



And the Oscar goes to ... the Trade Marks Office

by **Gaelyn Scott**

click to print
this article

In 2014, a South African court convicted Paralympian Oscar Pistorius of culpable homicide (manslaughter), following the shooting of his girlfriend Reeva Steenkamp, and he was given a custodial sentence of five years. The conviction was later replaced with one of murder and his sentence increased to six years' imprisonment. However, before this change, on 2 February 2015, Pistorius filed eight applications at the South African Trade Marks Office to register the name Oscar Pistorius as a trade mark. The news of these trade mark applications, however, only came to light recently, when a South African news service broke the story. The story was quickly picked up by the foreign media.

The applications that Pistorius filed for the trade mark Oscar Pistorius are in the following classes or product categories:

- class 9 for goods such as DVDs, CDs and electronic publications
- class 10 for, *inter alia*, orthopaedic articles, prosthetic and artificial limbs
- class 16 for a range of goods, including printed matter, stationery and instructional materials
- class 25 for clothing, footwear and headgear
- class 28 for, *inter alia*, sporting goods, games and rehabilitative sporting apparatus
- class 36 for financial services, including charitable and fundraising activities
- class 41 for education services, entertainment services and motivational speaking tours
- class 44 for medical services, psychological counselling, personality testing, providing physical rehabilitation services and programmes, and exercise facilities for health rehabilitation services

On the same day, Pistorius filed corresponding applications for the trade mark Blade Runner. The applications for Oscar Pistorius have all been accepted, whereas the applications for Blade Runner have been provisionally refused.

So, what are we to make of all this? Well, it probably tells us something about Pistorius' frame of mind in February 2015. Yes, he had been given a five-year sentence, but he certainly wasn't planning to spend that long in jail – there was talk that with good behaviour, he would serve only a fraction of the time. One therefore assumes that he was looking to the future, a future that would involve him using his very famous name as a way of making a living (and recouping the massive legal costs he incurred). According to media reports, the Pistorius family has said that they believe that “the brand is not dead.”

Pistorius was clearly thinking of going the personal brand route, a route that's much favoured by sportsmen and other celebrities. What's unusual here, though, is that I would imagine the thinking behind such a decision generally goes like this: “I'm famous; I can use the attractive force and positive associations that my name now has to license a host of companies to manufacture goods under my name in return for royalties; that will create new revenue streams for myself, and make me wealthier.” It would be unusual for a celebrity who's been found guilty of a serious crime to think along these lines though!

The product categories chosen by Pistorius are also interesting. Some are bog standard – all celebrities seem to be fascinated with bling and clothing, and you'll often find applications for watches and jewellery in class 14 and clothing in class 25, as well as things like electronic media apparatus in class 9, printed matter in class 16, and sporting goods in class 28.

Some of the classes and products chosen by Pistorius, however, suggest some interesting thinking. Pistorius seems to contemplate doing things in areas where his name, disability and story may have considerable resonance, and where he may even do some good – rehabilitative sporting apparatus, prosthetic and artificial limbs, physical rehabilitation services and programmes, and fundraising. But some are odd. As Pistorius is no doctor, does he really anticipate licensing his name for use in medical and psychological assessment services and entertainment services?

The Oscar Pistorius trade mark applications also raise some interesting issues of trade mark law. Why exactly does Pistorius think he needs to register his name as a trade mark? One benefit of registration is that it gives you a clear legal right to use the name. Another is that it creates an enforceable right. But is there likely to be much competition for the name Oscar Pistorius?

In order to file a valid trade mark application, you must have a genuine intention to use the trade mark. Presumably, Pistorius did have that intention in February 2015, but has his thinking changed since (following the change in his conviction in December 2015)?

The South African Trade Marks Act, 1993 says that a trade mark application can be refused if it is *contra bonos mores* (contrary to good morals) or likely to give offence to any class of persons. It's certainly possible that applications to register the trade mark Oscar Pistorius might have offended certain people and sensitivities. Was this issue considered?

In South Africa, many trade mark registrations are often limited by way of endorsements. The applications for Oscar Pistorius are no exception. The authorities have required Pistorius to enter the following disclaimer: “Registration of the mark shall give no right to the exclusive use of the words OSCAR and PISTORIUS separately and apart from the mark”. What this means, is that the registrations won't give Pistorius exclusive rights to the name “Oscar” and “Pistorius”, both common names that no one person should be able to monopolise.



Gaelyn Scott

trade mark attorney | director | head of IP department

cell: +27 83 632 1445



No information provided herein may in any way be construed as legal advice from ENSafrica and/or any of its personnel. Professional advice must be sought from ENSafrica before any action is taken based on the information provided herein, and consent must be obtained from ENSafrica before the information provided herein is reproduced in any way. ENSafrica disclaims any responsibility for positions taken without due consultation and/or information reproduced without due consent, and no person shall have any claim of any nature whatsoever arising out of, or in connection with, the information provided herein against ENSafrica and/or any of its personnel. Any values, such as currency (and their indicators), and/or dates provided herein are indicative and for information purposes only, and ENSafrica does not warrant the correctness, completeness or accuracy of the information provided herein in any way.

info@ENSafrica.com
level 2 BBBEE rating (South Africa)

