



# IS IT GAME SET AND MATCH FEDERER?

*By Donvay Wegierski, Director*

## LEGAL BRIEF AUGUST 2018

Roger Federer, holder of eight Wimbledon men's singles titles and currently ranked no. 2 in the world in men's tennis singles, he is one of the greatest tennis players of all time. With an estimated net worth of US\$450 million, he has at the age of thirty six entered a US\$300 million contract with Japanese casual wear, designer, manufacturer and clothing retailer Uniqlo, currently valid until he turns forty seven.



This impressive deal ends Federer's twenty-year contract with Nike, in terms of, which he is said to have earned US\$10 million annually. A trade mark issue has, however, transpired concerning Roger Federer's initials, which have been used extensively on Nike's range of branded gear that many may be familiar with:



It is reported that the Nike group are the registered owners of this trade mark in various territories around the world in class 25, the main class for clothing, footwear and headgear. This means that if any other unauthorised party, in this case Uniqlo, were to use RF on its clothing and related gear, Nike would be in a position to stop them from doing so since they own the registered trade mark, and any unauthorised use would be trade mark infringement. This is despite the fact that RF are Federer's initials.

The question concerning ownership and use of personal names is not new. The South African Trade Marks Act provides that it is a defence to use one's personal name provided that this use is 'consistent with fair practice', while in the EU it is a defence to use one's personal name if is 'in accordance with honest practices in industrial or commercial matters'.

Federer has requested Nike to transfer the trade mark to himself, because the mark comprises his initials, which would surely be "in accordance with honest practice". It turns out, however, that the issue is not quite as simple as the question concerns the terms of the commercial contract entered between Federer and Nike and where the goodwill in the trade marks and intellectual property resides now that it has terminated. It is also not clear whether the own name defence applies to initials.

The match between Kevin Anderson and Federer had all tennis fans and South African supporters glued to their seats, and it will be interesting to see how this trade mark issue transpires.

In last month's Legal Brief <https://www.werksmans.com/legal-briefs-view/trade-marks-sports-creation-superstars/>, some of the world's greatest footballers named highlight the sheer magnitude of superstar status and the brand value associated therewith. Italian club Juventus has since agreed a hefty £105 million (approximately US\$140 million) transfer fee for Cristiano Ronaldo's move from Real Madrid and with reported record sales of over 520 000 Juventus shirts in 24 hours at an approximate cost of US\$90 per shirt, this fee will be recouped in no time.

#### BEST PRACTICE

Trade mark registrations for logos, names (even nick names) and new brands provide statutory protection against unauthorised use and can be licensed for royalties. Trade marks are both territory and class specific and are perpetual on payment of renewal fees, usually every ten years.

While sportsmen, popstars, movie stars and indeed any public figure should take the necessary steps to ensure that trade marks be filed extensively and protect all intellectual property at the outset, the principle applies to all contracts commercialising intellectual property.

Legal notice: Nothing in this publication should be construed as legal advice from any lawyer or this firm. Readers are advised to consult professional legal advisers for guidance on legislation which may affect their businesses.

© 2018 Werksmans Incorporated trading as Werksmans Attorneys. All rights reserved.

## CONTACT THE AUTHOR



DONVAY  
WEGIERSKI

Title: Director  
Office: Stellenbosch  
Direct line: +27 (0) 21 809 6009  
Fax: +27 (0) 86 510 6732  
Email: [dwegierski@werksmans.com](mailto:dwegierski@werksmans.com)

Click [here](#) for her profile

### > Keep us close

The Corporate & Commercial Law Firm  
[www.werksmans.com](http://www.werksmans.com)

*A member of the LEX Africa Alliance*

## ABOUT WERKSMANS ATTORNEYS

Established in the early 1900s, Werksmans Attorneys is a leading South African corporate and commercial law firm, serving multinationals, listed companies, financial institutions, entrepreneurs and government.

Operating in Gauteng and the Western Cape, the firm is connected to an extensive African legal alliance through LEX Africa.

LEX Africa was established in 1993 as the first and largest African legal alliance and offers huge potential for Werksmans' clients seeking to do business on the continent by providing a gateway to Africa.

With a formidable track record in mergers and acquisitions, banking and finance, and commercial litigation and dispute resolution, Werksmans is distinguished by the people, clients and work that it attracts and retains.

Werksmans' more than 200 lawyers are a powerful team of independent-minded individuals who share a common service ethos. The firm's success is built on a solid foundation of insightful and innovative deal structuring and legal advice, a keen ability to understand business and economic imperatives and a strong focus on achieving the best legal outcome for clients.

