

Intellectual property

FIFA scores opening goal

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The honour of scoring the first goal in the 2010 Soccer World Cup has gone to FIFA. In the contest between FIFA and ambush marketers FIFA has shot into an early 1 – 0 lead. In the first encounter FIFA put a rocket past the defence of Eastwood Tavern in the opening exchanges. In so doing FIFA has shown its supporters and opponents alike what it is made of and what it can do.

ing. It also found the playing fields, and more particularly the South African legal system and specialist intellectual property law firms, were of a world class standard and this meant that, provided the proper strategy and game plan were put in place and the skills of the players properly harnessed, there would be a good prospect of it coming out of the contest triumphant.

The first step was to ensure that it could make the most of the favourable conditions. This meant taking comprehensive steps to put measures in place to enable it to assert its rights in connection of the 2010 tournament. This entailed embarking on an extensive trade mark registration programme covering trademarks such as SOUTH AFRICA 2010, WORLD CUP 2010. Once the official emblem had been devised, steps were taken

to register it widely as a trade mark as well as a design under the Designs Act. To supplement these measures, application was made to the Minister of Trade and Industry to declare the principal trade marks associated with the event as prohibited marks under s15 of the Merchandise Marks Act.

All these measures were, however, somewhat secondary to the main thrust of its plan of attack which was to utilise the provisions of s15A of the Act which empowers the Minister of Trade and Industry to designate major sporting events as so called “protected events”. By this means ambush marketers can be prevented from competing unlawfully with FIFA by obtaining special promotional benefit from, or associating themselves with, the 2010 World Cup, without being sponsors. This object was achieved in May 2006, when the Minister of Trade and Industry published a notice declaring the event to be protected.

Having done all the ground work for the implementation of its game plan, the next step was to harmonise and synchronise its players with the game plan. This entailed preparing a template for a civil court case to be brought against an ambush marketer. In so doing ground-breaking causes of action and arguments were formulated. In particular, a method had to be devised to enable FIFA to pursue a civil claim against an ambush marketer based on the anti-ambush marketing provisions of s15A of the Merchandise Marks Act, that create a criminal offence.

An unlawful competition argument was formulated utilising the principle that, in breaching the



This achievement has not come about through luck or as an opportunistic effort against the run of play. Rather, it has been the result of meticulous planning and a well formulated strategy and game plan. When the opportunity presented itself, FIFA moved quickly and decisively in implementing its strategy. The result was a deserved goal which should set the pattern for the remainder of the contest.

FIFA's planning and strategising to vanquish its opponents, that is, the ambush marketers, in the 2010 World Cup began as long ago as in 2004, when the contest was first announced. At that time, FIFA assessed its ability to conquer its opponents under South African conditions, and in particular in terms of South African law. It found the conditions favourable because South African law had, by virtue of previous world cup tournaments, put in place very effective world leading legislation dealing with ambush market-



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criminal provisions and thus entering into direct competition with FIFA's sponsor's for the 2010 World Cup, ambush marketers were perpetrating conduct which was objectively unlawful, being a criminal offence, and were causing damage to FIFA by prejudicing its relations with its sponsors. By virtue of the large sponsorship fees paid by sponsors of the tournament, it is essential to the success of the sponsorship arrangements that FIFA should be able to guarantee and deliver exclusivity of advertising exposure to their sponsors in their various fields of business.

Damaging the relationship between FIFA and its sponsors by detracting from the exclusive rights given to sponsors, could seriously damage FIFA and indeed place the staging of future World Cup soccer tournaments in jeopardy. Relying on this argument also enables FIFA to use the criminal provisions of s9(b) of the Trade Practices Act which prohibits persons from making unauthorised associations between themselves and a sponsored event.

Everything was set for FIFA's game plan to be put to the test. A goal scoring opportunity was sought. This was provided by Eastwood Tavern, a restaurant located very close to the Loftus Stadium in Pretoria, one of the match venues for the 2010 World Cup. Eastwood Tavern supplemented their main signage displaying its name by emblazing it with the legend "World Cup 2010." At the same time, banners were erected featuring the flags of a number of prominent soccer playing countries accompanied by the numerals 2010 as well as the words "Twenty Ten South Africa." FIFA took the gap presented with alacrity.

An application was launched in FIFA's name in the Pretoria High Court claiming interdicts against Eastwood Tavern on the grounds of infringing the registered trade marks WORLD CUP 2010, SOUTH AFRICA 2010 and TWENTY TEN SOUTH AFRICA, passing off under the common law, and unlawful competition through violating s15A of the Merchandise Marks Act and s9(d) of the Trade Practices Act. FIFA also claimed the costs of the court proceedings against Eastwood Tavern. The case achieved the desired result when an order granting all the relief sought was made in the High Court of South Africa (North Gauteng), Pretoria on April 7 2009. The game plan devised and implemented over a period of five years has produced a timely score some two months before the Confederations Cup Tournament, the dress rehearsal for the 2010 World Cup, and just over a year before the main tournament itself.

The implications of the first attack mounted by FIFA resulting in an emphatic goal being scored are significant. FIFA has demonstrated that it has an effective game plan and the will, the team and general wherewithal to score those goals. Would-be ambush marketers would do well to take note of this situation. South Africa and traders in the South African market should best not come out as losers in the FIFA 2010 World Cup. ♦

Dean is a partner of Spoor & Fisher; the firm played a leading role in the action against Eastwood Tavern