

# RULES OF THE GAMES



*Robert Buchan advises on how to avoid aggravation during the XX Commonwealth Games*

Scotland has been voted the third-best country to visit in 2014 by *Lonely Planet*, in part due to the fact that Glasgow is hosting the 2014 Commonwealth Games, which will see 4,500 athletes competing in 17 sports for more than 260 medals between 23 July and 3 August. Already, more than one million tickets have been sold, demonstrating the huge commercial draw of global sporting events – events that could not take place or attract international

audiences without significant financial sponsorship and investment. Given the recent success of the London Olympic Games in 2012, readers may be relatively familiar with the legal protection, including brand protection, afforded to such events. However, unless brand owners and businesses are advised as to what they can and cannot do in the run-up to and during the 2014 Games – particularly those located in or within areas in which the Games are being hosted – they could find themselves facing civil or criminal liability. To assist those advising on

the issue, this article will first consider the reasons why additional legal protection is required, then provide an overview of the 2014 Games protection that is in place.

## Why special protection?

For trade mark professionals – for whom brand protection is clearly close to their hearts – it can be easy to overlook the fact that one person's legitimate brand protection measures can be seen as another person's inability to show support for something about which they are passionate. Indeed, as evidenced by

some of the press surrounding the enforcement campaign in 2012, this difference in viewpoint can generate negative publicity for an event and its (often large, corporate) sponsors.

However, the reality is that the necessity for significant sponsorship for such high-profile events means that legal protection is required to prevent free-riding on the associated goodwill. The special measures taken are not just about protecting the investments made by current sponsors, but ensure that the legacy is maintained to allow future events to take place. And, given the huge amount of spectators involved, public health and safety is also protected by avoiding a myriad of unofficial street traders blocking access to venues.

Whether the measures are seen to be legitimate and proportionate will in large part be judged by the enforcement that takes place in relation to the event. A firm hand in the run-up may generate some negative publicity, but can send out a clear deterrent message and avoid, for example, large-scale ambush marketing during a televised event.

Meanwhile, traditional forms of IP protection still have an important role to play, for example protecting the Commonwealth Games logo, the words "Glasgow 2014", and the image and name of the official mascot "Clyde". Clearly such rights can be enforced in the usual manner. However, this article will focus on the specific additional protection that has been put in place as it is these that are likely to catch people out and, in particular, are more likely to be enforced immediately preceding and during the Games.

## Overarching legislation

The overarching legislation is the Glasgow Commonwealth Games Act 2008 with the main framework being implemented by the Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009 and the Glasgow Commonwealth Games (Trading and Advertising) (Scotland) Regulations 2013.

### Terms of infringement

The tables below contain words that if used in combination are likely to give rise to presumption of infringement

Table A

GAMES	GLASGOW
TWO THOUSAND AND FOURTEEN	MEDALS
2014	SPONSORS
XXth	GOLD
	SILVER
	BRONZE

Table B

### The Association Right

The 2009 Order came into effect in January 2010. It creates an exclusive legal right known as the Glasgow Commonwealth Games Association Right. It is infringed if, in the course of business, a person uses, in relation to goods or services, any representation that is likely to suggest to the public that there is an association between that person or their goods or services and the Games. This could cover a wide variety of activities, but in essence prevents the use of images or words in advertising or on the packaging of or the goods themselves that implies such an association. So, for example, websites looking to promote accommodation or activities in Glasgow by using the Games logo or the "Glasgow 2014" name are likely to fall foul of these rights.

Although not specified in the 2009 Order, guidance issued by the 2014 legal team indicates that although not conclusive, when assessing infringement, the following are likely to give rise to a presumption of infringement: expressions in which use is made of any two of the words set out in table A (above); or that contain any word in table A, together with one or more of the words in table B.

Therefore, a business making prominent use of "Glasgow Games" may find itself on the sharp end of an infringement action that includes injunctive relief, as well as the delivery-up or destruction of infringing materials. The Association Right lasts for six months after the closing ceremony in August 2014.

However, it is not only a one-way track! The 2009 Order provides a remedy for groundless threats of infringement proceedings in relation to the Association Right. In addition, there are several defences, such as legitimate use of a person's own name or address, use of an existing registered design or trade mark, or continuous use prior to the Order coming into effect in January 2010. In addition, infringement does not occur where the use is honest and relates, for example, to indications

of kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services. Understandably, from a practical point of view, there is also a defence for use made in a publication or broadcast about the Games.

#### Trading and advertising offences

In an effort to prevent ambush marketing, the 2013 Order creates trading and advertising offences in “event zones” during the Games. Essentially, this allows the organising committee to control advertising and outdoor trading in the vicinity of venues during, and for a period before, the event. One interesting difference between 2014 Games and the Olympic Games of 2012 is that there is not a central sporting village. Instead, there are 17 event zones in and around Glasgow, including an area in Edinburgh where the swimming events will take place. This is likely to make the work of the appointed enforcement officers (essentially they will act as trading standards officers) more of a challenge.

The trading offence is wide and prevents street trading in or around the event zones. Not only does it prevent the actual sale or offering for sale of goods or services, but also prevents seeking charitable donations or providing public entertainment. Buildings normally used as retail premises, such as restaurants or shops, are exempt, albeit they will have to ensure their displays of promotional material do not breach the separate advertising offence.

The advertising offence prevents advertising in relation to goods, services or a business in the event zones. It is wide and will prevent billboards, leafleting, providing free goods as part of a sale, branded vehicles or fancy-dress costumes promoting a business. There are specific exemptions for individuals wearing advertising attire, displaying advertisements on their bodies or carrying personal property, except where that individual knew or had reasonable cause to believe that they

were participating in an ambush marketing campaign.

As well as creating criminal offences punishable by fine, the enforcement officers have wide powers to prevent the commission of any offence by, for example, seizing articles or entering any place where they believe offences have been or are likely to be committed.

#### **Interesting times**

I am sure that the Games will be a huge success and that the legal protections in place will assist. However, the allure of a global audience for some brand owners and businesses is likely to mean that there will be a need for vigilant monitoring and appropriate enforcement. No doubt some larger sporting brands already have legal advice in place about how they can prominently advertise their brand without falling foul of the various protections. With brands and sports heavily intertwined, it will be interesting to watch both the sporting and branding games this summer.

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# Change ahead

*Tania Clark summarises the main concerns raised at an ITMA event on EU trade mark reform*

On 29 October 2013 Imogen Wiseman of Cleveland IP presented a stimulating insight into the proposed EU trade mark reform, clearly highlighting the main issues involved.

## Key proposals and concerns

### 1) Terminology

The Community Trade Mark (CTM) will be replaced with the “European Union Trade Mark”, while OHIM will be known as the “European Union Intellectual Property Agency”.

### 2) Graphical representation

The definition of the requirement for a sign to be capable of “graphical representation” is to be amended to: “capable of being represented in the Register of European Union Trade Marks in a manner which enables the competent authority and the public to determine the precise subject of the protection afforded to its proprietor.”

One question is how will this sit with the well-known criteria relating to “graphical representation” set out by the Court of Justice of the European Union (CJEU) in *Sieckmann v Deutsches Patent- und Markenamt*, Case 273/100. Perhaps these criteria ought to be reflected in the new legislative provisions? *Prima facie*, it appears that the proposed wording would permit the acceptance of smells and sounds as trade marks, as well as allowing for moving images to be represented by digital methods, rather than a series of stills and an accompanying description.

### 3) Absolute grounds of refusal

National offices ought to object to trade mark applications that would fall foul of trade mark laws in other Member States. Offices should refuse applications in a foreign language or script that, when translated into an official language of any Member State, would be incapable of registration. This will increase the burden on offices to understand the implications of the translation or transliteration of trade marks.

### 4) Acquired distinctiveness

There ought to be acceptance of evidence of acquired distinctiveness that originates from after the filing date of the application. This will create an additional administrative burden on the relevant offices to evaluate and place weight on evidence from different stages in the application process. For example, if evidence only after the filing date is submitted, should this be treated with less value as the same evidence dated prior to the filing date?

### 5) Double identity

Where the marks and goods or services are identical, infringing use must affect the origin function of the trade mark in question. There is no acknowledgement of the other trade mark functions set out in *L'Oréal*, for example communication, advertisement and investment. This may lead to referrals to the CJEU to

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clarify the true scope of function(s) of a trade mark.

### 6) Goods in transit

The European Commission would like to introduce a provision allowing trade mark owners to prevent the import of counterfeit goods into the EU without being released for free circulation, so long as the trade mark is registered in the country of destination.

### 7) Goods and services

There will be individual class fees for CTM applications; the current model of paying fees for up to three classes will be removed. In addition, the Commission would wish for the IP Translator decision to be codified.

### 8) Relative grounds for refusal

National offices ought to limit their examination to absolute grounds. This would result in the uniform removal of relative grounds examination across the EU. However, this would be without prejudice to offices providing searches and notifications on a purely informative basis.

### 9) Marks with reputation

Where cases rely on the reputation of an earlier mark, the reputation must reside in the Member State where the action is brought. For example, when objecting to a French application based on the reputation of a CTM, the earlier mark covered by the CTM must have a reputation in France.

### 10) Bad faith opposition

The Commission supports allowing owners of earlier marks to oppose bad faith applications in the EU where the contested application might be confused with an earlier mark protected outside of the EU. But why should owners within the EU be omitted from the benefit of this?

The proposed amendments are now being scrutinised by the European Council and we ought to know further about the breadth of the resulting changes in the next six to 12 months.

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