

## Intellectual Property Rights Application Process

The following guidelines are designed to assist registered horse owners (**Applicant**) who are seeking additional intellectual property protection for the name, image, jockey silk design or any other indicia associated with that horse (**Horse Indicia**) in addition to the licence they have already been granted by RA.

The Registrar of Racehorses (**Registrar**) will follow the procedures set out below, which may include escalation to the Intellectual Property Committee (**Committee**). The Committee generally comprises the following three members of the Australian thoroughbred horse racing industry: the Chief Executive Officer of RA, the Manager of Owners & Breeders Services of RA. However, the Registrar reserves the right to vary the composition of the Committee for any reason. The composition of the Committee is intended to enable the Committee to assess additional intellectual property protection sought by an owner.

These procedures are designed to ensure that: (a) owners are provided with an opportunity to present his or her case; and (b) applications are escalated at appropriate times and in an appropriate manner.

Applicants must keep all correspondence and discussions between the Applicant and the Registrar, or between the Applicant and the Committee, strictly confidential. Applicants must not disclose the details of any such correspondence or discussions to any third party. By engaging in either of the processes outlined below, Applicants will be deemed to have acknowledged, accepted and agreed to be bound by this paragraph.

### AR.18A of the Australian Rules of Racing

1. As a condition of the registration of a horse, and in consideration for registration of the horse, each owner (including future owners) of the horse:
  - a. acknowledges that the Registrar, the Principal Racing Authorities and race clubs use the names, images, jockey silks and other indicia of horses for the purpose of administering, promoting and reporting on thoroughbred horse racing;
  - b. agrees that the Registrar owns all right, title or interest (including but not limited to copyright, goodwill and reputation) in the name, image, jockey silks and any other indicia associated with the horse, whether existing before or after the horse is registered;
  - c. assigns to the Registrar – to the extent that the owner owns, by force of law, any right, title or interest (including but not limited to copyright) in the name, image, jockey silks and any other indicia associated with the horse, whether existing before or after the horse is registered – any and all such intellectual property rights;
  - d. undertakes not to apply, or to authorise any other person to apply, to register the name, image, jockey silks or any other indicia associated with the horse as a trade mark; and
  - e. undertakes not to assert or bring, or to authorise any other person to assert or bring, any claim of ownership of any intellectual property rights in the name, image, jockey silks or other indicia associated with the horse.
2. In consideration for the assignment and undertakings in AR.18(1), RA grants to the owner(s) a non-exclusive, royalty-free and non-transferable licence to:
  - a. use the name, image, jockey silks and other indicia associated with the horse the subject of this form where RA owns the intellectual property in such indicia for any purpose related to racing, training, promoting and otherwise dealing with the horse, including merchandising; and
  - b. sub-licence the same to any other person.

For information about the reasons and purposes underpinning AR.18A, please refer to [www.racingaustralia.horse/AboutUs/IndustryAnnouncements-24092012-Artical08.aspx](http://www.racingaustralia.horse/AboutUs/IndustryAnnouncements-24092012-Artical08.aspx).

### Intellectual Property Rights in Horse Indicia

One of the effects of AR.18A is that a registered horse owner must not:

- apply to register any Horse Indicia as a trade mark;
- assert or bring any claim of ownership of any intellectual property rights in Horse Indicia; or
- authorise any other person to do either of the above.

Under AR.18A(2), RA grants the owner(s) of a registered horse a non-exclusive, royalty-free and non-transferable licence to use the Horse Indicia (to the extent that RA owns the intellectual property in such Horse Indicia) for any purpose relating to racing, promoting or otherwise dealing with the horse, and to sub-licence those rights to any other person.

RA acknowledges that there may be situations in which a registered horse owner may require greater intellectual property protection in addition to the licence granted under AR.18A(2). In those situations, owners may apply to RA in accordance with the process outlined below.

### Application Process

1. An owner (Applicant) may send an email to [registrationip@racingaustralia.horse](mailto:registrationip@racingaustralia.horse) with the subject heading 'APPLICATION FOR INTELLECTUAL PROPERTY RIGHTS' with the following information:
  - (a) the name of the horse and any other necessary details about the horse;
  - (b) the name of the Applicant and details of his or her proprietary interest in the horse;
  - (c) the Horse Indicia in which the Applicant seeks intellectual property rights (or other rights); and
  - (d) further details about the legitimate need for those rights, including all supporting documents.
2. RA will decide whether it will grant to the Applicant any intellectual property rights in addition to the licence under AR.18A(2). Applicants should allow approximately 14 business days for RA to come to a decision, although this process may be expedited in urgent circumstances.
3. If RA rejects the application, it will communicate this decision to the Applicant by email and disclose the ground(s) for rejection. If RA accepts the application, it will communicate this decision to the Applicant by email and outline the intellectual property rights that it will grant to the Applicant, as well as the conditions on which it will grant such rights.
4. If the Applicant wishes to appeal the decision on any ground, the Applicant may appeal to the Committee. The Applicant is entitled to provide additional reasons and evidence of its legitimate need for intellectual property rights in addition to the licence granted under AR.18A(2) before the Committee makes its decision. Applicants should allow approximately 14 business days for the Committee to come to a decision, although this process may be expedited in urgent circumstances. The decision of the Committee will be final, and RA will not enter into any further correspondence with the Applicant in relation to the application.
5. If the Committee rejects the application, RA will communicate this decision to the Applicant by email and disclose the ground(s) for rejection. If the Committee accepts the application, RA will communicate this decision to the applicant by email and outline the intellectual property rights that RA will grant to the Applicant, as well as the conditions on which RA will grant such rights.
6. At any point in the application process, RA may request additional information and supporting documents from an Applicant before the application can be processed or a decision can be made. RA will make any request for additional information and supporting documents by email.
7. Where necessary, RA may obtain legal advice to ensure that any decision made is informed, reasonable and legally justified.

This process is designed to ensure, as far as possible, that all applications are processed in a fair, consistent and professional manner.

### What constitutes a legitimate need?

RA may grant intellectual property rights in Horse Indicia to an Applicant in addition to the licence granted under AR.18A(2):

- where the Applicant needs additional rights in order to pursue persons other than RA, the Principal Racing Authorities and Race Clubs for infringement of the Applicant's intellectual property rights;
- where the Applicant needs additional rights in order to race, train, promote or otherwise deal with the relevant horse, including by creating and selling merchandise; or
- in any other situation in which RA considers that the Applicant legitimately needs additional rights.

## Grounds for Rejection

RA will reject an application where:

- the Applicant is not a registered owner of the horse;
- the Applicant did not have any right, title or interest in the relevant intellectual property prior to the introduction of AR.18A on 1 October 2012;
- RA does not hold the relevant intellectual property rights (whether because they were not effectively transferred to RA under AR.18A or otherwise) and therefore cannot grant such rights to the Applicant; or
- RA decides that, while the Applicant may consider it desirable to obtain intellectual property rights in addition to the licence granted under AR.18A(2), there is no legitimate need to obtain such rights.

## Grant of Intellectual Property Rights

If RA accepts an application, RA will only grant the intellectual property rights that are absolutely necessary for the Applicant to satisfy his or her legitimate need. This may involve RA assigning the relevant intellectual property rights to the Applicant, or granting an exclusive licence in respect of the relevant intellectual property rights to the Applicant.

RA may grant any intellectual property rights to the Applicant subject to certain conditions, which may include (without limitation):

- that the Applicant (and any other owner of the horse) enters into a formal legal agreement or deed with RA to effect the assignment or exclusive licence;
- that the Applicant (and any other owner of the horse) assigns the intellectual property rights back to RA after his or her legitimate need is satisfied; and
- that any exclusive licence will expire once the legitimate need is satisfied.