covering a full page almost every day. The trader approached Mr. Kumar with his worries about trademark infringement on his part. If the bigger brand filed a case, then he may not be able to protect his brand, although he has been using it since 2014. He also said that although he hasn't registered the trademark since 2014, all the bills he paid and other receipts have been preserved by him under KLM Fashions. Mr. Kumar then managed to convince the trader to file a case against them. In the morning, a case was filed, in the afternoon, it was heard, and in the evening, an ex parte order passed. However, the other party approached them for negotiation and dropped the case. Ultimately, this trader got 20 lakhs for his KLM Fashions trademark, where earlier he couldn't even earn 2-3 lakhs properly in his full sales and has now changed his brand. The bigger KLM brand was also happy as they got a prior user right. In the end, Mr. Kumar opined that it does not matter whether a company is big or small, but rather what matters is if they have a legal right. If they do, then they should fight for it and never forsake it.

10) If India wants to Trademark certain fragrances, what will the procedure be from

determining the possibility of registration until it becomes a trademark?

Ans: Mr. Kumar pointed out that such a trademark will fall under the category of an unconventional trademark, which is not prevalent in India except for 1 or 2 sound marks that have been registered. Smell marks have not been registered so far. However, in the USA, they suggest that a person should instead file for chemical formulae used to get the smell/fragrance instead of filing for graphical representation. The chemical formulae can be submitted to the trademark registry to get the trademark registered.

11) Do you think India will benefit from continuing to use 'the First to Use method' or adopting 'the First to File' method in the future?

Ans: In India, it's always 'First to Use' because the smaller traders would not have registered their brands, whereas bigger companies like MNCs will register their brands thus stopping them from using that name. He also opined that 'First to Use' will always be prevalent in India. But, in the future, if the legislature comes up with legislation for making 'First to Register' compulsory, then a certain amount of time should be given to all the traders to register their trademarks.

12) Trademarks in India have a life of 10 years, whereas, in the USA, they are perpetual, i.e., they remain alive till the time consumers can

connect to the manufacturers of a product by seeing them. So, do you feel that even in India, such a practice should be introduced, considering renewing a trademark could increase costs and cause unnecessary trouble to their owners?

Ans: Mr. Kumar answered this question by disagreeing with the statement that trademarks in the USA are perpetual. In the US also, trademarks have to be renewed regularly. However, in comparison to India, in the US, along with fees for renewal, the person filing for renewal will also have to file for Statement of Use at the time of renewal. They have to file this affidavit in order to state that they want to use this mark for the product or service for which it has been registered, and unless the affidavit hasn't been filed, the mark will not be renewed in the US. In India, by just paying the renewal fee, the trademark is automatically renewed. Hence, he stated that India is in a better position than the USA. He also opined from his personal stand point that although the idea of a perpetual registration is good, still certain companies may not be requiring it as they shut down even before the lapse of the initial period of the trademark. Therefore, the registration has no use, and if the brands close soon, then the perpetuity has no meaning, and it will also not be available for others to use it. He concluded that renewal is necessary. He also added that in India, like the US, an affidavit should be filed for Statement of Use.

13) For a researcher who is seeking to get precise data on the number of applications pending, and the working of the Registrar, where can they look for authoritative sources?

Ans: Mr. Kumar answered this question by going to the ipindiaonline.gov.in site, and from there displaying how a person can discover information about trademarks such as the entire filing and registration process, the number of applications filed in a year, the number of applications awaiting examinations and the number of applications rejected as well. It also shows the number of applications registered in India to date. Also, an application can only be rejected on the grounds of Sections 9 & 11 of the Trademarks Act. The applicant can also demand

an explanation from the Registrar regarding the rejection of a trademark.

The vote of thanks delivered by Nidhi Rachel Kurian, Student Convenor, Intellectual Property Rights Committee, expressed the sincere gratitude of the School of Law to the esteemed guest, Mr. Vijay Kumar Makyam, for taking time from his busy schedule for this insightful session with the students. The Committee, through this Webinar series, aims to focus on the Fourth SDG goal of imparting quality education by raising awareness in the area of intellectual property law. By focusing on enlightening future lawyers in trademark filing and registration, the IPRC has contributed to the overall practical experience for student e-learning.

IPR REWIND

- October 13, 2021 - Microsoft-IPR Chair-GNLU-and DPIIT-IPR Chair webinar on “Traditional Knowledge as Intellectual Property: Opportunities and Challenges at the International Level.”
- October 14, 2021 - Webinar on Using Customs to Protect Your Intellectual Property conducted by The International Intellectual Property Law Association (IIPLA) .
- October 14, 2021 – Webinar on “Where to Start with Intellectual Property” conducted by Future Fashion Factory
- October 15, 2021 – Panel discussion on “Private International Law and Intellectual Property” conducted by The University of Sydney

IS COPYRIGHT THE MASTER CHIEF OF ESPORTS LAW?

- *Sanjana Rebecca*

Introduction

In recent years, e-sports as a distinct category has expanded the familiar threshold for sports and has invited discourse on its inclusion in the Olympics by the International Olympic Committee - the Global Association of International Sports Federations in July 2018. Although there is no consensus on the decision of such inclusion, the recognition of e-sports internationally, as separate from traditional sports necessitates a discussion on its regulationⁱ. On that note, e-sports can be defined as multiplayer online games that are played competitively by pro teams or pro players. The origins of competitive online gaming can be traced back to a Stamford student body Space Wars Tournament in 1972 and is recognized as the first ever e-sport eventⁱⁱ. From that point onwards, the popularity of e-sports has only spiked with the advent of FPS (first person shooter) games. Counter Strike Global Offensive introduced their exclusive pro-league tournament in 2015, notably referred to as the Global ESL Pro League which is deemed to be one of the most viewed tournaments even today. Video-games such as PUBG Mobile have returned with pro-tournaments featuring a prize pool exceeding crores and is a valid indicator that e-sports and pro-tournaments enjoy a certain level of popularity in

India. Other games such as FIFA 20, Counter Strike, Fortnite, Call of Duty, Valorant and DOTA have also found favour here.

Understanding Copyright implications for E-sports

Having said that, while regulations for e-sports law have garnered much attention, due to the nascent stage of its growth in India, there is scant jurisprudence for interpretation. However, opposed to general regulation, there appears to be much more clarity in the copyright landscape despite complexities in establishing ownership for the plethora of entities involved. For instance, there are a broad range of stakeholders, such as e-Gamers, game publishers, and organizers of eSports events particularly involved in protecting their copyright. The main sources of revenue generation in e-sports include advertising and sponsorshipsⁱⁱⁱ. As defined under Section 14 of The Copyright Act 1957, a copyright holder enjoys the exclusive right to produce, adapt, reproduce, publish, and perform an original literary, artistic, dramatic or musical work. Section 2(dd) of the Act also includes broadcasting rights as communication to the public and authorisation for broadcasting such work must be

taken from the copyright owner. In the instant case, the gaming company or the game developer that produced the online game are entitled to the benefits under Copyright law as the first owners of copyright. The Act also defines exclusive licence as a licence which confers on the licensee or on the licensee and persons authorised by him, to the exclusion of all other persons (including the owner of the copyright), any right comprising the copyright of a work. Esports contracts generally entail exclusive licensing deals with broadcasters and streaming services to publish and display pro-tournaments to the public. Agencies representing pro-players engage in sponsorships and endorsements ranging from game-related merchandise to PC and tech-accessories related to improving game performance. Tournament organizers and associated partners need to ensure that they have acquired rights from the game developers and are authorised or licenced to carry out large-scale events or tournaments to prevent themselves from being at the receiving end of potential lawsuits. For instance, Riot Games owns the licenses, trademarks and copyright over its games League of Legends Valorant. Riot's Terms and Use agreement permits free fan projects (protected as 'fair use') if they are non-commercial and prohibits any commercial projects without a licensing agreement with them. However, it also clearly lays down exceptions for ad revenue generated from streaming platforms by players and streamers, personal donations and subscription-based content while live streaming

games. While Riot's IP team welcomes streaming and promoting gameplay, there is a limitation on organizing tournaments without acquiring prior authorization from Riot's team^{iv}. In 2021, Riot collaborated with tournament partners Red bull and Secret Lab in organizing the Valorant Champion Tour, a global e-sports tournament. For the VCT 2021 tournament, Riot Games Europe Team struck licensing deals with multiple streaming partners including but not limited to Freaks 4U Gaming, Pro Gaming Italia & SPORTFIVE in Europe^v.

As a result, a well-defined IP strategy is a prerequisite for game developers and promoters that have put down time and effort in programming, source code development, artwork and graphic design, among many other things, that are protected by copyright law. Besides, it is pertinent to note that unlike traditional sports, the central IP protection is in the game itself. Copyright law is the most essential form of protection for online video games. Software and source code of a game is subject to protection under Section 2(n)(o) of the Copyright Act, 1957 i.e literary works which include computer programmes. The artwork and in-game skins can be protected under Section 2(c) of the Act which deals with protection for artistic works. Additionally, in-game music and sounds are protected as sound recordings or a musical work. According to the *scénés á faire* doctrine, copyright law does not protect "a scene that must be done", therefore certain essential elements of a game,

for instance, in an online interactive football game, a football, net and a goalkeeper are prerequisites for the creation of the specific game and therefore is not entitled to protection. In a recent case, PUBG Corp, the developer of Player Unknown's Battlegrounds ("PUBG"), sued NetEase, Inc. in the United States federal court in the April of 2018 for copyright infringement, unfair competition, and trade dress infringement, alleging that Knives Out ("KO") and Rules of Survival ("ROS") were illegal clones of PUBG and copied certain key elements from PUBG's game design. PUBG contended that the merger doctrine (where an idea merges with the expression) was inapplicable to its case as it was not seeking 'to monopolize the popular 'battle royale' genre of video games,' instead, it sought to protect its creative expression of unique and distinctive elements within its game^{vi}.

Therefore, the importance of copyright law can be demonstrated by distinguishing protectable elements from its unprotected counterparts. Performer's rights

for esports players happens to be an unexplored realm in copyright law and leaves behind a trail of questions in its understanding. It is understood that copyright holders have the exclusive right to perform their works. But the question of whether duplicating/copying a pro-player's play style in an e-sport tournament violates one's right to perform remains unanswered.^{vii}

Conclusion

The varied stakeholders in e-sports law are often faced with the challenges of protecting their rights, especially with bans on competitive online games. In the absence of proper guidelines or jurisprudence on the subject, there is an abundance of grey areas in the online gaming industry. While conventional tools of protection might suffice for India as it still happens to be in its initial stage, the future might require comprehensive reforms in the esports arena. But for now, copyright protection seems to hold the superior key to e-sports law.

ⁱ Stuti Srivastava, "Regulating E-sports - an opportunity and a challenge"(RSRR, 5 Jul 2021) <<http://rsrr.in/2019/07/05/regulating-e-sports-an-opportunity-and-a-challenge/>> Accessed 21st November 2021.

ⁱⁱ Bountie Gaming, "The History and Evolution of Esports" (*Bountie*, 3 Jan 2018) <<https://bountiegaming.medium.com/the-history-and-evolution-of-esports-8ab6c1cf3257>> Accessed 21st November 2021.

ⁱⁱⁱ Essenese Obhan & Mehak Dhingra, "Get Your Game On: ESports And IP In India" (*Mondaq*, 7 Oct 2020) <<https://www.mondaq.com/india/trademark/992058/get-your-game-on-esports-and-ip-in-india>> Accessed 21st November 2021.

^{iv} Read More at <https://www.riotgames.com/en/legal>

^v Henrieta Hyrliková, "Riot Games announces several partnerships for VALORANT Champions Tour" (*Esports Insider*, 17 Feb 2021)

<<https://www.esportsinsider.com/2021/02/riot-partnerships-regions/>> Accessed 21st November 2021.

^{vi} Mc Arthur Law Firm. PUBG & NETEASE SETTLE “BATTLE ROYALE” COPYRIGHT LAWSUIT, (*SMC Arthur Law*, 24 Mar 2019) <<https://smcarthurlaw.com/pubg-netease-settle-battle-royale-copyright-lawsuit/>> Accessed 21st November 2021

^{vii} Abanti Bose, "Highlighting the complex relationship of Esports and intellectual property rights" (*Ipleaders*, 21 Jul 2021) <<https://blog.ipleaders.in/highlighting-complex-relationship-esports-intellectual-property-rights/>> Accessed 21st November 2021.

BROADCASTING OF SPORTS EVENTS: AN IPR PERSPECTIVE

- *Athul Vijay*

Introduction

Sporting events have been a major source of entertainment for a majority of the populace since time immemorial. As technology has evolved, the ways in which people started to view sporting events also evolved with it. Earlier, the broadcasting of sporting events was confined to the television, wherein the event would be broadcasted live or recorded, to television screens of each household. Today, with the rise of the internet and OTT platforms, broadcasting has grown at an unprecedented rate as sports events can be streamed live from a computer or a smartphone via the internet. With the growth in the avenues of broadcasting, the Intellectual Property Rights involved in broadcasting such events must be considered.

Sports organizations earn royalties from the distribution of broadcasting rights making it a recurring source of money. Huge amounts of money are paid by media corporations to obtain the necessary license for broadcasting events. FIFA is an international organization that acts as the governing body for sports related to football which includes foosball, soccer and beach soccerⁱ. One of the flagship sports events organized by FIFA is the FIFA World Cup. In 2019, FIFA had earned almost 342.6 million U.S. dollars via broadcastingⁱⁱ. Broadcasting has thus grown to be an extremely important source of revenue for major sporting events which provide sporting organizations with a strong incentive to invest heavily into their events, making them a grand spectacle to appease the huge number of fans watching them.

Surpassing the total monetary gain available through ticket sales, the broadcasting of sporting events has become an extremely important and irreplaceable source of revenue in multiple sports. As a result of the visibility that broadcasting offers, other revenue streams, such as stadium advertising, corporate sponsorships, and naming rights, become more valuable.

Broadcasting Rights and IPR

The rights of broadcasters protect the investments that they have made in broadcasting sporting events wherein they will be entitled to any monetary rewards that can arise in the form of profits. The exclusive rights of broadcasters have been elaborated in the Rome Convention of 1961ⁱⁱⁱ. The Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations provides for a period of 20 years for any form of rebroadcasting, recording of the event and any form of communication to the masses. The organization responsible for holding the event may also run advertisements in order to gain additional revenue but such a display can only be done after receiving the express permission of the copyright holder^{iv}. Thus, the monetary rights of the corporations involved in broadcasting sporting events are secure.

The rise of live streaming is another avenue through which broadcasters gain their revenue. Copyright is

maintained by the organization hosting the event that is being live-streamed. E-Sports events are heavily dependent on the live streaming platform for their revenue^v. Various brands include their ads within the live-stream itself in addition to having banners within the stadiums promoting the product within the event itself thus leading to huge amounts of revenue. A system of paid-service can be used to eliminate the advertisements run by the OTT streaming services which is present in services such as Hotstar^{vi}, wherein a paid subscription would eliminate advertisements from the platform but not those within the live-stream itself. This is in contrast to how advertisements are run on television wherein the advertisements provided by the channel cannot be eliminated.

In India, broadcasting rights were not recognized by the Copyright Act of 1957 until the 1994 amendment wherein Section 33 was introduced for issuing licenses for copyrighted works^{vii}. The sports broadcasting industry accounts for a whopping 1.1 billion dollars of revenue in 2019^{viii}. The Indian sports broadcasting market includes various sports such as kabaddi, football, tennis, badminton etc. of which the major players are cricket and football. Some of the major sports broadcasting companies in India are Star Sports, Sony India and other OTT platforms. The corporations that own TV channels and/or OTT platforms are granted proper license from the event organizers to distribute their content. Government control over broadcasting and also on

broadcasting rights is an important aspect that was dealt with in the *Secretary, Ministry of Information & Broadcasting vs. Cricket Association of Bengal case*^{ix}. In this case, the Supreme Court had quashed the contention that the government could not have a monopoly over any form of broadcasting and that it will be able to restrict such broadcasting under Article 19 of the Constitution only if the material in question is in violation of the article.

The Government was not to have a monopoly on broadcasting as the air waves were declared to be public property. This allowed for the entry of private players in the broadcasting business, thus leading to the rise of channels such as Star and Sony that broadcast most of the sporting events within and outside the country. Doordarshan, is a public owned broadcasting company managed by the Government of India^x. It is one of the major government owned broadcasting channels as well as a major player in broadcasting sporting events within India and abroad.

Recent Issues in Broadcasting Rights

With the rise of OTT platforms and online live streaming gaining traction, it opens up a plethora of issues ranging from piracy to re-transmission. Re-transmission occurs when copyrighted live feed is being streamed by a third party at the same time without the permission of the copyright owner. Advancements in technology have allowed almost everyone with a laptop or a smartphone to engage in

piracy by either downloading the copyrighted material or through screen recording. An injunction against unauthorized streaming was given in the *Football Association Premier League Ltd v. BT*^{xi} case wherein internet service providers were ordered to block any sites engaging in unauthorized streaming of the English Premier League. A similar decision was laid down in the *Matchroom Boxing Ltd and Others v. British Telecommunications Plc*^{xii}. case wherein some websites were found to be infringing upon the copyright of the boxing matches which were organized by the plaintiff. The Court had issued an order to take down the sites which were found to be liable of such infringement.

The Internet is an extremely vast entity and thus its scope extends to a huge extent. Owing to its vastness, streaming copyrighted sporting events have become extremely easy owing to easy access to recording technologies. The rise of online streaming has seen an increase in such activities wherein identifying the perpetrators becomes a tedious task as anonymity is a perk offered by the internet. Copyright holders of sports events depend on national legislation to provide them with the adequate protection needed to set out towards funding such endeavors. But at an international level, legislation is still inadequate especially in the issue of signal piracy^{xiii} and streaming. Sports organizations use various forms of media to promote and stream their content and adequate protection on an international level is

required owing to the reach of the internet. Accounting such factors will be able to mitigate losses to the copyright holders by a huge margin.

Conclusion

Broadcasting rights are an extremely important part of copyright law. A major incentive for seeking protection through copyright is to protect one's financial interests. In this case, it is the financial gain

that drives sports organizations to host events that entertain millions of people. The lack of protection offered to such institutions may result in them facing losses in organizing such events which may lead to them losing interest in investing money in them. Thus, cementing broadcasting rights is an important issue which has to adapt to the changing nature of media and technology.

ⁱ 'What is FIFA?' (BUSINESS STANDARD)
<<https://www.business-standard.com/about/what-is-fifa#collapse>> accessed 18th October 2021.

ⁱⁱ David Lange, 'FIFA: revenue from television broadcasting rights 2003-2019' (STATISTA, Nov 26th 2020)
<<https://www.statista.com/statistics/268833/revenue-from-television-broadcasting-rights-of-fifa/>>
accessed 18th October 2021

ⁱⁱⁱ International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, 1961.

^{iv} Askan Deutsch, 'Sports Broadcasting and Virtual Advertising: Defining the Limits of Copyright Law and the Law of Unfair Competition' (MARQUETTE SPORTS LAW REVIEW, 2000)
<<http://scholarship.law.marquette.edu/sportslaw/vol11/iss1>> accessed 18th October 2021.

^v Juho Hamari Max Sjöblom, 'What is Esports and why do people watch it?', INSTITUTIONAL REPOSITORY OF TAMPERE UNIVERSITY,

2013)<<https://core.ac.uk/download/pdf/250147191.pdf>> accessed 18th November 2021.

^{vi} Vaishali Tripathi, 'ICC T20 World Cup 2021 Advertising on Hotstar: A Complete Guide' (THE MEDIA ANT, September 1, 2021).
<<https://blog.themediaant.com/icc-t20-world-cup-2021-advertising-on-hotstar-a-complete-guide>>
accessed 18th October 2021.

^{vii} Tanvi Sapra, 'Rights of Broadcasting Organizations and of performers under the Copyright Act' 1957 (LAW CIRCA, 20th December 2020) <<https://lawcirca.com/rights-of-broadcasting-organizations-and-of-performers-under-the-copyright-act-1957/>> accessed 18th October 2021.

^{viii} Saumya Tewari, 'Sports Rights in India expected to touch \$1.3 billion by 2024' (LIVE LAW, 6th March 2020)
<<https://www.livemint.com/industry/advertising/sports-rights-in-india-expected-to-touch-1-3-bn-by->

2024-11583490221074.html> accessed 19th October 2021.

^{ix} Secretary, Ministry of Info. & Broad. v. Cricket Association of Bengal, (1995) 2 S.C.C. 161, 224

^x Kamat, Payal, ‘Short essay on Development of Television in India’ (PRESERVE ARTICLES, 18 January 2012)

<<https://www.preservearticles.com/short-essays/short-essay-on-development-of-television-in-india/18825>> accessed 19th October 2021.

^{xi} The Football Association Premier League Ltd v British Telecommunications plc & Ors [2017] EWCH 480 (CH).

^{xii} Matchroom Boxing Ltd and another v British Telecommunications plc and others [2020] EWHC 2868 (CH).

^{xiii} ‘Broadcasting & Media Rights in Sport, Sports & IP’ (WIPO) <<https://www.wipo.int/ip-sport/en/broadcasting.html>> accessed 19th October 2021.

ANALYSING COPYRIGHT/TRADEMARK CASES RELATED TO SPORTS MERCHANDISING

- *Anjali Baskar*

Introduction

Merchandise and licensing has always been a major part of all aspects of the entertainment industry, including sports. When the term “sports merchandising” comes to mind, people often automatically think of their favourite teams across sports, like the Chennai Super Kings, Chelsea FC or the New York Yankees. There is merchandise being released even for fictional sports teams.ⁱ In a sports merchandising agreement, popular players are associated with apparel making brands, and come up with an agreement to use character merchandising

rights and produce merchandise with their names on them. For instance, a jersey with their name and player number. The licensor generates revenue from allowing the usage of this merchandise, along with additional publicity and endorsement.

Despite the rising commercialisation of sporting teams, most manufacturers and suppliers faced losses during the pandemic.ⁱⁱ The Indian sports endorsement industry catapulted in 2001, when Sachin Tendulkar was able to score a 100 crore branding dealⁱⁱⁱ, but as the field grows, intellectual property lawsuits keep

growing, especially with the aggressive advertising and endorsement of sports in the digital sphere^{iv}. There are rampant instances of copyright and trademark infringement, where people try to replicate the original and sell them online, thus receiving unjust enrichment from someone else's work.

Evolution of Merchandising Rights

Merchandising problems existed as far back as in the 1980s in the USA, because existing legal remedies didn't cause much deterrence^v. Getting ex-parte orders to seize the infringing apparel without notice were difficult under the due process of law. Even if a notice was given, the person committing infringement would just disappear with the goods by the time any order could be passed. Further, federal prosecutors were also unable to act on "John Doe" complaints because the standard of evidence was higher than what could be actually gotten in reality. Relief for damages were available, but only upon showing the sales earned by the defendant indicating a non-negligible amount of unlawful profits. Some courts also required the plaintiff to show that there is a likelihood of the public associating or confusing the defendant's mark with the plaintiff's mark.^{vi} Other courts interpreted trademark infringement to mean tarnishing or dilution of the plaintiff's reputation and the mark thereof^{vii}.

Evolution of Trademark Infringement

There was a case before the European Court of Justice^{viii}, which related to an Arsenal fan selling club merchandise, like shirts, scarves and hats, with the plaintiff's trademark "Gunnars", including the logo and the club's distinct emblem. On appeal, Arsenal was successful in proving trademark infringement, as the fan sold the merchandise to the public, claiming that it was genuinely Arsenal's products. This gave clubs a lot more confidence to aggressively file suits against these kinds of infringement.^{ix} This included even university sports teams, for example, the University of Alabama brought a lawsuit against an artist for violating trademark rights. They claimed that the artist did this by depicting the colours and uniforms of their team.^x Thus, US trademark law established a general rule that trademarks were also protected against consumer confusion^{xi} in a stronger light in the 2000s than decades earlier.

A landmark case in the US laid down a 6-step criteria to assess whether a sports-wear company in Texas manufactured jerseys which were almost identical in terms of the blue and yellow colour scheme of the Seattle Seahawks, infringing NFL Properties' trademark. This case also held that disclaimers^{xii} stating that the jerseys were not officially from the original club are invalid, if it is placed in hardly visible areas where people may not notice it, like on the backs of labels.^{xiii} This case also added on to *International Order of Job's Daughters v. Lindeburg & Co.*^{xiv}, stating that not only is an emblem or name

of a trademark its functional component, but it also acts as a secondary trademark independent from the original trademark as a whole. An interesting case also emerged in the US with respect to T-shirts being made using the colour scheme of several universities and their sports teams. Even though this merchandise did not name the universities, it was proven that they combined their colour schemes using identifiable indirect references to them, like referring to their bowl championships. Thus, the court used a stricter approach to make people cautious about using certain elements of a trademark (eg: names of players or their numbers on merchandise) for apparel without authorisation that may be associated with another mark. A court established that Nike's "two-stripe" design did not infringe upon Adidas' "three-stripe" trademark.^{xv} In 2018, BCCI was successful in prohibiting Grace India Sports Ltd. from using the trademark "IPL" and its related logo in their merchandise.^{xvi}

Position under Copyright Law

In sports merchandising, copyright is used mostly for protecting the artistic value of the design or brand. Copyrights exist in various aspects of sporting events, like the artwork related to the logos in apparel and images of a sportsperson. The US Supreme Court in *Star Athletica L.L.C. v. Varsity Brands, Inc.*^{xvii}, stated that 2 conditions need to be fulfilled for a feature of an article (like a logo) to be protected by copyright law: "1. It must be perceived as a 2-D or 3-D artwork

piece separate from the useful article; 2. It should qualify as a protectable pictorial, graphic, or sculptural work, either on its own or fixed in some tangible medium of expression, if it were imagined separately from the useful article into which it is incorporated." The court in this case held that even though the designs on the Varsity Brands uniforms could not be separated from the article or had any function attached to it, they were still entitled to copyright protection, thus reiterating the fact that copyrights do not need to be for utility purposes, and can just exist for aesthetic value^{xviii}. California law is more stricter when it comes to copyright infringement, and states that any person who violates copyright in merchandise, goods, products, etc. can attract injunctions and heavier damages.^{xix}

Conclusion

With the advancement of technology, people are able to escape infringement much easier, with pirated sites selling duplicate merch, from different servers and across different jurisdictions.^{xx} In recent developments, there have been instances of even fantasy sports clubs filing lawsuits for trademark and copyright infringement against people.^{xxi} Some have even argued that trademark suits should be filed with a higher standard of proof.^{xxii} One way to curb these instances of infringement can be to impose heavy fines along with imprisonment, and in rare cases, even allow for criminal remedies under the Trademarks Act, 1999 and the Copyright Act, 1957.

ⁱ Michael Walsh, 'Ted Lasso Launches Official Merch Store' (*Nerdist*, 21 June 2021) <<https://nerdist.com/article/warner-bros-ted-lasso-afc-richmond-official-merchandise-store/>> accessed 21st October, 2021.

ⁱⁱ Cara Salpini, 'What 2021 means for sports marketing — and how Foot Locker's approaching it now' (*Retail Dive*, 3 Feb 2021) <<https://www.retaildive.com/news/what-2021-means-for-sports-marketing-and-how-foot-lockers-approaching-it/594244/>> accessed 22nd October 2021.

ⁱⁱⁱ Vivek Kamath, 'How Mark Mascarenhas Redefined Celebrity Management' (*Forbes*, 2 July 2021) <<https://www.forbesindia.com/article/2013-celebrity-100/how-mark-mascarenhas-redefined-celebrity-management/36751/1>> accessed 21st October 2021.

^{iv} Mario Lukinovic and Ana Opacic and Irena Milojevic, 'Legal Aspects of Merchandising in Sports' (2020) ODITOR 63.

^v Paul D Supnik, 'Diluting the Counterfeiters: New Trademark Rights and Remedies in Dealing with Entertainment and Merchandising Properties' (1985) 4 Ent & Sports Law 3.

^{vi} *Boston Professional Hockey Assn. Inc. v Dallas Cap & Emblem Mfg. Inc.* 510 F.2d 1004 (5th Cir. 1975)

^{vii} *AMF Inc. v Sleekcraft Boat* 599 F.2d 341 (9th Cir. 1979),

^{viii} *Arsenal v M. Reed* [2003] EWCA Civ 696.

^{ix} Joseph P Liu, 'Sports Merchandising, Publicity Rights, and the Missing Role of the Sports Fan' (2011) 52 BC L Rev 493.

^x *University of Alabama Board of Trustees v New Life Art Inc.* 683 F.3d 1266 (11th Cir. 2012).

^{xi} *Bd. of Governors of the Univ. of N.C. v Helpingstine* 714 F. Supp. 167, 170 (M.D.N.C. 1989).

^{xii} Glenn M Wong, 'Recent Trademark Law Cases Involving Professional and Intercollegiate Sports' (1986) Det CL Rev 87.

^{xiii} *Nat. Football League v Wichita Falls Sportswear* 532 F. Supp. 651 (W.D. Wash. 1982).

^{xiv} *International Order of Job's Daughters v Lindeburg & Co.* 633 F.2d 912 (1980).

^{xv} *Nike, Inc. v Adidas America, Inc.* No. CV 05-541-BR (D. Or. Oct. 21, 2005).

^{xvi} *BCCI v. Grace India Sports Ltd.*, CS No. 815 of 2017.

^{xvii} *Star Athletica L.L.C. v. Varsity Brands, Inc.*, (2017) 137 S.Ct. 1002, 1007.

^{xviii} 17 U.S.C. § 102.

^{xix} Cal. Civ Code § 3344.1

^{xx} Darshan, 'Trademark and Copyright Prosecution: Marvel, Disney and China' (*Youtube*, 23 September 2021) <<https://www.youtube.com/watch?v=493-OsQu1Og>> accessed 23rd October 2021

^{xxi} *Supra* note 8.

^{xxii} Irene Calboli, 'The Case for a Limited Protection of Trademark Merchandising' (2011) U Ill L Rev 865.

PRIZED FIGHT! THE PAY-PER-VIEW MODEL AND THE PROBLEM OF COPYRIGHT INFRINGEMENT IN MIXED MARTIAL ARTS

- *Nachiket Jonnalagadda*

Introduction

Mixed Martial Arts has been taking the world of sports by storm by gaining immense popularity over the past decade. A unique blend of wrestling, kickboxing, boxing, jujitsu, and Muay Thai mixed martial arts (Hereafter referred to as MMA) has snatched the attention of audiences worldwideⁱ. There are even discussions to declare it as an Olympic Sport. A significant factor of MMA's rise in popularity is the fighter's ability to draw a crowd and put up a good show. Famous names such as Connor McGregor, Jon Jones, Israel Adesanya have helped put MMA on the global map, making it a worldwide sensation. Another contributing factor is the effective utilisation of the pay-per-view model. Pay-per-view is a form of pay television or webcast service that allows viewers to pay for private telecasts of certain events. The electronic programme guide on a multichannel television network, an automated telephone system, or a live customer service representative are all options for purchasing events. Pay-per-views are increasingly being broadcast

online via streaming video, either in or instead of traditional television distribution.

This model has been used in boxing bouts, musical concerts, professional wrestling matches, and MMA. However, it has brought its own set of problems, primarily illegal streamers who pirate the content on the internet for free. This article shall be elaborating on the various copyright issues faced by the Ultimate Fighting Championship (hereafter referred to as the UFC). To further the readers understanding of the same, the author shall also provide a brief on the legislation involved, the Digital Millennium Copyright Act of 1998 in the United States.

The Digital Millennium Copyright Act and Piracy

The Pay-per-view model was usually executed by cable television channels that offered assistance to various sports organisations to garner viewers for publicity. However, in 2012, prominent American cable news channel Fox, offered ZUFFA LLC, the largest and most prominent MMA company, to partner with them for pay-per-view salesⁱⁱ. This had

resulted in a significant increase in viewership and income for the organisation and, in turn, had resulted in the sport reaching a larger audience. Eventually, the UFC had decided to create their online streaming service that used the pay-per-view structure to entertain the online audience.

The Digital Millennium Copyright Act was passed in the United States in 1998 and is one of the first laws to recognise intellectual property on the internet. The statute, signed into law by then-US President Bill Clinton, governs the implementation of two World Intellectual Property Organization (WIPO) treaties negotiated and agreed upon by member nations in 1996. It also provides the necessary legal protection to digital content. As this bill was passed before creating online streaming platforms, a notice mentions the steps to protect the creator from any copyright content violation on the internetⁱⁱⁱ. The notification requires the provider to review potential infringing material and, under certain conditions, remove the material. A failure to remove infringing material can lead to liability for the provider^{iv}. It must be determined whether these pay-per-view fights are protected under copyright law.

The law of copyright protects original works of authorship that are fixed in a physical medium of expression. Audiovisual works are considered original works of art. Therefore Zuffa's bouts and pay-per-view production are protected under

copyright law since they produce a live audiovisual work simultaneously fixed upon transmission. Therefore, it is established that online streaming content does fall under the purview of The Digital Millennium Copyright Act.

The UFC and the Issue of Copyright Violation:

ZUFFA LLC is the parent company of the UFC, which organises MMA bouts for millions of fans worldwide. Since most of the fanbase resides outside the United States (where these fights take place), ZUFFA LLC had begun streaming its fights on the internet. However, since many people are not willing to pay a certain amount of money to view the program, they resort to illegally streaming the content online. However, not all online streaming is illegal. There can be fair use of copyrighted content, in this case, the bouts hosted by the UFC, which is the copyrighted property of ZUFFA LLC. A common defence of copyright infringement is the concept of fair use, which states that the content so used by an external third party is done without hampering the creator's creativity.

Any copyright falls firmly on the copyright owner according to the Digital Millennium Copyright Act. The copyright owner has exclusive access to essential knowledge and information that allows him or her to more efficiently and adequately assess whether or not any given content is infringing^v. There are two tests to determine whether there is fair use of copyrighted

material^{vi}. The first is the “red flag test”. This test essentially lays down whether the service provider is aware of the apparent infringement activity that they are performing. For instance, if a streaming platform distributes any content on the internet with the knowledge that such distribution is illegal, then it cannot be said that there is fair use of the content, which is a copyright violation. The second test is the “Direct Financial Benefit” and the “Right and Ability to Control” content. As the name suggests, if a service provider receives some monetary incentive and, with the creator’s permission, can control the content provided to a certain extent, they can claim fair use of copyrighted material. If any streaming activity is found to counter any of the tests discussed here, it would be considered a copyright violation. Therefore, such content shall be taken down in order to avoid further misuse of the content.

Piracy poses a significant threat to companies like ZUFFA and the UFC. They receive a majority of their income from the online pay-per-view model. However, the company faces many losses due to many illegal streamers who distribute content for free on the internet. Although this can be taken down, it takes longer than expected as the burden to determine whether the content is being infringed upon lies on the creator. In most cases, by the time the creator identifies such infringement, many losses are already incurred. The best example is the recent rematch between Connor McGregor and Dustin Poirier which

secured over one million pay-per-view buy^{vii}. However, over another million dollars’ worth of income could have been generated had there not been an instance of piracy^{viii}.

This act of piracy also provides for a reduced income to the fighters. A significant chunk of the commission of these fighters is obtained through online sales. If such acts of piracy were to continue, these athletes who put their lives at stake for the entertainment of the fans would be deprived of sufficient pay. This would indefinitely be a gross violation of their rights.

Conclusion

Considering the situation mentioned above, the author would like to conclude the article by stating that, Although the Digital Millenium Copyright Act provides a method to determine whether there has been fair use of the content, It prevents the defendant from escaping liability on the same ground. However, these tests themselves have certain shortcomings. The onus of determining whether there has been a copyright infringement is usually quite taxing. It does not provide enough guarantee to protect the creator’s content. By the time the violation or act of piracy is identified, many losses are incurred. Therefore, the existing law must consider this aspect and tackle the issue with stricter measures, thereby providing a safety net to the organisers, which would benefit the sport and the fighters.

-
- ⁱ Keith Black, Technical Knockout: How Mixed Martial Arts Will Change Copyright Enforcement on the Web, 21 Fordham Intell. Prop. Media & Ent. L.J. 739 (2011).
<https://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1498&context=iplj>, accessed on 15th October 2021.
- ⁱⁱ Dan Hiergesell, UFC: Paying Tribute to One of the World's Fastest Growing Sports,
<https://bleacherreport.com/articles/941301-ufc-paying-tribute-to-one-of-the-worlds-fastest-growing-sports>, accessed on 20th October 2021.
- ⁱⁱⁱ Viacom Int'l Inc. v. YouTube, Inc., 718 F. Supp. 2d 514, 519 (S.D.N.Y. 2010).
- ^{iv} Aashish Aryan, Explained: What are DMCA notices for protection of intellectual property online? The Indian Express,
[https://indianexpress.com/article/explained/digital-millennium-copyright-act-notices-twitter-ravi-](https://indianexpress.com/article/explained/digital-millennium-copyright-act-notices-twitter-ravi-shankar-prasad-7377932/)

[shankar-prasad-7377932/](https://indianexpress.com/article/explained/digital-millennium-copyright-act-notices-twitter-ravi-shankar-prasad-7377932/), accessed on 15th October 2021.

^v Greg Jansen, Note, Whose Burden is it Anyway? Addressing the Needs of Content Owners in DMCA Safe Harbors, 62 Federal Communications Law Journal 153 (2010),
<https://www.repository.law.indiana.edu/fclj/vol62/iss1/6/>, accessed on October 20th 2021.

^{vi} Section 512, Digital Millenium Act 1998

^{vii} Kane Dane, UFC 264 Conor McGregor v Dustin Poirier Purse Payouts Revealed,<https://www.sportingfree.com/mma/mcgregor-vs-poirier-3-purse-payouts-ufc-264/>, accessed on October 20th 2021.

^{viii} Micheal McCann, UFC Aims to Slam Online Pirates With Tougher Federal Copyright Law, Yahoo!Sports, <https://sports.yahoo.com/ufc-aims-slam-online-pirates-040100235.html>, accessed on 15th October 2021.

CASE INGOTS

Sporta Technologies Pvt. Ltd. & Anr. v. John Doe & Anr. (CS(COMM) 365/2021)

The plaintiff launched a fantasy sports website under the trademark “DREAM11” in 2012. The domain name for their website “www.dream11.com” however was registered in 2008. Totally, 11 marks related to “DREAM11” was registered in their name. The defendant, was also involved in the business of facilitating fantasy sports services on their fantasy cricket league platform, called “www.mydream11.in”. The corresponding app was called “MyDream11”. It was argued by the plaintiff that the mark and website is deceptively similar to theirs, including the domain name and recital on the website and claimed it would create consumer confusion. Agreeing with the plaintiffs, the Delhi High Court restrained the Defendant from using the mark “mydream11” or any other related mark or domain name, that may be considered similar to the Plaintiffs’ mark. The Court also ordered the suspension of the Defendants’ website.

E.N. Project & Engineering Industries (P) Ltd. & Anr. v. KVT Electrical Project & Engineering and Ors. (CS(COMM) 262/2020)

The plaintiffs had a table tray manufacturing business, with clients from food processing, airport and railway industries. These trays were registered under Section 6 of the Designs Act, 2000 since 2010, by which they claimed that their design was novel and possessed a secondary meaning in the market. A suit was filed against the Defendants claiming they sold an imitation of the plaintiff’s design. This infringement was claimed to be deliberate as the defendants were former distributors of the plaintiffs. The defendants contended the registration of the plaintiff’s design claiming it was not a “novel” one as required under the provision. The Delhi High Court observed that it could not be a coincidence that the Defendants’ design is an exact copy, even if they agreed that a “grid-like metallic design” is not original.

MRF Ltd. v. Sujavudeen & Anr. (C.S. No. 735 of 2000)

Plaintiff was engaged in the business of trading automobile tyres and sports goods, registered under the mark “MRF”. This mark became popular and identified by customers as their business grew. The Defendants established a business called “MRF Readymades” and “MRF Enterprises” under a mark also titled “MRF”. The Plaintiffs contended that this was a clear case for infringement, as it can cause confusion among the public and allow the defendants to unjustly benefit from the plaintiff’s goodwill. Court observed that though the Defendants’ mark had a slightly different lettering style and they engaged in a different business, it was sufficient to create confusion among consumers. Although not identical, it still constituted infringement under Sections 27 and 105 of the Trade and Merchandise Marks Act, 1958 and Section 55 of the Copyright Act, 1957. The Court granted a permanent injunction in favour of the Plaintiffs.

TRADE SECRETS AND INDUSTRIAL ESPIONAGE IN MOTORSPORT

- **Keerthana R**

Motorsport is the culmination of cutting edge aerodynamics, tasteful engineering and flawless design. While one would expect such human innovation to be protected from unfair use, many aspects of the machines themselves are often not subject to the extensive portfolios of registered intellectual property rights.

The cutting edge technology along with the massive monetary investments would naturally appear to be a fertile ground for IP protection, in fact IP's place in motorsport is ubiquitous. In a sport where fractions of seconds could determine the winner of grand titles, minor mechanical adjustments to the racecars could provide contestants that crucial edge over the others and this is where trade secrets come in.

Trade Secrets and Motorsport

Trade secrets include information regarding the mechanics of a machine, technical test results, manufacturing processes, prospective designs and other practices that have inherent economic value. Motorsport, especially the Formula 1 races are known to be quite dangerous and from its initiation, the governing body, the Federation Internationale de L'Automobile [FIA], turbocharged its safety standardsⁱ and more emphasis was laid on superior

aerodynamics all while balancing it with the safety of the driver.

While the NASCAR races restrict teams and mandate the standard of racecars to be used, the F1 races are more lax and allow teams the liberty to fine-tune their carsⁱⁱ and this pushes them to further design and engineering. Usually, patents are issued to protect such advancements and discoveries however, patents are very rarely used in the world of motorsport despite its advantages because of the time it takes for a patent to be approved and registered.

A senior F1 engineer is quoted below to explain the lack of interest to use patents:

"It's because if a team takes out a patent on a design, that then locks in an advantage the other teams cannot access. Therefore, the other teams will simply vote it out through the FIA Technical Working Group process by the end of the season in question. By keeping a new design in the game, a team can gamble that they can do a better job on a design than another team. Examples like seamless shift gearbox and inertia dampers are good ones. If these were patented by F1 teams, then they would have been wiped out"ⁱⁱⁱ

In order to promote competition and motivation to constantly improve, trade secrets are the preferred form of IP in motorsport. The two rationales relied upon while employing trade secrets in the field of motorsport include the ideas of commercial morality and unfair competition.^{iv} Contract breaches manifest itself to become the foundation for the rationale, and the motive behind the same is incentivizing new innovations.

Cases of Industrial Espionage in Formula One

The most controversial battle in the land of IP rights and motorsport includes the rift between the two most revered F1 teams – McLaren and Ferrari in 2007^v. It all began with the wife of Micheal Coughlan, the chief designer of McLaren's F1 race team, Trudy Coughlan walked into a copy shop in Surrey to photocopy almost 780 pages of top-secret Ferrari insider information on the design and engineering of the race cars. The photocopy store owner being a massive Ferrari fan reported the incident and thus began the competitive legal battle between the two formidable racing giants with regards to espionage and violation of privacy.

The insider who had been leaking such valuable information was a newly appointed mechanic at McLaren who had previously worked at Ferrari named Stepney and once the police raided his home, they found enough schematic drawings, technical reports, photographs, budget sheets and planning

materials to reverse-engineer a Ferrari F1 race car from scratch. He had even leaked the team's pit-stop strategy to McLaren which put them at an undisputable advantage. The case ultimately resulted in McLaren having to pay USD 100 Million in addition to being excluded from the 2007 Constructors' World Championship.^{vi}

Industrial espionage is not limited to illegally obtaining information about competitors via private entities but it also extends to spying within an organisation itself. As was seen in the Hewlett-Packard scandal^{vii} wherein the media observed that the company spied on its own directors with the aim of identifying a mole who was leaking board confidential secrets. The scandal ended with the Chairman of the Board having to resign along with a settlement agreement where HP had to pay around USD 14.5 Million to the Attorney General.

In *Force India Formula 1 Team Ltd v. 1 Malaysia Racing Team*,^{viii} the principal claim was the misuse of confidential information with regards to the design of a half-size wind tunnel model of a race car. This was coupled with a claim for infringement of copyright. An ex-employee of the Force India F1 team had entered into an aerodynamic development contract with the Malaysian Racing Team [Lotus Team] and he then used some of the elements of the Force India Team's confidential engineering systems to develop a new race car for the Lotus Team.

The defendant went on to claim that upon the termination of his service at the Force India F1 team in 2009, the duty of confidentiality and obligation of non-disclosure had also ended with the contract of employment. The Court then held that the elements necessary for a breach of confidence included the presence of confidence, the unauthorised breach of said confidence and the misuse of such confidential information for profit. The absence of a restrictive covenant does not allow former employees to use trade secrets of his former employer. Thus, despite former employees being encouraged to use their own skill and knowledge acquired while practising with their former employers, it did not entitle them to misuse confidential trade secrets with future employers.

However, the line between sanctioned and fraudulent trade secret transfer in F1 is vague and lacks concrete definition. While the above cases stipulate that any misappropriation claims need to be backed by 'substantial evidence', the exact constitution of the term 'substantial evidence' in itself is unclear. While certain parts of the engineering and equipment used to build the race cars are available in the public domain, most of the parts remain confidential. Some companies allow other automobile manufacturing companies to lease out designs^{ix} and occasionally divulge specific secrets, the exact line between acceptable use and infringement of trade secrets remains undefined. The World Motor Sport Council [WMSC] needs to delineate the difference between acceptable use and punishable espionage in F1.

ⁱ Ashwene Vij, *What is the driving force behind Intellectual Property of Formula 1*, iPleaders, <<https://blog.ipleaders.in/driving-force-behind-intellectual-property-formula-1/>> accessed May 23, 2021.

ⁱⁱ Diego Black, *F1 IP demonstrates value of Trade Secrets*, The Engineer, <<https://www.theengineer.co.uk/f1-ip-dispute-trade-secrets/>> accessed August 27, 2020.

ⁱⁱⁱ James Allen, *Patents in F1 Explained*, <<https://www.jamesallenonf1.com/2012/01/patents-in-f1-explained/>> accessed Jan 13, 2012.

^{iv} Simon Casinader, Niall Lavery, *How Patents & Trade Secrets Are Utilised in Motorsport*, LawInSport, <<https://www.lawinsport.com/topics/item/how->

[patents-trade-secrets-are-utilised-in-motorsport](#)> 03 September 2021.

^v Mark Seal, *Inside the Scandal that rocked the Formula One Racing World*, WIRED, <<https://www.wired.com/2008/05/ff-formulaone/>> accessed May 19, 2000.

^{vi} Ibid.

^{vii} Kevin Allison, *HP spy scandal extends to employees*, The Financial Times, <<https://www.ft.com/content/38e2f2f2-437a-11db-9574-0000779e2340>> accessed September 14 2006.

^{viii} Force India Formula 1 Team Ltd v. 1 Malaysia Racing Team, (2012) RPC 29.

^{ix} Nissan outsources its design and manufacturing process to Renault Alpine F1 team at times, Renault Group. <<https://www.renaultgroup.com/en/our-company/heritage/focus-on-international-markets/>>

THE ROLE OF TRADE SECRETS IN PROFESSIONAL SPORTS: AN ANALYSIS OF THE US LEGAL REGIME

- *Sanjana Santhosh*

Our society is currently under the transition of a “big data” revolution. Businesses are progressively marshalling formerly inconceivable volumes of data across vast swaths of the economy to derive new insights in industries as diverse as health care, financial services, and transportation. By utilising data analytics, businesses may more efficiently predict future requirements and weaknesses, plan strategically, avoid losses, and manage risk, all for the benefit of the end result. This big data revolution has been played out nowhere more prominently than in the professional sports business.ⁱ

Millions of sports fans are exposed to a variety of novel and increasingly sophisticated statistics while watching their favourite teams play every day. Teams collect proprietary information in the form of statistical analysis, scouting reports, nutritional regimens, physiological measures, and psychological assessment procedures to acquire a competitive edge in the market. Secret substances and materials are frequently used in sports equipment to help sportsmen perform better. Companies intend to find the appropriate combination of features and designs by spending a lot of money on extensive focus groups

to make their products more appealing and marketable.ⁱⁱ

Despite the growth of information in today's economy, limited data is available about how enterprises in the professional sports industry, or the economy as a whole, secure their proprietary information. Firms have traditionally been hesitant to discuss the types of trade secrets they possess, or the measures taken by them to keep this information secured. This is understandable considering that methods of data analysis are protected under the law of trade secrecy, and public disclosure might lead to the loss of legal protection.ⁱⁱⁱ

This article aims to examine proprietary information from the professional sports industry in the United States, and intends to shed light on the scope of trade secret protection in the modern economy, as well as the measures that these companies have taken to safeguard their vital, but highly sensitive data.

Data and Statistical Analysis in Sports

The professional sports industry, to varying degrees, has focused on a plethora of statistical data to evaluate athletes and guide teams in making scheduled decisions. Various teams in the sports

industry attempting to implement new biometric-tracking technology, which allows them to track their players' physiological performance. For instance, teams can now measure the number of calories their players consume and burn in a given day, their heart rate during training and matches, and even the quantity and quality of sleep they get each night using devices called *Fitbits* and other similar devices.^{iv} Other technological advances, such as *Motus sensors*, allow teams to see in real-time, the amount of stress players exert on their joints and tendons, especially those that are most prone to rupture. The information collected from these biometric tracking devices can assist teams in fine-tuning their dietary and physical workout routines to help their players prevent injury and achieve optimum physical performance on the field.^v

Sports organizations benefit from more conventional forms of proprietary information in addition to sophisticated statistical and data analysis. Many teams, for example, protect their 'playbooks', which essentially contains all of their strategies and moves, as well as numerous signals (hand, verbal, or otherwise), generally used by coaches to communicate play calls to athletes during a match. Scouting reports show the strengths and shortcomings of both a franchise's players and those playing in competing teams, as well as documents recording a franchise's recent and ongoing trade negotiations with other clubs, are other types of

information that clubs may want to safeguard. Meanwhile, a professional sports club, like any other business, is likely to have private information about its general business plans, marketing tactics, and customer data, all of which usually are commercially valuable.^{vi}

According to reports from June 2015, "the FBI was investigating whether officials from MLB's St. Louis Cardinals had illegally entered, or hacked into, an internal computer network belonging to its league rival, the *Houston Astros*. The government launched an investigation, after records detailing the Astros' trade conversations with other teams were leaked to the sports website *Deadspin* via the team's network, dubbed "Ground Control". While the FBI investigation was ongoing, Christopher Correa, the Cardinals' former scouting director, had pled guilty to the accusations that, he illegally accessed the Astros' internal network to get hold of the team's confidential information."^{vii}

Thus, this incident indicates the increasing significance of proprietary data in the domain of professional sports, thereby emphasizing the need for sports organizations to secure, and legally protect their most valuable and sensitive data.

Law of Trade Secrets

The law of trade secrets is extensively used to protect data analysis and other kinds of private information

by enterprises in both the professional sports industry and the global economy. The American Law Institute includes trade secrecy in its Restatement (First) of Torts (Restatement), published in 1939, in an attempt to compile and harmonise the developing body of state laws on the subject. The Restatement defined a trade secret as “*any formula, pattern, device or compilation of information which is used in one’s business, and which gives [the business] an opportunity to obtain an advantage over competitors who do not know or use it.*”^{viii} Furthermore, it stipulated that secrecy was required in order for proprietary information to be legally protected. In the United States, trade secret law was finally codified into three main legislations:

- Uniform Trade Secrets Act (UTSA):

The National Conference of Commissioners on Uniform State Laws sought to fix the Restatement's errors through its enactment of the UTSA in 1979, by “*codifying existing common law standards and . . . providing a uniform approach to trade secret misappropriation among the states*”.^{ix}

The UTSA has now been accepted by forty-eight states and the District of Columbia. To prove the existence of a trade secret, the UTSA mandates two components:

i. A plaintiff must be able to demonstrate that its trade secret is economically valuable since it is not “commonly known.”

ii. In order for a legally protectable trade secret to exist under the UTSA, a plaintiff must also be able to establish that he has taken reasonable steps to keep its proprietary information undisclosed.^x

- The Economic Espionage Act (EEA):

With the enactment of the EEA in 1996, trade secrecy became a federal crime for the first time. To prevent trade secret theft prior to the EEA, federal prosecutors had to depend on federal legislation against mail and wire fraud—or, alternatively, a law targeting unauthorised computer access—none of which were specifically designed to address trade secret misuse.^{xi} In contrast to the UTSA's civil liability, the EEA outlaws both attempted trade secret theft and misappropriation conspiracies, whether national or foreign. Furthermore, the EEA has a distinct *mens rea* component that necessitates proof of unlawful intent. The EEA criminalizes two types of trade secret theft:

- a) theft benefiting a foreign entity; and
- b) cases of domestic theft for economic gain.^{xii}

- The Defend Trade Secrets Act (DTSA):

On May 11, 2016, Congress passed the Defend Trade Secrets Act (DTSA), which alters the EEA to create a federal civil cause of action for trade secret abuse. Theft of a trade secret “*connected to a product or service used in, or intended for use in, interstate or foreign commerce*” is specifically covered by the new statute.^{xiii} The DTSA is modelled after the UTSA, and it includes the same definition of a trade secret as the

UTSA, as well as the requirement that the trade secret owner take appropriate precautions to protect the information's anonymity. The DTSA, on the other hand, is unique as it also includes an ex-parte seizure clause that allows a court, “under extraordinary circumstances, to issue an order providing for the seizure of property necessary to prevent the propagation or dissemination of the trade secret”.^{xiv}

Conclusion

This article has explored the protection of trade secrets in the professional sports industry, particularly, by casting new light on the practices

used by sports teams to keep their private knowledge confidential. Further, the article has identified methods in which sports leagues may seek to take action in order to increase competition among their teams, as well as indicating the necessity for more research into the trade secret protection policies of enterprises in both the professional sports industry and the economy at large. Furthermore, given the growing prominence of big data in the market over the following years, issues concerning the legal protection of proprietary data will only become more crucial.

ⁱ Ian Kerr, Jessica Earle, “Prediction, Preemption, Presumption: How Big Data Threatens Big Picture Privacy”, STAN. L. REV. ONLINE vol. 66, 2013, pp. 66 <https://review.law.stanford.edu/wp-content/uploads/sites/3/2016/08/66_StnLRevOnline_65_KerrEarle.pdf> accessed 11 October 2021.

ⁱⁱ Steve Eder, “Modern Stats Bring WAR to Broadcast Booth”, 2013, N.Y. TIMES <<https://www.nytimes.com/2013/04/02/sports/baseball/baseball-broadcasts-introduce-advanced-statistics-but-with-caution.html>> accessed 11 October 2021.

ⁱⁱⁱ David S. Almeling, “A Statistical Analysis of Trade Secret Litigation in Federal Courts”, GONZ. L. REV., vol. 45, 2009, pp. 291 <<https://www.tradesecretsandemployeemobility.com>

/files/2014/05/Statistical-Analysis-of-Trade-Secret-Litigation-in.pdf> accessed 11 October 2021.

^{iv} Steven I. Friedland, “Of Clouds and Clocks: Police Location Tracking in the Digital Age”, TEX. TECH L. REV., vol. 48, 2015, pp. 165 <<http://texastechlawreview.org/wp-content/uploads/Friedland.PUBLISHED.pdf>> accessed 11 October 2021.

^v Robert Guthrie, “The Future of Biometric Tracking Will Make Step Counters Look Like Antiques”, DIGITAL TRENDS, 2016 <<https://www.digitaltrends.com/health-fitness/future-of-biometrics-beyond-the-wrist-track>> accessed 11 October 2021.

^{vi} Kelley Clements Keller, Brian M.Z. Reece, “Economic Espionage and the Theft of Trade

Secrets: The Case for a Federal Cause of Action”,
TUL. J. TECH. & INTELL. PROP., vol. 16, 2013,
pp. 1

<<https://journals.tulane.edu/TIP/article/view/2625>>
accessed 11 October 2021.

^{vii} United States v. Correa, No. 16-2316 (7th Cir.
2018)

^{viii} RESTATEMENT (FIRST) OF TORTS § 757
cmt. (1939)

^{ix} Christopher Rebel J. Pace, “The Case for a Federal
Trade Secrets Act”, HARV. J.L. & TECH., vol. 8,

1995, pp. 432-33

<<http://jolt.law.harvard.edu/articles/pdf/v08/08HarvJLTech427.pdf>> accessed 11 October 2021.

^x UNIF. TRADE SECRETS ACT § 1(4) (UNIF.
LAW COMM’N 1996)

^{xi} *Supra* note 6

^{xii} 18 U.S.C. § 1832(a) (2012)

^{xiii} 18 U.S.C. § 1836(b)(1)

^{xiv} 18 U.S.C. § 1836.

IPR REWIND

- October 15, 2021 – IAM, with Industrial Bureau, Ministry of Economic Affairs (IDB) and the Industrial Technology Research Institute (ITRI) co-hosted IPBC Taiwan 2021 with 5G IP Strategy as the topic.
- October 26, 2021 – A Co-Sponsored conference by the United States Copyright Office and the United States Patent and Trademark Office on “Copyright Law and Machine Learning for AI: Where Are We and Where Are We Going?”
- October 27-29, 2021 – conference on “Intellectual Property and Artificial Intelligence” conducted by Academy of European law
- October 28-29, 2021- China intellectual property & Innovation summit 2021 (CIPI2021)

COMMERCIALIZATION OF IP IN THE SPORTS INDUSTRY

- *Sahana R*

Sports have evolved over the years, and due to the advancement in technology, telecasting of sports has increased the viewer base to a great extent. In almost every facet of human existence, including sports, rights stimulate creativity and growth. Thus, in the era of innovation and entertainment, Intellectual Property plays a vital role to protect invention. The term "commercialization" refers to the process of generating value from the intellectual property by marketing a new product, production method, or service that is at least partially based on the IP.ⁱ In the field of sports innovative technologies are protected under the Patents Act, the names and goodwill of sport teams are protected under Trademark Act and so on. Thus, the most common ways of commercialization are licensing, franchising and merchandising.

Intellectual Property protection in the Sports industry

Various types of IP are used to protect various aspects of the Sports industry. These include; Trademarks, Patents, Copyrights and Trade Secrets. The artistic work in team logos, slogans, photos of players or official mascots of athletic events, and so on, all include copyright. Similarly, copyright is extremely

essential in the broadcasting and telecasting of sporting events as only those with the broadcasting rights will be able to legally broadcast the sports events on their channels. For example, Star India paid a whopping price of 16,347.5 crores (\$ 2.55 billion) for the broadcasting rights to the Indian Premier League (IPL) for a five-year term beginning in 2018.ⁱⁱ Trademarks play a significant role in developing brand value, interest and popularity in sports. Michael Phelps holds the rights to the "MP" logo, which appeared on his swim cap during the Olympics, and the name "Michael Phelps Swim School,"ⁱⁱⁱ This has helped the company gain more reputation and has built the brand. Thus, it attracts more followers to buy these goods.

The new technologies and equipment innovated in the sports industry are protected by patents. For example, George L. Pierce received the first patent for a ball created expressly for "basketball" in 1929.^{iv} Everlast boxing headgear instrumented with 12 single-axis linear accelerometers has been successfully validated to provide information about the severity and location of impacts and has been protected by a patent.^v Thus, we can see how these patents have increased innovation in the sports

industry to make sports equipment more safe for the players.

To obtain an advantage over their opponents, teams and organizations generate different critical information, such as statistical data, dietary and nutritional analyses, psychological and physiological data about players, and even specific rehabilitative treatments for specific sports and ailments and these are protected under trade secrets.^{vi} The IP rights help to secure the economic value of the sport. Once a particular sports team gets an IP maybe in the form of a trademark or patent, there lies huge commercial opportunities offered to these inventors.

Sports IP commercialization

Trademarks, which include the team name, logo, emblem, and sport jerseys, are the most common way of Commercialisation in sports. To safeguard their personality rights and prevent third parties from utilizing their name, logo, or picture for commercial gain, well-known athletes must trademark their names, logos, and images.^{vii} One such example is P.K. Subban, a member of the Montreal Canadiens, who is pursuing eight trademarks through his company P.K.S.S. Management Inc. The company has shirts, hats, and other goods with nicknames and phrases. Subban's trademark applications are all pending, and it's unclear whether he'll be able to demonstrate that he's used the terms commercially. "Subbanator," "P.K. 76," "Skate Past The Noise," and "Change The Game" are among the trademarks he's

seeking.^{viii} With these trademarks, PK Subban can monetize by selling the merchandises at a higher rate due to the goodwill and reputation of PK Subban.

Furthermore, in sports, commercialization takes place by franchising and conducting leagues with famous sportspersons. Some examples are the Indian Premier League for cricket in India, The English premier league in the United Kingdom for Football and the NBA for Basketball in the United States. By using intellectual property rights available through active marketing, broadcasting, and promotion of various other marketable choices, the organisers of these leagues have been able to reap significant economic gains and benefits. For example, Board of Control for Cricket in India, holds the copyright for the Indian Premier League in India and calls for tenders every five years to broadcasting channels.^{ix} This is a way of commercialization in which the copyright holder gets economic benefits.

Sports teams commercialize their IPs by merchandising in the form of articles such as clothes, keychains, dolls etc. For example, Manchester United, a famous football team in the United produces keychains, clothes and so on under this trademark.^x Any person who sells articles under the trademark of Manchester United, they would be infringing the trademark of Manchester United.^{xi} Thus, the fans who support a particular sports team will surely buy the sports team merchandises as there

will be some amount of brand loyalty by the fans towards their favourite teams.

Conclusion

In the sports industry, intellectual property rights play a significant role, resulting in innovations and expansion of sports on the field. As a result, it is critical that these intellectual property rights are well-protected in order to assure continued growth in all areas of the sports industry. Furthermore, the increase in new technologies and creativity in the field of sports will result in a greater number of IP protections

and thus increasing brand value, goodwill etc. of the sports team. The development in the sports industry will lead to development in various other sectors and economic growth. The other sectors could include the textile industry, Export and import industries etc. For example, the development in the sports IP Industry would lead to commercialization by the way of character merchandising where every team would like to get their team jerseys and would contact a textile shop in the locality. The bulk orders would also help the textile industries to grow economically.

ⁱ “Intellectual Property Commercialization N - UNECE”

<<https://unece.org/fileadmin/DAM/ceci/publications/ip.pdf>> accessed October 20, 2021.

ⁱⁱ “IPL Media Rights Auction Highlights: Star India Sweeps All Rights with World-Record Bid of Rs 16,347.5 Crore” (*Hindustan Times* September 4, 2017)

<[https://www.hindustantimes.com/cricket/live-indian-premier-league-media-auction-big-names-lucrative-rights/story-](https://www.hindustantimes.com/cricket/live-indian-premier-league-media-auction-big-names-lucrative-rights/story-RA1LOPqaQcWBUQ0j1Vt9WN.html)

[RA1LOPqaQcWBUQ0j1Vt9WN.html](https://www.hindustantimes.com/cricket/live-indian-premier-league-media-auction-big-names-lucrative-rights/story-RA1LOPqaQcWBUQ0j1Vt9WN.html)> accessed October 22, 2021.

ⁱⁱⁱ That's why they trademark their names, “Pro Athletes and the Things They Trademark” (*CNNMoney*)

<<https://money.cnn.com/2016/08/19/news/trademarks-athletes-usain-bolt-olympics/>> accessed October 19, 2021.

^{iv} Moreira victor sergio, “The Role of Patents in Sports - Intellectual Property - Worldwide” (*Mondaq* June 24, 2019)

<<https://www.mondaq.com/patent/818194/the-role-of-patents-in-sports>> accessed October 20, 2021.

^v “Sports and Fitness – Role of Patents and Technology” (Patent business lawyer. Com)

<<https://patentbusinesslawyer.com/sports-and-fitness-role-of-patents-and-technology/>> accessed November 18, 2021.

^{vi} Lawandorderblog, “The Intersection of IPR and Sports: Commercialisation of Sports” (*Law & Order* August 19, 2020) <<https://www.law-order.org/post/the-intersection-of-ipr-and-sports-commercialisation-of-sports>> accessed October 21, 2021.

^{vii} K.V. Vibhu Prasad, Pranav.R, IPR and Sports, Intellectual Property Rights, Manupatra, (2020), <https://www.manupatrafast.com/articles/ArticleSearch.aspx?c=&years=2020&search=IPR+and+Sports>.

^{viii} “Brown Patent Law, PLLC”

(*BrownPatentLaw, PLLC* January 1, 1970)

<<https://www.dennisbrownpatents.com/blog/posts/view/14/4-trademark-cases-from-the-sports-world>> accessed October 21, 2021.

^{ix} “BCCI Announces Tender of IPL Media Rights for 2023-2027 Cycle” (*The Board of Control for Cricket in India* September 28, 2021)

<<https://www.bcci.tv/articles/2021/news/155106/bcci-announces-tender-of-ipl-media-rights-for-2023-2027-cycle>> accessed October 21, 2021.

^x Sharada, “Intellectual Property and the Business of Sports Management”

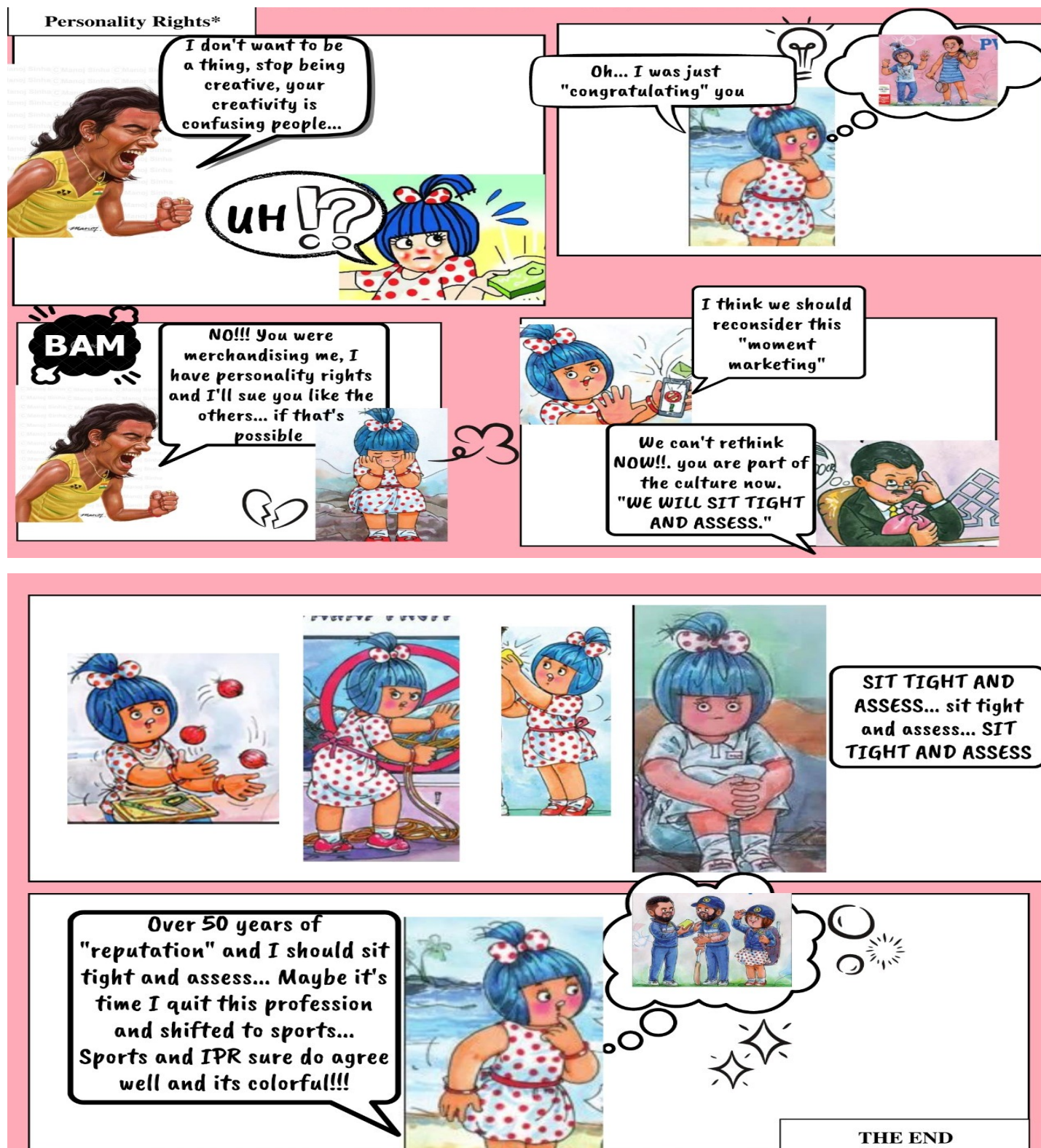
<<http://nopr.niscair.res.in/bitstream/123456789/14768/1/JIPR%2017%285%29%20437-442.pdf>>
accessed October 24, 2021

^{xi} Sharada, “Intellectual Property and the Business of Sports Management”

<<http://nopr.niscair.res.in/bitstream/123456789/14768/1/JIPR%2017%285%29%20437-442.pdf>>
accessed October 24, 2021.

COMMERCIALIZATION OF IP IN THE SPORTS INDUSTRY

- Meher Mansi



*Satchit Bhogle, 'PV Sindhu's Olympics Victory: How Non-Sponsors Skirt the Law by 'Congratulating' Athletes' (SpicyIP, 16 August 2021) <<https://spicyip.com/2021/08/pv-sindhus-olympics-victory-how-non-sponsors-skirt-the-law-by-congratulating-athletes.html>> accessed 14 October 2021

CAREFULLY LAUNCHED AMBUSH ATTACKS: TRAVERSING THROUGH SPORTS SPONSORSHIPS, AMBUSH MARKETING & IPR

- *Aleena Anabelly A*

The year was 1996; the Indian economy was redesigning its landscape after opening its gate to the world. Post-globalisation, major players and MNCs were vying in the market to gain supremacy. And, the born rivals – Coca-Cola and Pepsi, with their undistinguishable taste and features- attempted to distinguish themselves to capture the Indian soft-drinks market. The 1996 Cricket world cup was the ideal opportunity to mark their superiority in the newly liberalised India, and as anticipated, both brands bid for official sponsorship. Finally, Coca-Cola landed as the official sponsor to the Wills World

Cup, 1996, by defying the oddsⁱ. What followed was an interesting turn of events as Pepsi became the cynosure of all eyes and hijacked the world cup by introducing an admittedly impressive counter-ad against Coca-Cola's self-declaration that it is 'the official drink of the world cup'. The ad featured popular cricket players and made the tagline - "Nothing official about it,"ⁱⁱ sensational. Likely, Pepsi associated itself with the event and gained reputational benefits without being the official sponsor. This was India's first encounter with ambush marketing strategy. This article will attempt

to analyse the legality of ambush marketing in India, by aligning with the Intellectual property legislations.

The parasite problem and Law

Intentional association of a brand to an event, commonly sporting events, without payment of the colossal sponsorship charges, with the desire to steal the reputational and other benefits available to the official sponsors is known as 'Ambush marketing'ⁱⁱⁱ. This parasitic marketing induces the costumers to reasonably believe that the non-sponsor brand has a legitimate connection with the event. Commonly, this strategy is executed in three different ways -

- (i) By sponsoring the program through broadcast companies
- (ii) By sponsoring the participants
- (iii) By aggressively and extensively advertising in the country, region, or geographical location where the event is happening, associating the brand with the event.

This deliberate campaign is often considered unethical, but illegality in its dissemination arises only when the marks, logos, taglines, and other

intellectual property owned by the sporting event organizers and protected under law is used without authorization^{iv}. Traditionally, as a return on investment, the sponsors are provided with exclusive permission to use the intellectual property associated with the event, under a license. Hence, ambush marketing by non-sponsors, without any formal authorization, is a breach of this right made available to the sponsors. In India, if the event is recognized through a registered trademark, then, on infringement of it; the event organizers or official sponsors can protect their rights by initiating proceedings under Section 29^v of the Trademark Act 1999 and avail remedies. Furthermore, according to the ratio given in *ICC Development (International) Ltd v. Evergreen Station*, logos qualify as an artistic work to which copyright protection is available^{vi}. Therefore, section 51 of the Indian Copyright Act can be invoked when the logo or other original work related to the event is used or disseminated without authorization^{vii}. Though Indian Intellectual property legislations serves as a protective framework against direct ambush marketing, it has been proven to be inadequate in combating indirect ambush marketing. This incapacity was first revealed in *ICC Development (International) Ltd v. Arvee Enterprises and Anr*^{viii}.

ICC Development (International) Ltd (ICCDL) v. Arvee Enterprises and Anr

The plaintiff, a company formed by the International Cricket Council to efficiently control all commercial

rights related to the ICC World Cup, 2003, created a unique logo and mascot to identify and endorse the event. For safeguarding the right over these intellectual assets, ICCDL applied for the registration of trademarks in various countries. Likely, in India, they submitted an application for registering the words ‘ICC World Cup South Africa 2003,’ the official logo and the mascot – ‘Dazzler^{ix}.’ The defendants, a dealer of Philips India Ltd, deluded the consumers into believing that they are officially affiliated with the event, through misleading advertisements. Deceiving taglines like – ‘Diwali Manao, World Cup Jao^x,’ similar to plaintiff’s registered trademarks were used in those advertisements. Consequently, ICCDL filed a trademark infringement suit to protect their rights. The court dismissed the petition on the grounds that the defendants merely used a term that is extremely common and generic, i.e., ‘world cup^{xi}.’ This ruling leaves room for many ambiguities, primarily because of the obscurity of its justification. Furthermore, this ratio has partially validated indirect ambush marketing. Then, it becomes crucial to analyse the consequences of this decision.

Ambush marketing is a predatory approach employed by companies for causing commercial loss to their competitors by unfairly benefitting from unauthorized affiliation to an event. This can be perceived as an unfair trade practice that leads to unfair competition^{xii}, which is not yet penalized or regulated by law. Further, the monetary contributions

of leading brands and companies through the sponsorship channel are the primary financial source for the event organizers. In consideration of this, the event organizers offer exclusive access to the event's commercial rights to the sponsors. If such commercial rights do not seem beneficial, especially due to the possibility of competitors intervening in the exercise of such rights through ambush marketing, then the brands will be no more willing to sponsor events, thereby limiting the sponsorship options available to event organizers. Then, owing to the evident deficiency in law, the only recourse available to event organizers is to create an event-specific Ambush marketing legislation^{xiii} that expressly declares the unauthorized use of their intellectual assets illegal. This, coupled with restrictions on athlete/participant sponsorship, can

reduce the instances of Ambush marketing and unfair competition. But, event-specific legislation does not provide durable protection against the loss incurred due to ambush marketing. Therefore, a modification in the existing Intellectual property legislation and competition law for regulating indirect ambush marketing is inevitable.

Conclusion

Direct ambush marketing has been a subject of legal scrutiny in the last few years. Still, indirect ambush attacks that are carefully launched for debilitating the market power of a competitor do not attract any legal liability. Admittedly, it's time to extend the rule of 'fair play' beyond the sporting field and regulate indirect ambush marketing to create a level playing field.

ⁱ Kanoria A, "How Pepsi 'Sponsored' The World Cup without Spending a Dime" (*Medium* March 13, 2021) <<https://medium.com/an-idea/how-pepsi-sponsored-the-world-cup-without-spending-a-dime-240013d333b8>> accessed October 20, 2021.

ⁱⁱ (2014)
<<https://www.youtube.com/watch?v=riwOAtmMhZY>>.

ⁱⁱⁱ "What Is Ambush Marketing? Definition of Ambush Marketing, Ambush Marketing Meaning" (*The Economic Times*)
<<https://economictimes.indiatimes.com/definition/ambush-marketing>> accessed October 20, 2021.

^{iv} Kelbrick R, "Ambush Marketing and the Protection of the Trade Marks of International Sports Organisations — a Comparative View" (2008) 41 *The Comparative and International Law Journal of Southern Africa* 24

<<https://www.jstor.org/stable/23252717>> accessed October 20, 2021.

^v The Trademark Act, 1999 s29.

^{vi} ICC Development (International) Ltd v. Evergreen Station, 102 (2003) DLT 723.

^{vii} Indian Copyright Act, 1957 s51.

^{viii} 2004 (1) RAJ 10.

^{ix} Rout S, "Ambush Marketing: Need for Legislation in India - Intellectual Property - India" (*Mondaq* April 10, 2018)
<<https://www.mondaq.com/india/trademark/690204/ambush-marketing-need-for-legislation-in-india>> accessed October 20, 2021.

^x "Philips Plans to Roll out Festive Promo to Boost Sales" (*exchange4media*)
<<https://www.exchange4media.com/marketing-news/philips-plans-to-roll-out-festive-promo-to-boost-sales-6263.html>> accessed October 22, 2021.

^{xi} ICC Development (International) Ltd (ICCDL) v. Arvee Enterprises and Anr 2004 (1) RAJ 10.

^{xii} Dias JCV, Pereira DQ and Freitas JPSP, “Unfair Competition and Ambush Marketing: Concept, Characterization and Polemic Issues” (*Revista Brasileira Multidisciplinar - ReBraM /Brazilian Multidisciplinay Journal* June 1, 2014)

<<https://doaj.org/article/9aab5d6927d6497b95ecbc420cf86d89>> accessed October 20, 2021.

^{xiii} McKelvey S and Longley N, “Event-Specific Ambush Marketing Legislation for Mega-Sporting Events: an Economics Perspective” (2015) 16 *International Journal of Sports Marketing and Sponsorship* 20-35.

ANALYZING THE ROLE OF PATENTS IN SPORTS

Introduction

Intellectual Property is a dynamic field, which finds its use in almost every sphere of human life, to which *Sports* is no exception. In fact, sportspeople and sports academies all over the world use numerous types of equipment to prepare the players before a competition. Therefore, it becomes important for companies manufacturing such types of equipment to go for patents or lease a particular patent to manufacture the required product. However, here again, many sports academies may simply come up with their own device, invented indigenously, thereby having to file for a patent to protect their assets, as well as to earn profits over it. This article, in detail, explores this relationship between sports and intellectual property, in the form of patent, and its importance in this particular area.

A recent example of the same can be the javelin equipment imported by India from China in order to

- *Anjali Saran*

provide the requisite training needed to qualify and win in the *Javelin throw* category of Tokyo Olympics 2020, which indeed did pay off in the form of Neeraj Chopra clinching the gold medal this year for the same. These specially imported gadgets indeed helped the athletes to prepare themselves in a better manner. It was placed in the *Athletics Federation of India, Patiala*, where the newly imported KTG machine to 'develop strength' of javelin throwers. The deal cost the government around Rs. 5 crores¹. India could've manufactured the machine, but it did not own the IP Right over it.

Similarly, many other forms of sports also use or depend upon different pieces of equipment. Even the gym equipment that is built in a specific design, have different patents accompanying them. An example can be –

“*Treadmill Patents (Class D21/669,) Patent No.- D531683, Type- Grant, Filed- May 3, 2005, Date of*

*Patent- November 7, 2006, Assignee- Motus Co., Ltd.
& Inventors- Sang Yong Choi, & Hyun Gyu Limⁱⁱ*

From this, it can be inferred that filing a patent is not limited to scientific inventions, but any kind of innovation and invention that can benefit mankind and hasn't been invented before. The above example is of a patent for treadmill. It includes the class or category of equipment, the patent number granted to it after registration, the date of filing of the application as well as the date when the patent got registered, and the name of the inventors or the company that owns it. From the above example, one can also get to know what all important details have to accompany a patent registration certificate. A patent can be filed for multiple reasons and for numerous inventions. Here are certain examples for the same.

Use of Patents in the Manufacture of Sport Equipment

As mentioned earlier, patents have numerous uses in sports. They can even be used to invent games and mechanisms to increase the games' popularity and viewership. In 1996, a special hockey puck was made, and a patent was obtained for the same, as the hockey viewership had decreased due to visibility issues with the previous puckⁱⁱⁱ. It used to transmit some special electromagnetic rays, which improved visibility.

Formula One cars are still very popular sports, with different brands flashing their adept cars to compete with others over a huge sum of money. Mercedes Benz, Ferrari, and other such big brands never fail to turn up for these events. However, for racing, the normal cars which are used for domestic travelling are not enough. Specialized cars, with special seats are arranged, to see the comfort and safety of the driver. Therefore, here too, patents come into play for car engines and car technology.

In fact, sometimes, it is because of a proper patent that a particular game ever got any direction, and is known in the world. In 1929, however, George L. Pierce was awarded the first patent (US1718305) for a ball specifically designed for *basketball*^{iv}. However these also do not come free. There are both pros and cons associated with such patents.

Pros and Cons of Patents in Sports

Sports patents have dual benefits, both for the inventors and players. Some of the pros of having patents in sports can be a benefit to the game developer or inventor. As mentioned earlier, these patents truly helped in the development of some sports. Today, almost every piece of equipment we see has a long history of patents. They provide the inventor with an incentive to invent and keep evolving in this field. They help them earn their value for investment and efforts put in by them to make the specific equipment. These technologies indirectly help a sportsperson in improving his/her

game. It helps them in developing different strategies. An example can be one of the Indian cricketer, who used stickers on his bat to record the number of fours and sixes he hit, to keep a proper record of his performance and his speed of dealing with different forms of balling techniques.

However, there are quite a lot of drawbacks of sports-specific patents. Some of the cons of having sports patents are that it increases the price of any instrument or equipment, making it difficult for being available to everyone who needs it. Hence, certain games become categorized as games of riches. An example can be Car Racing, where only high-priced cars of renowned companies took part. This is because of the heavy investment required for developing that invention and its subsequent maintenance. Also, India's lesser flourishing sports

academies won't be able to afford it, thereby making sport development lag behind in these areas. Therefore, a perfect balance between the two has to be sought after.

Conclusion

Summing up everything discussed above, it is clear that like a coin that has two faces, similarly, every situation or circumstance has a dual effect. For Sports patents, it is also the same. One way of overcoming this challenge is to ask the government to fund such equipment. Even NGOs and other voluntary bodies can be asked to do it. Even sports manufacturing companies can have a separate wing to overcome these challenges. This ensures that the sports spirit of *Citius, Altius, Fortius* (Faster, Higher, Stronger-Together)^v always prevails.

ⁱ Anonymous, "Athletics Federation of India imports KTG machine to 'develop strength' of javelin throwers" (ANI 29th May, 2021) <<https://www.aninews.in/news/sports/others/athletics-federation-of-india-imports-ktg-machine-to-develop-strength-of-javelin-throwers20210529151341/>> accessed on 20th October, 2021.

ⁱⁱ Anonymous, 'Treadmill Patents (Class D21/669)' (Justia Patents) <<https://patents.justia.com/patents-by-us-classification/D21/669>>, accessed on 20th October, 2021.

ⁱⁱⁱ Vitor Sergio Moreira, 'The Role of Patents in Sports' (Inventa International 19th June 2019) <https://inventa.com/en/news/article/415/the-role-of-patents-in-sports?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration>, accessed on 20th October, 2021.

^{iv} Id.

^v Anonymous, The Olympic Motto (International Olympic Committee) <<https://olympics.com/ioc/olympic-motto>> accessed on 20th October, 2021.

WHEN IPRs AND THE OLYMPICS OVERLAP: AN ANALYSIS

- *Shreya Sampathkumar*

Introduction

The Olympics is a celebration of athletic competitiveness and global unity that bases its foundation on sport. However, in order to sustain and deliver on the values that the Olympics stands for, the Olympic committees must protect all elements of value and individuality with the help of a strong system of intellectual property protection. With the involvement of thousands of players and a massive international audience, sponsorships are created, with the host countries transferring all related rights with respect to the Olympic sponsors to host countriesⁱ. When it comes down to the Olympics, marketing is a phenomenon of increasing concern and importance. This current article will enlighten its readers on the numerous IP concepts concerning the Olympics.

How do IPRs Play Out in the Olympics?

At the outset, when a certain city wishes to host the Olympics, they must display their interest to their own National Olympic Committees. After this process, they must register their trademarks (Logos and so on).ⁱⁱ The earlier the domain registration, the lower the chance of preventing misuses in later scenarios.

Cities that wish to take part in the formal trial to enter

the Olympics must have a complete plan and various literary, artistic works and audiovisual compositions that are wholly eligible for copyright protection. In addition to these, there must be mascots, symbols, brands, emblems, slogans and broadcasting works that must be eligible for trademark or industrial design protection.

The IP in relation to the Olympics is owned by the International Olympic Committee or the IOC, which is a non-profit organization responsible for conducting the summer and the winter Olympics. It has an objective to handle individuality protection and establish its significance in intellectual property.

One such example of IP protection is that of the Olympic Torch event. Alongside this, the Olympic logo with five interconnected rings is called the “Olympic Five Rings”, which happen to be one of the most well-recognized symbols in the entire world. The World Intellectual Property Organization (WIPO) protects the Olympic Symbol through the Nairobi Treaty. Appropriate measures are put forth for the usage of the logo for commercial purposes unless the IOC permits such usage.

With regard to symbols, the event’s official mascot is a brand and respective pictograms denote the various sports and medals for each of them. “Ambush

Marketing” is a term used to describe the practice of hijacking another brand’s advertisement regime to promote another, which is a problem that modern-day Olympic IP Protection seeks to address. An example of this is the 1992 France Winter Olympics where Visa was its official sponsor.

Sponsoring is an easy way for a brand to start making money. The most valuable resource of the Olympic intellectual property is in the form of broadcasting rights, accounting for around 73% of the IOC’s revenue. The very reason for the involvement of IPR is to protect sponsorshipsⁱⁱⁱ.

Dealing with ‘Ambush Marketing’

The definition of the term ‘Ambush Marketing’ in the Olympics, can be stated as follows: “A practice wherein a company, which is more often than not, a competitor of a certain Olympic event’s sponsor draws the public attention surrounding the event to itself and away from the sponsor, thereby capitalizing on the investment that the sponsor has made.”^{iv} This is an orchestrated attempt by non-sponsors to connect themselves with the event in the eyes of the consumers. In its objective to prevent this phenomenon from occurring, the IOC has all its host countries implement strict anti-ambush marketing legislations at every step of conducting the Games.^v

While exploring the effect that ‘Ambush Marketing’ has on these sponsors, an important concept to introduce is that of ‘Clutter’. The phrase refers to the plethora of competing attempts of communication to attract the attention of consumers, fans and

audiences.^{vi} These two concepts are closely intertwined and just like other forms of infringement, threatens to dilute the goodwill and market value of brand associations when coupled together.

The real question here becomes that of how one can effectively tackle these forms of infringement while effectively avoiding problems that rigid anti-ambush marketing laws might pose to potential sponsorship opportunities. Firstly, the issue of ‘Clutter’ must be resolved by implementing strategies to reduce the likelihood of confusion in the minds of consumers. Next, there must be strategic announcements of sponsorships with events. Appropriate investments must be made in order to cash in from all the benefits that sponsoring an event could bring to a brand. Techniques such as advertising, hospitality and promotions must be tactfully planned. The earlier and stronger the imprint of such sponsorships are made, the stronger the protection against ‘Clutter’ and ‘Ambush Marketing’. Public relations becomes the most vital role in this scenario. They can take measures such as condemning such ambushers by using beloved athletes to educate the public about such unethical practices that companies use. Meetings, press conferences and campaigns can be effective tools to propagate this awareness.

A thorough understanding of ‘Ambush Marketing’ makes one realise that it deserves a category for itself in the realm of IP. The methods, strategies and tactics to combat associated infringement becomes a task that requires further research and special knowledge^{vii}.

The Rational for a Strong Protection Regime

In understanding the reasons for such a thorough system of IP protection, it is pertinent to consider the importance of funding sources to conduct the Olympics and its further advancement. Without these sponsorships, the Olympics itself would not exist.

The Olympic symbol, designed in 1912 by Baron Pierre de Coubertin, was never expected to turn into one of the most well-recognised international brands. The current value of the Olympic brand is well over 30 billion pounds, according to The Guardian.

The culmination of all threats to Olympic IP has led to the IOC enacting strict standards for its protection. The Olympic Charter dictates that the IOC may take all necessary measures to legally protect itself nationally and internationally with regard to all rights over the Olympics and all IP concerning the same. The heavy competition has brought about a regime of strict protection that every host country must abide by.

The Olympic Charter has all rights to license all or parts of its rights based on the terms and conditions set forth by the IOC to prevent all host countries from access that violates the charter for the benefit of the IOC and to protect all works that fall under its ambit. However, there is an authorised right to non-profit use of the Olympic symbol, flag, motto and anthem subject to prior approval of the IOC. In addition to this, the IOC registers all its trademarks under the WIPO Madrid System.

The protection in the host city is established by way of the Host City Contract and requires the host country to begin vigorously protecting the IOC's IP. While the IP is protected, every feasible measure must be taken by the NOC and the related details should compulsorily be taken by the NOC^{viii}.

Conclusion

The current system of Olympic IP protection in the US seems to fall on the utilitarian aspect and creates serious profits for those who control the events, especially those that are highly viewed by the sporting community. A need to strike a balance between those who control sport production and those who view these events springs before law enforcement. While it is impossible to implement a fantasy that ensures the perfect balance between the two, there may be a possibility that intellectual property may push its boundaries further for the enjoyment that fans of sports are entitled to^{ix}.

Intellectual property protection is involved in the process of conducting the games in one host country until it moves on to the next. Sponsors and affiliates receive a good share of this protection to secure funding and income in addition to crediting artists and producers for their work and skill. The spirit enshrined in the form of the various types of IP, brings forth the values of unity, collectiveness and cooperation which the games also uphold. This promotes worldwide development, improvements in the conduct of the games^x.

ⁱ Castro C, “Intellectual Property and the Olympic Games” (wipo.int April 2019)

<https://www.wipo.int/ip-outreach/en/ipday/2019/intellectual_property_olympic_games.html> accessed October 17, 2021.

ⁱⁱ Raheja K, “Intellectual Property and Their Role in Olympic Games - Intellectual Property - Worldwide” (Mondaq August 3, 2021)

<<https://www.mondaq.com/india/trademark/1098284/intellectual-property-and-their-role-in-olympic-games>> accessed October 17, 2021.

ⁱⁱⁱ Séguin B and Scassa T, “Ambush Marketing Legislation to Protect Olympic Sponsors: A Step Too Far in the Name of Brand Protection?,”

Intellectual property for the 21st Century: Interdisciplinary approaches (Irwin Law 2014).

^{iv} Jennifer L. Donatuti, Can China Protect the Olympics, or Should the Olympics Be Protected from China?, 15 J. Intell. Prop. L. 203 (2007).

^v Rule 40, Bye-law paragraph 3 of the Olympic Charter dictates that “Except as permitted by the

IOC Executive Board, no competitor, coach, trainer or official who participates in the Olympic Games may allow his person, name, picture or sports performances to be used for advertising purposes during the Olympic Games”.

^{vi} Supra at 4.

^{vii} Supra at 2.

^{viii} Kim D, “In the Spirit of Fair Play: A Primer on IP and the Olympics” (Intellectual Property Watch August 2, 2012) <<https://www.ip-watch.org/2012/08/02/in-the-spirit-of-fair-play-a-primer-on-ip-and-the-olympic-s/>> accessed October 17, 2021.

^{ix} Hylton JG, “The over-Protection of Intellectual Property Rights in Sport in the United States and Elsewhere*” (2011) 21 Journal of Legal Aspects of Sport 43.

^x Supra at 4.

CASE INGOTS

M/s.Matrimony.com Limited v. Silicon Valley Infomedia Private Limited- 2021 SCC OnLine Mad 5463

The plaintiff filed a lawsuit seeking an injunction to prevent the defendant from infringing on his registered trademark BHARATMATRIMONY and its variants. Plaintiff's business was in operation since 2001, and used the internet as a venue for marriage alliances. The defendant had falsely adopted the plaintiff's trademark. If the same mark is used for the same service, the Court will presume infringement under Section 29(3). Thus, according to Section 29, the court held that the defendant's usage of the domain name www.bharatmatrimony.org, was infringement. A permanent injunction restraining the defendant was given and they were asked to destroy all the data where the mark was used.

TATA Sons Private Limited v. Hakunamatata Tata Founders and Ors CS(COMM) 316/2021 & I.A.8000/2021

Tata Sons Limited has been providing financial services, including crypto-currencies, under the trademark "Tata," whereas Hakunamatata Tata Founders & Ors deal in crypto-currency under the name "Tata coin/\$Tata" in the US and the UK. Plaintiffs sought a permanent injunction prohibiting Defendants from using the trademark "Tata". The High Court concluded that the Trademarks Act and the CPC are only applicable within India. In case of internet infringements, the Court's decision may apply to entities located abroad, only if their activity is connected to India. In the instant case, since the intent to target India by the defendant could not be proved, the case was dismissed.

Yashram Lifestyle Brands Pvt Ltd vs Aditya Birla Fashion And Retail Limited (Madura F And L Division) I.A.NO.1/2020 IN O.S.NO.4/2021

Yashram, the plaintiff, addressed the Court, claiming that Aditya Birla Fashion and Retail Ltd. had infringed its patent on a sanitary undergarment known as 'Cotton Sensation Stay Dry Period Panty' and 'Period Panty.' The Karnataka High Court granted an ex-parte temporary injunction prohibiting Aditya Birla Fashion and Retail Limited from further producing and selling sanitary underwear, which the plaintiff, Yashram Lifestyle, has patented. According to the Karnataka High Court, the alleged patent infringement 'causes hardship to the plaintiffs' who invented the infringing goods.

UNDERSTANDING LICENSING IN THE WORLD OF SPORTS

- *Ananya Deswal*

Introduction

Fair play, tolerance, team spirit and teamwork, self-discipline and control, understanding and patience, focus, dedication, problem-solving skills, a winning attitude, good health due to regular exercising, etc., are only a few of the positives of playing sports. Like how being close to nature or music heals some people, sport is a haven for many people across the globe. Whether that be people just being involved in playing a specific sport or coming up with new and better technology to help advance the world of sports. Thus, the importance of sports - as a holistic sector that involves an individual's body and brain and mind - cannot be overlooked. When hard work, creativity, innovation, perseverance, resilience, and research are some of the foundational milestones in the sports sector, how can Intellectual Property Rights not have an integral role in this area?

IPR's presence in Sports is visible when we look at transactions/interactions related to sponsorship, licensing, franchising, merchandising, broadcasting, technological innovations and more.ⁱ In this article, my main focus is covering the concept of licensing when it comes to the intertwined world of Sports and IPR and how that

affects the sector. There also is an attempt to look at the issues that plague the field and the future of licensing and IPR in the world of Sports.

What is Licensing?

Licensing can be understood as an agreement between two or more parties - the licensor and the licensee, wherein what is to be licensed is defined with other conditions like the rights of the parties, financial requirements ('royalty'), obligations, etc.ⁱⁱ Essentially speaking, having a license of something provides the licensee with certain rights regarding the licensed material (for use in conjunction with a product, service or promotion), without actually transferring the ownership rights. It thereby allows the licensee to make use of the intellectual property of another in exchange for a certain fee, as decided between the concerned parties.

A license can be applied for any kind of Intellectual Property - technology, patents, copyright, design, technical "know-how", etc.ⁱⁱⁱ The thing to note here is that the licensee does not have rights of the owner but rather those rights that have been agreed upon in the licensing agreement. The scope of licenses can range from telling the licensing how to use the licensed

material or having details regarding the manufacturing or modification aspects, etc. In India, The Patents Act (Section 68), and the Designs Act (Section 30) mandate the registration of license agreement after it is considered to have been executed and decided upon. The Copyright Act does not require such mandatory registration (this is evident upon reading Section 45(1) and Section 51 of the Copyright Act). It is also mandated under most acts to ensure that the licensing agreement is in writing so that there exists no chance of ambiguity regarding any of the conditions agreed upon by the parties in question.

Licensing in the Sports Sector

As mentioned above, any protected content can be licensed with a proper agreement and if the requirements of the law are followed. The world of sports is no exception to the phenomenon of licensing. Licensing in the sporting world can be understood as a ‘contractual agreement’ between parties, wherein, the licensor/ owner of the protected content provides the right to use the image or a logo or the name of an athlete or an event or a team or an organization for research, merchandising, advertising, sales, branding, etc.^{iv} The main reason behind sports licensing is to ensure that the money that companies make off athletes, their names, logos of teams, etc. is done so in exchange of a fee/royalty and thus it respects the intellectual property of the individuals/teams and through licensing, helps increase the brand

value and helps profit both the parties. It also helps in achieving better engagement with the fans and thus increases the market value of the products. Licensing allows individuals or teams to help expand their fanbase, due to the collaboration with apparels, or merchandising companies. Adding to this, there are TV and non-TV deals that increase the brand value of the individual/team and thereby profits the licensee parties as well.

There are many examples - The National Football League (NFL) which was the first major organisation to come up with its own formal licensing agreements and had partnered with numerous brands like Adidas, Dallas Cowboys Merchandising, Electronic Arts, Pegasus Sports, Tokyo Time, etc.^v An NFLPA license provides rights for over 2,000 current NFL players through its group licensing program. The group license is for six or more players.^{vi} All these licenses and deals have resulted in The NFL earning over \$9.5 billion in national revenue in 2020.^{vii}

Another example is the World Wrestling Entertainment (WWE) - its worldwide licensing program resulted in long and successful partnerships with companies across the globe which lead and continues to lead the creation of products featuring WWE’s marks and logos, copyrighted works and characters in diverse categories, including toys, video games, apparel,

housewares, books and more. WWE licensed products, created by more than 150 licensees in more than 100 countries across the globe, have been made available at all major retailers, like Amazon, Walmart, Target, GameStop, Walgreens, Barnes & Noble, etc.^{viii} This has led to the massive increase in its fanbase 'WWE Universe' and these licensing deals have contributed greatly to their annual revenue.

Yet another, and probably the most important example of the use of licensing in Sports Industry are the Olympics. The intellectual property (IP) system, essentially trademarks, play a vital role in safeguarding the unique character of the Olympic Games and their identifications, including the Olympic symbol, Olympic emblems, the flag, the torch and the anthem. "The Olympic Licensing Programmes produce officially licensed products from the organizing committees for the Olympic Games, the National Olympic Committees and the IOC."^{ix} "These commemorative products bear the emblems and mascots of the Olympic Games or Olympic teams. By maintaining high merchandising standards, they act as creative and pro-active custodians of the Olympic brand, enhancing the Olympic image and ensuring quality goods for the public."^x

The Future of Licensing and IPR in the Sports World

The world at present has been able to establish IPR laws to protect and rightly compensate people for their intellectual property - whether that be in the area of literature, scientific innovations or even naming and merchandise rights in sports. However, it will not be wise to deny that there are no loopholes when it comes to licensing and IPR in the sporting world. Ambush marketing is one of the most utilised method of "hoping on" and taking a "free-ride" on the momentum that builds in regards with an individual, a team or a sporting event.^{xi} But it is for us to decide whether to consider this practice a foe to the growth of the sports sector or to look at it as a friend that helps boost the related industries and concerned people. E.g) Nike's ambush marketing strategy during the Olympic games of 1996, held in Atlanta. The Olympic Gold medalist, Michael Johnson's gold Nike sneakers have not been forgotten by any sports fan and despite Reebok being the official sponsor of the games, the limelight was swayed away to shine on Nike, which established the company as one of the major competitors in the Sports Fashion world.^{xii}

Digital media is one another aspect that essentially controls how the future of licensing and IPR in sports will look like. The COVID 19 pandemic forced us all to operate online and entertainment in the form of movies, e-sports, online viewing of events provided us with the much-needed escape from the depressing state of

affairs across the globe. According to Forbes, IPR and Sports need to merge and experiment with esports and virtual reality to cater to the growing expectations of the younger generations.^{xiii}

Conclusion

At this point, it is clear as to how licensing impacts the sports sector by helping the athletes, their teams, sporting events, etc. grow a huge fanbase and how that brings in huge profits for not only the players but also the companies that have the license to use the intellectual property of these

entities. Licensing also ensures that the owners of the protected content benefit from it while also giving them the avenue to generate royalty for themselves by licensing out their patents, copyrights and more. All of this essentially helps to enhance their brand value and also helps establish and grow numerous companies that they partner with. Licensing in the field of sports has been around for quite a while but with the increasing use of digital media, IPR laws might have to look into this aspect to better work with the advancing society.

ⁱ World Intellectual Property Organization (WIPO), 'Sport and Intellectual Property' < www.wipo.int/ip-sport/en/ > accessed October 15, 2021.

ⁱⁱ Yumiko Hamano, "Introduction to License" (WIPO), <https://www.wipo.int/edocs/mdocs/aspac/en/wipo_ip_bkk_17/wipo_ip_bkk_17_19.pdf> accessed October 18, 2021.

ⁱⁱⁱ 'Intellectual Property Licensing in India' (Obhan & Associates) <www.obhanandassociates.com/blog/intellectual-property-licensing-in-india/> accessed October 15, 2021.

^{iv} Riccardo Tafa, "Licensing and Co-Branding, 2 Opportunities to Invest in Sports Marketing" (*RTR Sports Marketing*) <<https://rtrsports.com/en/blog/licensing-co-branding-2-opportunities-invest-sport/>> accessed October 18, 2021.

^v NFL PLAYERS INC., 'Licensees' (*NFLPA*) < <https://nflpa.com/partners/licensees> > accessed October 16, 2021.

^{vi} NFL PLAYERS INC., 'Licensing' (*NFLPA*) < <https://nflpa.com/partners/licensing> > accessed October 16, 2021.

^{vii} Jakob Eckstein, 'How The NFL Makes Money' (*Investopedia*, 10 September 2021) < www.investopedia.com/articles/personal-finance/062515/how-nfl-makes-money.asp > accessed October 17, 2021.

^{viii} World Wrestling Entertainment Inc., 'Licensing' (*Corporate.wwe*) <<https://corporate.wwe.com/what-we-do/consumer-products/licensing>> accessed October 17, 2021.

^{ix} 'Licensing Programme' (*International Olympic Committee*) < <https://olympics.com/ioc/licensing> > accessed October 17, 2021.

^x World Intellectual Property Organization (WIPO), 'The Olympic Games' <www.wipo.int/ip-sport/en/olympic.html> accessed October 19, 2021.

^{xi} Shruti Gulati, "Ambush Marketing: The Unofficial Free Riding" (*GRANTHAALAYAH*, September 30, 2016) <<https://www.granthaalayahpublication.org/jour>

nals/index.php/granthaalayah/article/view/IJRG16_C09_126 > accessed October 17, 2021.

^{xii} Hannah Spruce, '3 Times Nike Ambushed the Olympics' (*High Speed Training*, 29 March 2016)

<www.highspeedtraining.co.uk/hub/ambush-marketing-sport/ > accessed October 19, 2021.

^{xiii} Toni Fitzgerald, 'How Sports Licensing Deals Must Evolve In The Digital Era' (*Forbes*, 5 September 2018)

<<https://www.forbes.com/sites/tonifitzgerald/2018/09/05/how-sports-licensing-deals-must-evolve-in-the-digital-era/> > accessed October 20, 2021.

THE INTERNATIONAL SCENARIO ON TRADEMARK PROTECTION OF SPORTS ASSOCIATIONS AND BRANDS

- *Lilian Grace Thomas*

Introduction

The tremendous growth in the number of sports teams and brands has seen an increase in the registration of trademarks by professional sports leagues and organisations. This has particularly led to the increase in litigation in this niche area, and the introduction of several guidelines regarding sports trademarks. The increased consumer demand has also garnered intense competition in the field, thereby increasing the reliance on the governance of trademarks, and various courts' decisions and interpretations. The following article deliberates upon imperative issues considered in cases from the European Union, UK, and US with respect to sports trademarks and their usage.

The Role of Secondary Meaning under Trademarks for Sports Brands

With regard to team names or their nicknames, and team player names or their numbers, several issues may arise while manufacturing sporting apparel including these names, symbols, or terms and whether they can be considered as trademarks. It is also a common practice for team names to be associated with the country or region of origin. However, it is usually not possible to register a city's name as a trademark if it consists of the toponym.ⁱ A pressing concern that crops up is the ability or likelihood of the public to confuse these goods as being endorsed by the sports league itself. This can be in the form of primary and secondary meaning which an average consumer associates to a product.

The attribution of a secondary meaning is the product of one's mental ability to associate certain symbols, words, colours, and designs of a good from a particular source.ⁱⁱ It essentially denotes the connection or link formed in the consumer's mind between the product bearing the mark and its source.ⁱⁱⁱ It can be described as a process of testing the 'commercial magnetism' wherein due to a mark's distinctiveness, a buyer is able to distinguish a mark from other goods in the market.^{iv} In cases where a product is easily distinguishable, the need to attribute secondary meaning will not arise.

In *Decathlon v EUIPO*,^v Decathlon filed a notice of opposition stating that the mark of the company 'Athlon' was similar to their earlier signs and their product offering included similar goods viz., sports apparel such as clothing, caps^{vi} and gymnastic and sporting articles.^{vii} The contention was based on the fact that the two names were likely to cause confusion amongst its consumers. The Court first looked into the distinctive and dominant elements of the 'Athlon' mark, which consisted of both figurative and word elements. For this, the Court thought it appropriate to examine the intrinsic qualities of the figurative elements, the word elements applied, and their respective positions.^{viii}

On the contention of the confusion between the two signs, the Court put forward two components that were essential in determining dominance on the visual front. Firstly, the impact of the elements in question on the global assessment of the likelihood of confusion, especially in cases where the similarity

arises due to the weak nature of the distinctive component. Secondly, the relevant market situation and circumstances at the time is to be taken into consideration in assessing the likelihood of confusion and should not be solely based on the similarity factor between the two signs.^{ix} In certain situations, where a mark contains both figurative and word elements, the average consumer tends to refer to the product by its name, and hence, the word element forms a distinguishing factor.^x Thus, while assessing the overall appeal of a mark in the consumer's eyes, certain characteristics such as the stylisation of words and figurative elements may overshadow others depending on the facts and circumstances of each case and the likelihood of confusion between the goods. The Court dismissed Decathlon's appeal stating that there was no likelihood of confusion as the word element 'athlon' had a weak distinctive character and that the visual aspect formed a greater part in this assessment. It also took into consideration the meaning of the term 'athlon', which is the Greek word for 'sports' or 'contest' and held that consumers were not likely to attribute such meaning as it was not common knowledge.

Significance of Distinctiveness under Sports Trademarks

The distinctive character of a trademark is determined by the capacity of the element present in the mark to identify a particular good or service for which the mark was registered and its ability to

distinguish those goods or services from offerings of other companies. In doing so, it is essential to examine the inherent qualities of the element, the relationship between the product and the mark and whether the mark qualifies in being descriptive of the goods and services for which the mark has been registered.^{xi}

In the European Union, matters relating to the rights of the EU Trademark (EUTM) are governed by Regulation EU 2017/1001.^{xii} Article 8(5) of the Regulation provides for additional protection on reputed EUTMs in the Union or the member State concerned. The application of the provision is subject to certain conditions. Firstly, the mark must be identical or similar to a previously registered trademark. Secondly, the EUTM must have a reputation. Thirdly, its usage without proper cause provides for a situation which results in an unfair advantage to the infringer or is detrimental to the distinctive character of the mark. This is based on the public's perception of the identical marks and whether they are of the belief that the two are associated with each other. This association or linkage in the minds of the public forms an essential precondition under Article 8(5).

In *Puma SE v EUIPO*, a machinery manufacturer, Doosan Machine Tools Co Ltd. applied for a registration of a figurative EUTM, which comprised the term 'Puma'.^{xiii} Puma SE filed an opposition stating that the mark was deceptively similar to an earlier mark which was affixed on the company's shoes, apparel, and bags. The Court, while assessing

the impact and damage to the reputation of Puma, looked into the average consumers of the two companies and held that these sections of consumers were entirely distinct. The target market of Doosan Co. mainly comprised of highly specialised technical professionals, whereas Puma targeted consumers interested in sports and leisure activities. It did take into consideration the overlap between the two sets of the public in the sense that professionals did purchase Puma's products. However, a necessary component of Article 8(5) is the existence of a strong reputation, especially when the two products are distinct in nature. The strength of the distinctiveness of the mark would determine the likeliness of the public to associate a newer mark with a former one.^{xiv} Moreover, the Court stated that the detriment or unfair advantage of the later mark must be so obvious, that evidence would not be required to be put forward.

The Playoff between Official and Unofficial Sports Associations

A case which arose before the Italian courts concerning unofficial sports associations and their right to use marks of official associations ended in a positive note for the latter, as it stated that official associations have the right to proceed against the former in cases of infringement. An Italian sports club incorporated in the year 1914, known as Entella (or Virtus Entella) filed an application for the club's name and the blue and white crest of the team.^{xv} An unincorporated sports association, formed in 1977

which went by the name AC Entella 1914, proceeded against Virtus Entella claiming that the latter, while selling new kits, and shirts and conducted events, infringed the unregistered trademark of the former. The Court of Genoa firstly examined whether AC Entella qualified as an enterprise in order to invoke trademark protection. This was answered in the affirmative as it regularly engaged in the sale of goods and services, and generated revenues from its football team. The Court stated that names of football clubs or teams and their litigated signs can be afforded the protection as trademarks, as they provide the distinctive feature which enables fans and consumers to identify the provider of those services.^{xvi} This further contributes to their ability to monetise assets through sponsorships, and merchandising.

In another Italian decision, the Court held that the right of a trademark owner to oppose third parties from using their trademark has a limitation period of five years, failing which, the said right will be deemed as exhausted.^{xvii} Tolerating of such usage for a period of five years would amount to acquiescence on the part of the trademark owner. A trademark infringement arises particularly when a third party uses the mark in the course of business in order to gain a commercial advantage.^{xviii} On this point, the Court found that official sports clubs may enforce their trademark rights against unofficial fan clubs that use their marks for offering goods and services, and thus assists in eliminating future competition in the market.

Conclusion

A summary of the abovementioned guidelines to be followed while determining a likelihood of confusion in relation to sports trademarks can be summed up through the case of National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.,^{xix} wherein a six-factor analysis was employed and is stated as follows:

1. Strength or weakness of the marks^{xx}
2. Similarity in appearance, sound and meaning
3. Class of goods in question
4. Marketing channels
5. Evidence of actual confusion
6. Evidence of intention in selecting and using the alleged infringed mark

In conclusion, as newer teams and brands are being constantly added in every sport, complications may arise with regard to the originality of marks, thereby bringing in legal risks and consequences. Brand or association owners' claims of popularity are not sufficient in proving the distinctiveness of a mark and must be backed by adequate evidence. On these lines, the registration of well-known marks seems to be a daunting task, especially with regard to the usage of the mark and the form in which it is registered. Moreover, overconfidence of the success of one's mark may result in more damage while bringing a dispute before the Courts, especially if the associated risks are not adequately calculated beforehand.

ⁱ Article 13, paragraph 1, Italian Industrial Property Code, Legislative Decree No. 30 of 10 February 2005.

ⁱⁱ *Levi Strauss & Co. v. Blue Bell, Inc.*, U.S. 632 F.2d 817 (9th Cir. 1980).

ⁱⁱⁱ David M. Kelly, 'Trademarks: Protection of Merchandising Properties in Professional Sports' [1983] 21 DUQ. L. Rev. 927
 <<https://dsc.duq.edu/cgi/viewcontent.cgi?article=2348&context=dlr>> accessed 15 October 2021.

^{iv} *Mishawaka Rubber & Wollen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

^v Case T-349/19 *Decathlon v EUIPO* [2020] EU: T:2020:488.

^{vi} International Classification of Goods and Services (Nice Class Headings), Class 25, 11th Ed.
 <<https://euipo.europa.eu/ec2/classheadings/?niceClassLang=en>> accessed 20 October 2021.

^{vii} International Classification of Goods and Services (Nice Class Headings), Class 28, 11th Ed.
 <<https://euipo.europa.eu/ec2/classheadings/?niceClassLang=en>> accessed 20 October 2021.

^{viii} Case T-61/14 *Monster Energy v OHIM* [2015] EU:T:2015:750, Case T-82/16 *International Gaming Projects v EUIPO* [2017] EU: T:2017:66.

^{ix} Case C-328/18 P *EUIPO v Equivalenza Manufactory* [2020] EU: C:2020:156 70.

^x Case T-381/12 *Borrajó Canelo v OHIM* [2014] EU:T:2014:119.

^{xi} Case T-234/17 *Siberian Vodka v EUIPO* [2018] EU: T:2018:259 38.

^{xii} Regulation EU 2017/1001 of 14 June 2017 OJ L154/1.

^{xiii} Case T-62/16 *Puma SE v EUIPO* [2018] EU:T:2018:604.

^{xiv} C-252/07 *Intel Corporation Inc. v CPM United Kingdom Ltd.* [2008] ECLI EU:C:2008:655.

^{xv} *Associazione Sportiva Entella Chiavari 1914 v Virtus Entella*, Court of First Instance of Genoa, Sezione specializzata in materia di Imprese, Order of 21 October 2013.

^{xvi} Article 8, Italian Industrial Property Code, Legislative Decree No. 30 of 10 February 2005.

^{xvii} Ferrari Spa v Associazione Ferrari Club Milano, Judgment No 26498, 27 November 2013 (Court of Cassation, First Chamber).

^{xviii} C-236/08 Google France SARL and Ors. v Louis Vuitton Malletier SA [2008] EU:C:2008:389, C-237

and 238/08 EU:2010:159.

^{xix} U.S. 532 F.Supp. 651 (W.D. Wash. 1982).

^{xx} Ibid at 660.

PERSONALITY RIGHTS IN SPORTS AND INTELLECTUAL PROPERTY

- *Harshini N*

Introduction:

According to the Indian Copyrights Act, the word celebrity is defined and the inference is from the word performer of Section 2(qq) of the performer which is not just restricted to the celebrities or people who perform but rather it covers a wide spectrum which includes singers, sports players, etc. The personality rights or the right to publicity protects against the unauthorized appropriation of an individual's action or performance, which would result in an undeserved commercial advantage for someone else. In the field of sports, this unauthorized use would infringe an individual's sportsperson image or the right to publicity according to Section 39 of the Act. But there is no separate codified law pertaining in India in relation to personality rights and in the status and development of such rights and laws are still in their nascent stage, mostly guided by judicial declarations.

The supreme court has not dealt with a case pertaining to this right. The most important statutory provision governing Personality Rights, on the other hand, is contained and governed as part of the fundamental right to life given by Article 21 of the Indian Constitution.

Personality Rights:

Professional players' rights may be protected through intellectual property rights (IPR). IPR works on theories that could justify the exercise of personal rights in the field of sports. Labor Theory, Personhood Theory, and Economic Justification Theory are three of these theories. The labour theory is about the person should reap the benefits of his or her own labor, which is reasonable given that players must work extremely hard to achieve their position and maintain their reputation. A sportsperson is primarily known for his sport's skills and ability and thus that person is allowed to benefit economically

from their sportsperson's reputation. The personhood theory states on the basis of a sportsman's right to personality as it defines their work in the field. A person's personality and property are crossroads of major to him. Property has been established to be both internal and external, and the only thing a person possesses is his personality, which, if he does not have sovereignty over, is tantamount to slavery. The economic justification theory suggests that if a person is granted the right to his or her personality, they will work on it, which will urge them to spend significantly on money and effort in it.ⁱ Sports players must also continue to practice hard in order to enhance productivity on the field and to play effectively throughout. These theories combined established the personality rights in sports in relation to the field of Intellectual Property rights. In *Shivaji Rao Gaikwad vs. Varsha Productions*ⁱⁱ, the Madras High Court, in a case brought by renowned Indian actor Mr. Rajinikanth, noted that while there is no definition of "Personality Right" in any Indian statute, courts have recognized it in numerous judgments.

The jurisprudence behind the personality rights:

Until the emergence of social media and the internet, the publicity was done in the mode of TV, newspapers, etc but the usage of the internet changed altered the entire dynamic and made everything much more global. It was first discussed by Louis Brandeis in an article written by them where the right to publicity also was mentioned when the discussion

of the right to privacy was written but the difference was not detailed.ⁱⁱⁱ It was further discussed in the article authored by Melville Nimmer which centered primarily on the Right to publicity also called personality rights which gave a detailed version of the concept.^{iv} Because the right of publicity has been in use in the United States of America for so long, there have been numerous instances involving it, some embracing it and others rejecting it. In the year 1998, Tiger Woods was the subject of a well-known sports case. Tiger Woods' exclusive license agent, ETW Corporation, and Jireh Publishing fought the lawsuit. This case involved Rick Rush's artwork "The Masters of Augusta,"^v which was published by Jireh Publishing. Tiger Woods won the 1997 Masters Tournament in Augusta, Georgia, and the picture was created to commemorate his success. ETW Corporation filed a suit against Jireh Publication under the Lanham Act, commonly known as the Trademark Act, alleging trademark infringement, dilution of the mark, unfair competition, and false advertising. ETW claimed it engaged in unfair competition and deceptive trade practices in violation of the Ohio Revised Code, but also unfair competition, trademark infringement, and infringement of Tiger Woods' right of publicity in violation of Ohio common law. Rick Rush's painting was protected under the First Amendment, therefore there was no violation of the right to publicity, and the Lanham Act was not infringed. The problem lies therein- there being no law created confusion, though it can be seen that artistic work is safe under the first

amendment but this created confusion for the consumers and ETW Corp. The reason that the law is not determined can lead any to harm to the decision of the cases and jurisprudence depending on the situation.

The legal position in India:

ICC development Ltd v Aarvee Enterprises & Anr^{vi} was the very first case to recognize the publicity rights which enhanced the definition of publicity rights and their role in the legal system: The right of publicity developed from the right of privacy, and it can only arise in an individual or any indicia of his or her identity, such as his or her name, personality characteristic, signature, voice, and so on."^{vii} An individual may have the right of notoriety as a result of his involvement in a particular event, sport, or film. That right, however, does not belong to the event that made the individual famous, nor does it belong to the corporation that organized the event. Any attempt to transfer the right of publicity from individuals to the event's organizer, a "non-human entity," would be a violation of Articles 19 and 21 of the Indian Constitution.^{viii} No persona can be monopolized. . For example, if any entity, was to use Kapil Dev or Sachin Tendulkar's name/persona/indicia in connection with the 'World Cup' without their authorization, they would have a valid and enforceable cause of action." Furthermore, image or personality rights are a type of intellectual property (IP) right that can last even after a person's death. A name, image, or likeness of a sportsperson

is registered to be used as a trademark, then they can be licensed or authorized. Some Indian sportsmen, particularly well-known cricketers like Sachin Tendulkar and Kapil Dev, have trademarked their names or domain names for their websites to protect their image rights. "When the identity of a famous personality is used in advertising without their permission, the complaint is not that no one should commercialize their identity, but that the right to control when, where, and how their identity is used should vest with the famous personality," the court decided to write in *Titan Industries v M/S Ramkumar Jewellers*.^{ix} The right to authorize the commercial use of a person's identity is often referred to as the right to publicity." But that protection on the basis of this case is a very rare case in India where for example, For instance, the Indian government had permitted the use of a picture of John Terry, a world-renowned footballer who was the captain of England's national team, on cigarette packets. In recent years, India has been increasingly becoming a rising country in the commercialization of sports. The Indian Premier League changed the entire dimension of the commercialization of sports and the use of intellectual property rights in it. Many things changed when the Indian Premier League (IPL) began in 2008. Their leagues existed prior to 2008, but they were heavily commercialized. IPL changed the entire paradigm of sports in India and raised its economic worth. Later on, numerous sports such as kabaddi, badminton, football, and others began their own leagues, and since then, a lot has changed in

India. Even though it is well known that their image is in the public domain, their rights can be infringed on a routine basis and breach the right to privacy. Right to publicity originates from the right to privacy and other laws under Intellectual Property Rights.

Conclusion:

This can be concluded from the above discussion that a Right of Publicity Act is required. The right of publicity is a one-of-a-kind right that cannot be properly positioned under any IPR regulation to safeguard a celebrity's personality. Many countries have recognized such rights, with the United States forging ahead. Though it lacks the necessary legislation, the right has evolved through judicial jurisprudence, as discussed in the article. Even in the United Kingdom, the right to privacy and tax

regulations have been recognized. The rest of Europe, including France and Germany, has already enacted specific legislation recognizing the right of publicity. Sports is a hugely profitable market in today's modern world, accounting for around 3 percent of total international trade. A professional athlete's right to publicity should be safeguarded as it is the result of their year's hard work, and they have every right to exploit it and determine who can exploit it. Because the Indian sports business is growing at a rapid pace, sports stars are becoming increasingly exposed to exploitation. India requires legislation to safeguard its celebrities, or it might be recognized as an aspect of the right to privacy so that until such legislation is enacted, the celebrities in India are all still protected.

ⁱ Lexlifeeditor, "Personality Rights in Sports" (Lexlife India April 6, 2021)

ⁱⁱ Shivaji Rao Gaikwad vs. Varsha Production, 2015 SCC OnLine Mad 158

ⁱⁱⁱ Louis Brandeis et. Al., Right to Privacy, 4 Harvard L.R. 193 (1890)

^{iv} Melville B. Nimmer, The Right of Publicity, 19 Law and Contemporary Problems, 203-223 (1954).

^v Rick Rush: A southern artist's freedom of speech, Southern Living, <https://www.southernliving.com/culture/southern-made-rick-rush-freedom-of-speech>

^{vi} Icc Development (International) ... vs Arvee Enterprises And Anr. on 1 January, 2003 VIIAD Delhi 405, 2003 (26) PTC 245 Del, 2004 (1) RAJ 10.

^{vii} Chiramel, Christine, Intellectual Property Rights In Sports-Indian Perspective, Mondaq, 2012 <https://www.mondaq.com/india/trademark/164974/intellectual-property-rights-in-sports-indian-perspective>.

^{ix} Titan Industries Ltd. v. M/s. Ramkumar Jewellers, CS(OS) No.2662/2011, 2012 SCC OnLine Del 2382.