

## IP for Retailers – Current Training Modules

### Social climbing: the use and abuse of IP rights in social media

Retail advertising and marketing is increasingly taking place in social media and online markets are proving both a growing opportunity and a developing problem. This session considers the issues which arise including brand disparagement on Twitter, Facebook and other media, the online sale of counterfeits and the problems of policing and enforcing trade mark rights in online marketplaces such as Amazon, Alibaba and eBay as well as the impact of recent decisions such as *Lush v Amazon*.

This module also provides practical advice as to how to put in place suitable mechanisms for dealing with “anti-social” behaviour and developing cost effective processes for online brand management.

### Damage limitation: how to argue for more (or less) damages in retail disputes

Almost every retailer has occasional clashes with other retailers or suppliers over brand and design infringements. The key elements of liability are relatively well known but the law and practice of assessing damages is much less frequently understood.

A good grasp of this subject will enable retailers, when claimant, to know how to maximise recovery and, when defendant, how to minimise payment.

This module examines the core principles and looks at recent helpful cases in this area such as *32 Red plc* and *Holister v Medik*.

### Retail wars - the power of comparative advertising

As is evident from Aldi’s much-talked-about campaign, comparative advertising is becoming steadily more aggressive. Consumers’ pre-occupation with value is prompting many retailers to consider running their own campaigns and to ensure they know how they can fight back when they are the target of a competitor’s campaign. The protracted legal clash between Tesco and Sainsbury’s arising from Sainsbury’s attack on Tesco’s Price Promise campaign has provided some very useful insight into the key do’s and don’ts for both parties.

In this module, we look at the applicable regulations, discuss what is fair and what is impermissible in a comparative advertisement and provide practical guidance on how to run an effective and lawful campaign.

### Logo law

As the principal and most vital emblem of retail identity, the unique features of logos and their importance for retailers have been at the centre of many trade mark cases such as *Jack Wills v House of Fraser*, *Ralph Lauren v Chunk Clothing* and *Specsavers v Asda*. This module reviews the applicable law and principles and explains the particular issues that need consideration when developing a new logo or when assessing the merits of an infringement claim against a third party.

### Looks like a lookalike...

Last year the Intellectual Property Office published the results of an in-depth examination of the problems created by lookalike packaging. Whilst lookalikes have been an issue for decades, following the much publicised Puffin/Penguin case, the way in which the courts apply the relevant principles of trade mark and passing of law continue to develop and evolve and lookalikes are also the subject of European case law and legislation.

This module looks at where the courts will draw the fine line between the permissible packaging and the unacceptable “rip off” as well as reviewing recent cases and providing practice advice for both the look-alike retailer and the brand-owner.

### About-face: Image rights, endorsement, copyright and passing off in the fashion industry

Cases across Europe involving celebrities such as Eric Cantona, Kylie Minogue and, of course, Rihanna in her well-publicised claim against Topshop have prompted much discussion about the lack of concrete “image rights” for celebrities in the United Kingdom, the adequacy of passing off as a remedy and the implications for retailers when using celebrity imagery without explicit endorsement.

This module provides practical advice as to how retailers can protect themselves against complaints from famous faces and whether seeking consent is always the best option. It also considers how rights such as copyright and passing off interact in the world of celebrity endorsements and provides important practical guidance on how to minimise the likelihood of a product conflicting with third party rights.

## About HGF’s Retail Team

HGF is one of the fastest growing and largest full service IP practices in the United Kingdom. When ranked by the number of Community Trade Mark filings (a commonly used metric) we are presently the second largest trade mark practice in the UK and the sixth largest in Europe.

The HGF Retail team work with a growing number of national and international retailers and provides support and advice on the full suite of IP needs including

- brand creation;
- searching and clearance;
- filing and prosecution of trade mark and design applications globally;
- trade mark and design portfolio management, including renewals;
- oppositions, appeals and other disputes at trade mark offices around the world;
- domain name registration and maintenance;
- design and brand protection including anti-counterfeiting, dispute management, enforcement and litigation.

In addition to our expert advisors, many of whom are highly ranked in legal directories, we support our clients with leading edge, bespoke portfolio and document management software allowing full online access to files as well as specialist renewals and formalities teams.

## Members of HGF's retail team



### Antony Gold – Partner (Solicitor)

- Specialist expertise in retail IP for over 15 years
- Focuses on brand protection and enforcement
- Highly ranked by the independent legal guides to law firms

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### Alice Gould – Partner (Solicitor)

- IP expert providing a full service to owners of brands and designs
- Specialist in anti-counterfeiting
- Undertakes brand clearance and portfolio management

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### David Potter – Partner (Trade Mark Attorney)

- Head of the Trade Marks Team at HGF
- Over 20 years' experience of working with major brands
- Work encompasses all aspects of brand protection

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### Geoffrey Smith – Partner (Solicitor and Trade Mark Attorney)

- Dual qualified solicitor and trade mark attorney
- Over 20 years' brand experience, both in private practice and in-house
- Advises a diverse range of consumer-facing brands

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### Janet Knowles – Partner (Solicitor)

- Well known for her work in brand licensing particularly in fashion
- One of a limited number of UK IP licensing professionals recommended by the international guide IAM 1000

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**Lee Curtis – Partner (Trade Mark attorney)**

- Manages the trade mark portfolios of a number of leading retailers
- Over 20 years' experience of working with retailers
- Ranked in the Legal 500 and holds Trade Mark Litigators certificate

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**Martyn Fish – Partner (Solicitor)**

- Experienced IP litigator with considerable experience of UK and European design law
- Acted for a number of retailers in design –related disputes

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**Michael Varvill – Partner (Solicitor)**

- Specialist expertise in comparative advertising
- Member of the invitation-only ADLAW group of advertising specialists
- Substantial litigation practice in all areas of intellectual property law

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**Adjoa Anim – Trade Mark Attorney**

- Works with retailers in clothing, accessories and sports goods
- Handles counterfeiting, trade mark acquisitions and oppositions

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**Jocelyn Wheeler – Trade Mark Attorney**

- 8 years' experience working for a wide range of retailers
- Experience in brand clearance, portfolio management and global expansion, including worldwide co-existence agreements and local use investigations

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### **Rebecca Field – Trade Mark Attorney**

- Over 7 years' experience of working closely with leading retailers
- Special expertise in domain names and rebranding
- Manages worldwide brand portfolio's and launches into new territories

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### **Katie Goulding – Trainee Trade Mark Attorney**

- Works with leading retailers in fashion and e-commerce
- Assists retailers with online brand monitoring and removal of counterfeit listings from online retail platforms
- High success rate in overcoming OHIM and UK IPO objections against registerability

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### **Lauren Somers – Trainee Trade Mark Attorney**

- Worked with retailers in a range of fields, including fashion, home furnishings, automotives, shoes and handbags
- Prepared and delivered training to management, marketing and design teams of leading UK retailers

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