

## **FIFA's German 2006 world cup marks partially cancelled**

The German Federal Patent Court (FPC) has cancelled the Fédération Internationale de Football Association's (FIFA) registrations for FUSSBALL WM 2006 and WM 2006 for goods and services directly relating to the organization of sporting events on the grounds that they were descriptive and lacked distinctiveness as 'Fussball' means 'football' and WM stands for Weltmeisterschaft, meaning 'world championship' (Joined Cases 32 W (pat) 238/04 and 32 W (pat) 237/04, August 3 2005).

FIFA obtained registration for the three marks in July 2002 and March 2003. Three companies, including confectionery producer Ferrero, filed applications to cancel the marks in July, September and December 2003. They argued that the marks were descriptive and devoid of distinctive character. Additionally, they claimed that FIFA had acted in bad faith when filing the applications.

The German Patent and Trademark Office (PTO) combined the three proceedings and cancelled the three registrations for all the goods and services for which they were registered following an oral hearing in October 2004. The PTO found that the marks were mere references to the 2006 soccer championship and therefore were devoid of any distinctive character.

FIFA appealed to the FPC. It pointed out that it has a monopoly on the organization of the soccer world championship and argued that the marks had become distinctive in relation to the "organization of sporting events, namely the soccer world championship" as a consequence of the use that has been made of them.

The court first noted that FIFA's alleged monopoly does not have an impact on the assessment of the descriptive character of the marks. It held that the terms should remain available to the general public to describe the event without restriction.

The court found the marks to be descriptive for sporting events and services related to this type of event, such as travel arrangements, advertising, and provision of food, drinks and entertainment. It also held that the marks were descriptive for media products and services related to the media exploitation and commercialization of such events. Accordingly, it cancelled the marks in relation to these goods and services. It also cancelled the registrations in relation to:

- sports goods and products aimed at sports fans;
- shoes and clothing in general;
- authorization systems;
- measurements;
- promotion;
- souvenirs; and
- training services.

Surprisingly, the court did not cancel the registrations in relation to merchandising because it took the view that these articles are not specific to soccer world championships and, therefore, the application of the marks to these products could not be found to be descriptive of the products in question. The court did not agree with FIFA that the marks have acquired distinctiveness for the "organization of sporting events, namely soccer world championships" in consequence of the use that has been made of them because the marks had only been used in connection with the name FIFA and, in some instances, also with FIFA's logo. Moreover, a survey showed that a large proportion of the public did not associate the marks with FIFA. Consequently, the court held that FIFA had failed to prove that the marks had acquired distinctiveness. Accordingly, the FPC dismissed the appeal partially and cancelled the registration of the marks for all the goods and services that were in direct relation to the organization of the soccer world championship while maintaining the registration for all other goods, in particular, product merchandising. In view of the high economic importance of the trademarks to FIFA (the exclusive marketing rights of the sponsors amount to nearly €700 million), FIFA has already filed an appeal with the Federal Supreme Court, which is prepared to decide on the case before the soccer

world championship takes place next summer.  
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