

IP in Retail

Online training events





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HGF's retail group

HGF is one of the largest full-service IP firms in Europe with over 200 IP professionals and 22 offices across the UK, Ireland, the Netherlands, Germany, Austria and Switzerland.

Our retail group acts for a growing number of the UK's high street and international online brands and offers a full range of IP services in retail and fashion including advising on social media, e-markets, advertising and design clearance, rebranding and portfolio management plus online and bricks and mortar brand protection.

Our LinkedIn groups, Retail+IP, Fashion+IP and Food&Drink+IP have over 7,500 members and are designed to bring together those in retail and fashion to discuss stories, recent IP development and legal updates.



Brands & designs

Logo law

Presented by Lauren Somers
Trade Mark Attorney

Overview

Logos are a vital emblem of retail identity. Their unique characteristics mean that they have been the subject of many trade mark decisions, not least because the analysis of the similarity of images and stylized text to a registered mark can be much more complex than a comparison of word marks. Recent decisions such as *Beats Electronics, LLC v Disashop SL and Micheal Kors (Switzerland) International GmbH v Julong Wang* have helped keep logos at the centre of emerging trade mark law.

In this module

We will provide knowledge of the particular law and principles applicable to the comparison of logo marks. This knowledge will be crucial to marketing teams when developing a new logo allowing them to assess conflicts with prior logos. The session will also assist legal teams when assessing the merits of infringement claims against third parties for use of potentially similar logos.





Module 2

Debating designs

Presented by Martyn Fish
Solicitor

Overview

Unregistered EU design law has had a significant impact on retailers. The number of design infringement cases has significantly increased since its introduction, helped by cost effective enforcement in the UK. However, after nearly 20 years the availability of this useful protection may well be a victim of the UK leaving the EU. It is now time to review your design protection strategy to ensure that there are no gaps in your protection.

In this module

We will provide an overview of unregistered rights in the UK and Europe, highlight areas of change (recent decisions such as *Beverly Hills Teddy Bear Company v PMS* and *Cofomel v G-Star Raw* confirm the constantly evolving nature of design law) and analyse whether there should now be more of an emphasis on obtaining registered protection.

We will also examine a recent trend of companies attempting to rely on unfair competition / passing off to protect the shape of products.



Big brands = big value

Presented by Michelle Davies
Solicitor

Overview

Are you leveraging the value of your brands to the max? Ensuring you obtain the best return and protection for your brands will require well drafted and negotiated contractual terms but there is a lot to consider to make sure you get this right and on the right side of the law.

The implications of the OECD's November 2019 review and recommendations on the Licensing of IP and Competition Law (Nov 2019) as well as recent trade mark and competition cases alongside

other factors, including Brexit, digitalisation and the GDPR. They play a part in how you draft and negotiate your contracts.

In this module

We explore the framework for leveraging the best value for your brands under your contracts, including the licensing and sale of marks, the use of heads of terms, local law issues, formalities, taxation and the application of EU and UK competition law.





Module 4

Non-traditional trade marks

Presented by Claire Jones
Trade Mark Attorney

Overview

Unlike traditional word and logo branding, today's modern branding market demands more and more creative ways of engaging consumers and creating unique selling points. Brands like Glossier are heavily involved in trying to protect and enforce their pink bubble-wrap lined ziplock pouches, this shows the growing trend for packaging and other non-traditional forms of protection to be just as essential.

In this module

We will examine some of the main non-traditional elements of trade marks, the issues faced and ways of protecting these elements. From examining the different elements, legal and marketing teams can have a better knowledge of what defines their brand identity and how to protect it.



Position brands, me-toos & anti-counterfeiting post-Louboutin

Presented by Alexander Hagen
Trade Mark Attorney

Overview

In the aftermath of the landmark *Louboutin* decision by the Court of Justice, we look at position marks in the post-*Louboutin* world and their value in anti-counterfeiting and brand protection strategies in the UK, the EU and beyond.

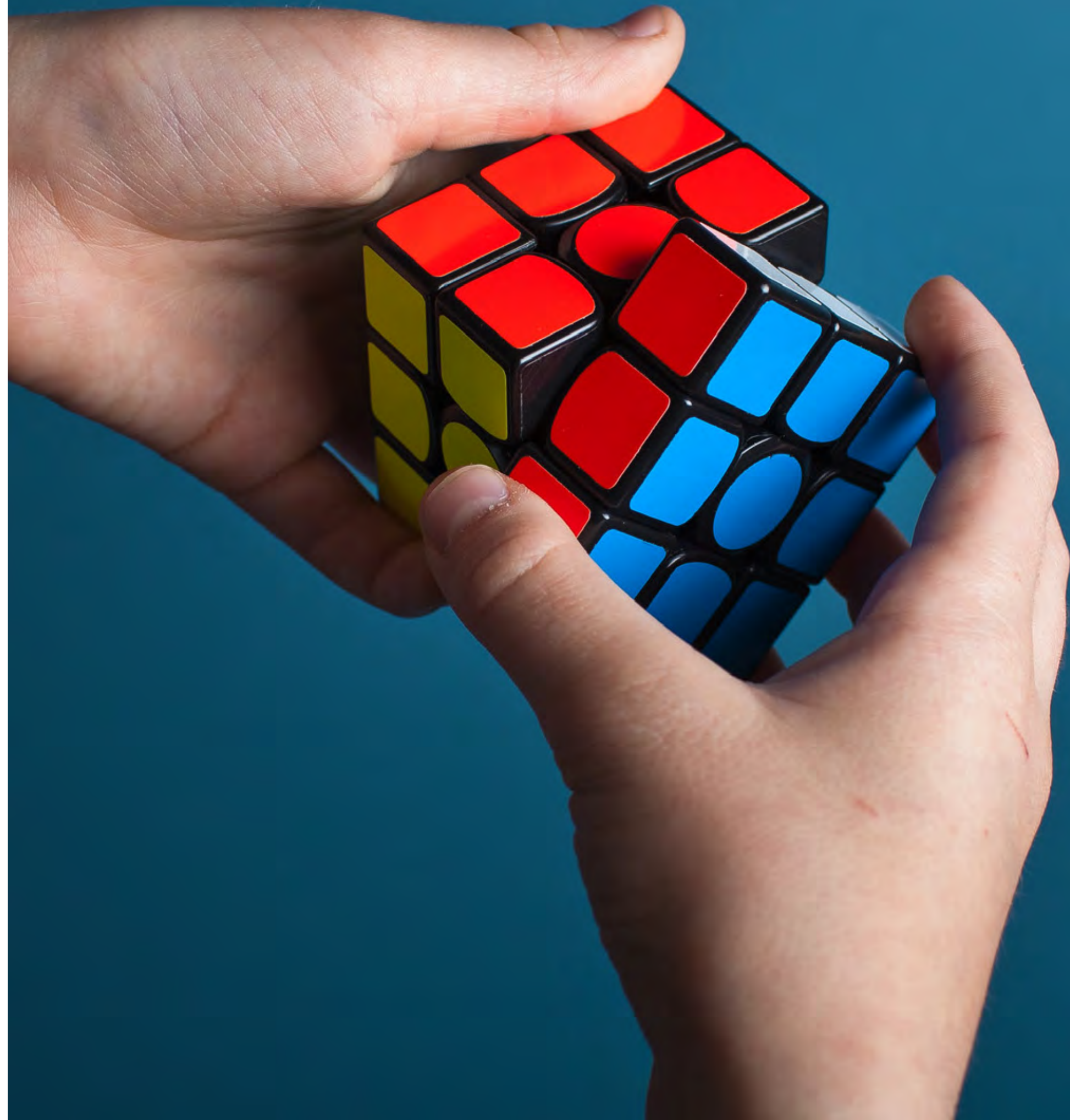
In this module

We will focus on the added value that position brands, a relatively new way of protecting IP, can help protecting key features with distinct placing on products or in marketing.

It gives new scopes of protection for this, and also adds to claims that in the past could be made on more traditional trademarks. The importance of this subject applies to a vast number of businesses, because almost all, some of them without realising it, do have distinctive names, colours or logos consequently used on specific places, throughout their business.



Problems & problem solving in retail



IP disputes on e-markets

— strategies & tactics

Presented by Lauren Somers & Claire Jones
Trade Mark Attorneys

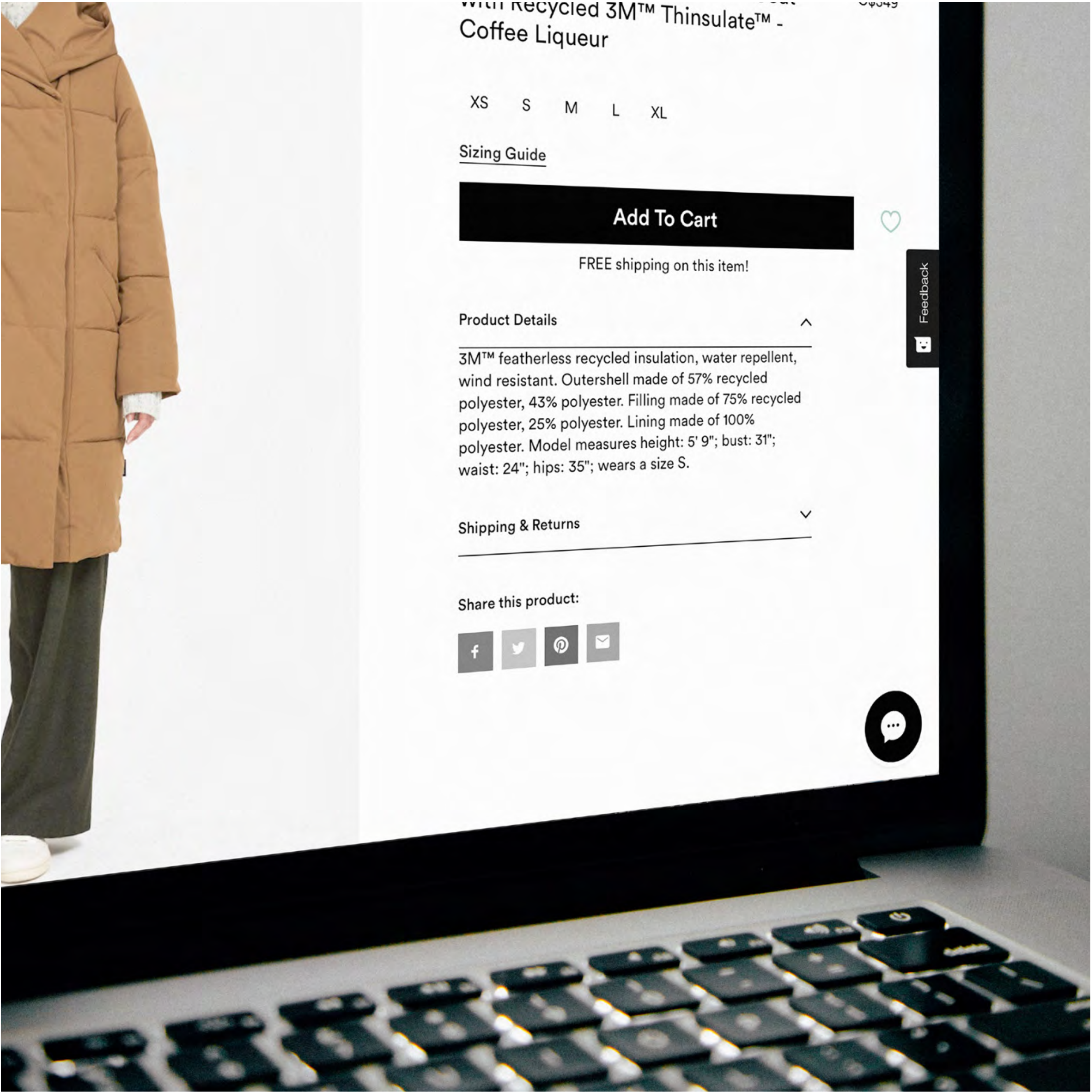
Overview

Few, if any, retailers can afford to ignore the new landscape for IP protection created by policies such as Amazon’s Seller Central programme. Even if they do not sell on them directly, retailers frequently need to contend with third parties selling legitimately or selling grey market or counterfeit stock. The way in which e-markets now handle claims of intellectual property infringement is very different from, and sometimes more important than, the court process.

Whichever end of the complaint process they are on, retailers need to know how the processes work and what is the best practical way of using this very different dynamic to their advantage.

In this module

We will provide a guide to the Amazon system, allowing e-commerce teams to navigate the platforms’ Amazon Brand Registry tool. Attendees will also learn other vital strategies for monitoring and protecting against counterfeiting online.





Module 7

Oppositions & infringements — *combining tactics*

Presented by Lauren Somers
Trade mark Attorney

Overview

The launch of a potentially infringing third party brand often presents the retailer with two potential remedies, typically used in combination – opposing the third party trade mark applications and taking action to prevent infringements. Each option has its pros and cons. Oppositions are inexpensive but long-term. Court action, or the threat of it, can be effective but more costly. A combined approach can place sufficient pressure on the third party to reach an early and cost effective solution.

In this module

We will provide problem-solving skills, teaching how to deploy both options (opposition and infringement actions) in a co-ordinated manner to secure the best outcome from trade mark disputes.



A guide to ASA complaints

— what, why & how?

Presented by Antony Gold
Solicitor

Overview

The ASA is at the sharp end of advertising regulation in the UK and its guidance is constantly evolving. In the last 2 years, it has introduced new rules on the use of data for marketing, detailed guidance which prohibit gender stereotypes and release guidance notes on subjects as diverse as weight loss and influencers. Retailers familiar with the codes are very proficient at ensuring competitor advertising is compliant and not unfair and that their own ads are compliant.

In this module

We will look at the most relevant provisions and recent developments, discuss what is fair and what is impermissible in a comparative advertisement and provide practical guidance on how to run an effective and compliant campaign.





Module 9

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

Presented by Antony Gold
Solicitor

Overview

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 in intellectual property disputes is much less frequently understood. A number of recent decisions, such as *OOO Abbot v Design & Display* and *Jack Wills v House of Fraser*, have provided very helpful guidance on damages.

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

In this module

We will examine the cases and give practical advice on how to best present your position when arguing about damages.



Domain name infringements

How to create & maintain a cost-effective online monitoring programme

Presented by Antony Gold
Solicitor

Overview

Cybersquatting continues to comprise one of the prevalent forms of intellectual property infringement; last year WIPO reported that the previous 12 months alone had seen a record-breaking 3,447 cases filed under the UDRP. As different trends of internet abuse emerge, panellists are adapting to the changing landscape.

Many retailers are still unsure as to the basis for taking action under the various policies relating to domain names as well as timescale, cost and how best to put together a cost-effective complaint.

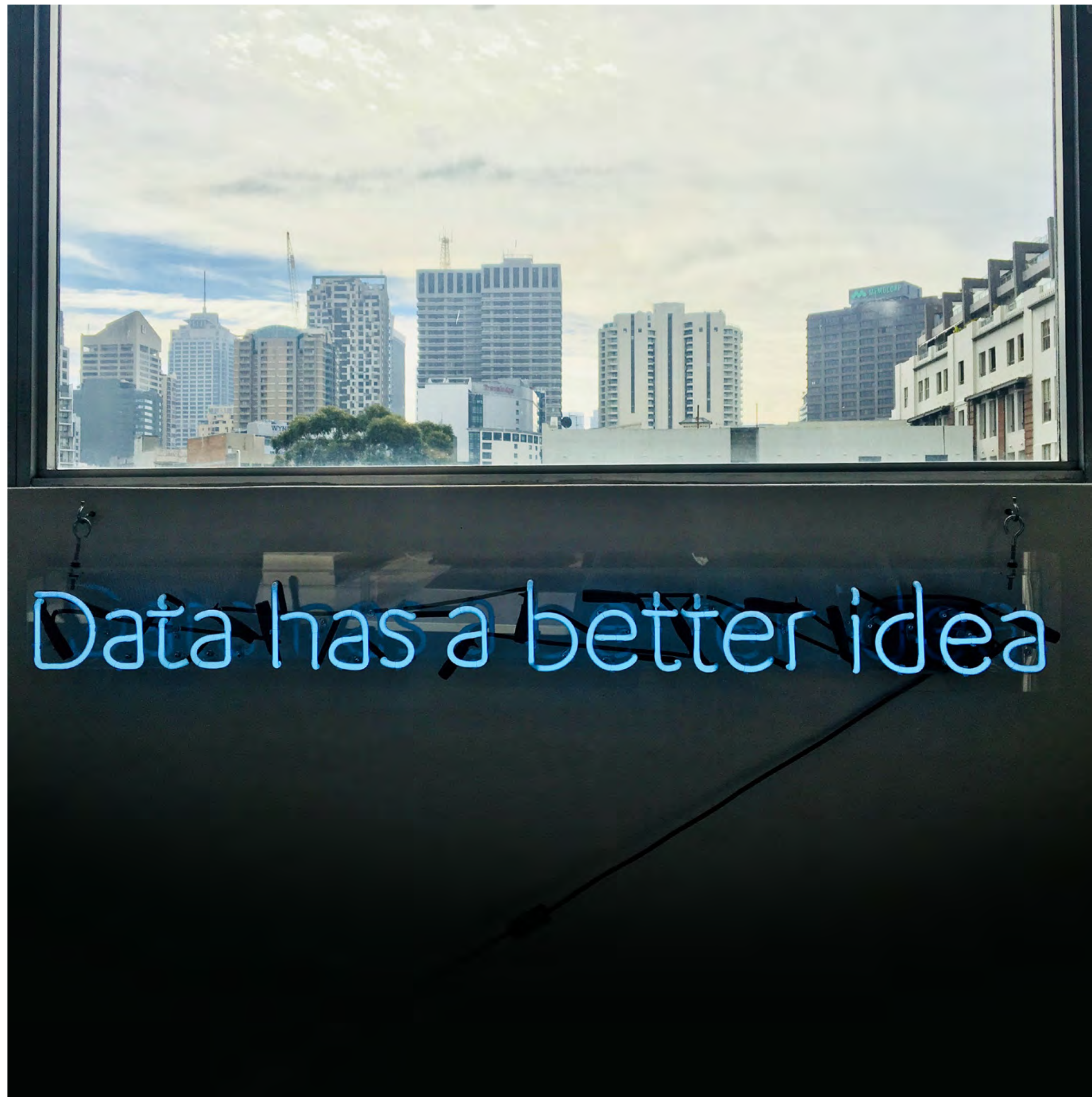
In this module

We will provide highly practical guidance in this area ranging from the high level monitoring and triaging of potentially problematic third party registrations through to the nuts and bolts of complaint preparation.



A close-up photograph of a display rack filled with various styles of eyeglasses. The glasses are arranged on clear plastic hangers, with some frames in sharp focus and others blurred in the background. The frames come in different colors and materials, including black, red, blue, and tortoiseshell. The text "Commercial issues for retailers" is overlaid in a white, elegant script font on the right side of the image.

Commercial issues for retailers



Module 11

Data privacy — the landscape for retailers in 2020

Presented by Ellis Parry
Consultant

Overview

Although the EU's e-Privacy Regulation may have failed to be passed, the GDPR's provisions on profiling consumers online and making automated decisions about the content they see are still live. The Information Commissioner has hinted at enforcement action if it does not see the Adtech industry change its practices in relation to real time bidding.

The use of personal data in the online advertising space appears to be an area of particular focus for the Information Commissioner this year with a new Direct Marketing Code out for consultation and an Age Appropriate Design Code already laid before Parliament.

In this module

We will review the new emerging legal and regulatory landscape, give you tools to help you assess your online risk and the knowledge to take the right steps to mitigate that risk.



Practical steps for risk minimisation & effective communication across your business

Presented by Michelle Davies
Solicitor

Overview

Inevitably issues will arise across all areas of your business from the inadvertent disclosure of sensitive information through to the handling of customer complaints, public exposure, manufacturing problems, product recall or even dawn raids. Whilst some risks can be avoided, it is quite often the inappropriate handling of situations and panic responses made by a business that can cause the greatest damage. With over 12 years' experience working in-house directly with business teams and functions,

Michelle talks through her insights and the practical steps she has seen work most effectively.

In this module

We will discuss what steps can be taken as a matter of good business practice to prevent or minimise your business' risk and exposure which can be as simple as training staff on how best to create and share internal or external communications or on how to initiate and run an 'issue management team' most effectively.





Module 13

Trading in, from & through China

Presented by Lee Curtis and Rebecca Field
Trade Mark Attorneys

Overview

China is both a major global hub for branded products and one of the largest markets for them. Whilst a hugely significant – and positive change – was introduced to China's trade mark law in late 2019, bad faith trade mark filings and brand high-jacking are still a problem. The case law on so-called OEM trade mark use (that is the manufacturer of product in China solely for export) is also constantly shifting.

In this module

We will consider these issues and suggest solutions allowing you to apply and determine how Chinese case law on OEM use impacts on your global supply chains, as well as your ability to sell your branded products to Chinese consumers. We will touch on the use and registration of brand names in Chinese characters, transliterations of trade marks and the use of nicknames of brands and their registration by Chinese consumers which are all important components in the use of brands in China.



E-commerce — getting your website documents right

Presented by James Talbot
Solicitor

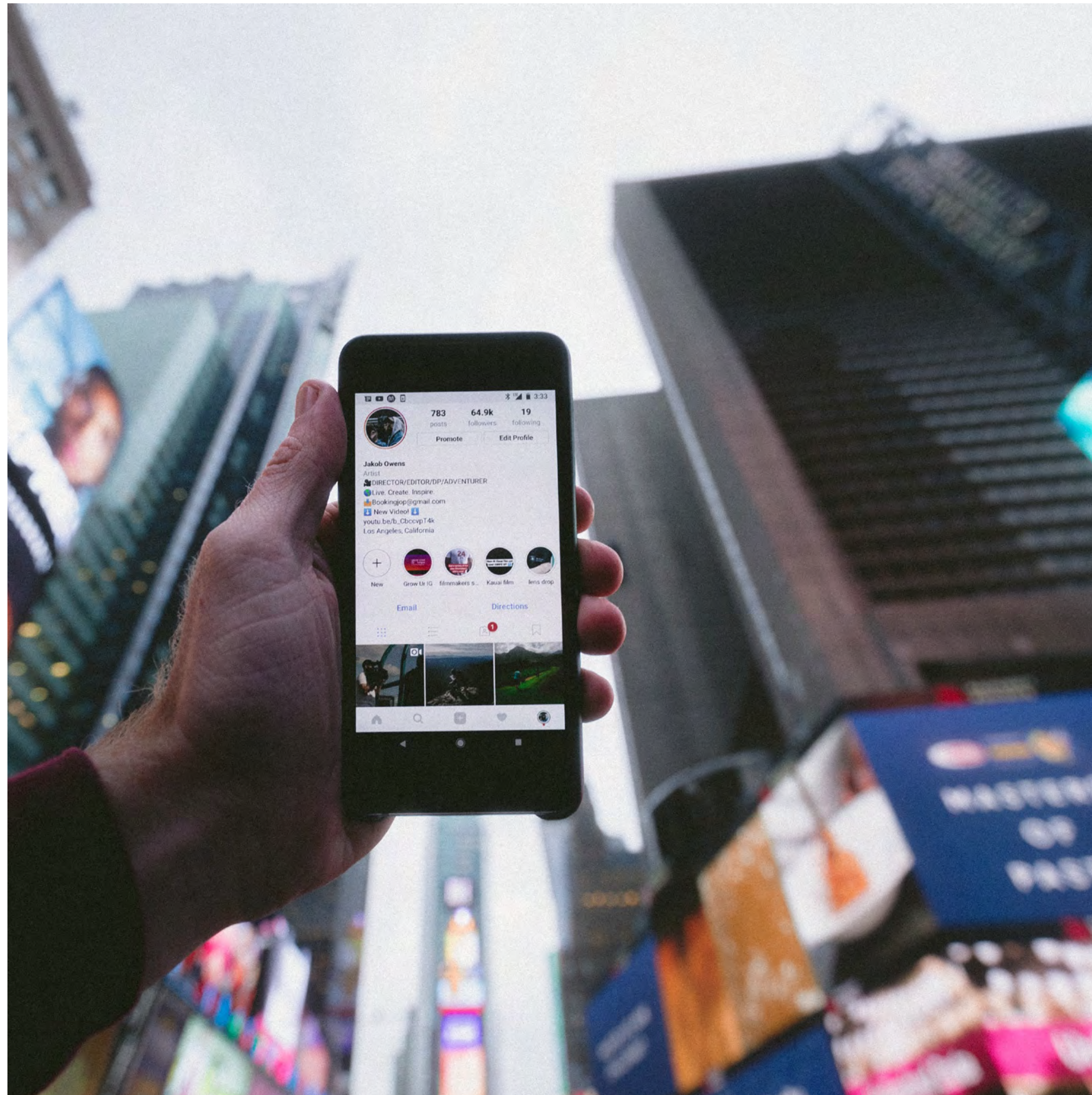
Overview

Online presence is increasingly important to retailers as a key route to market, making it important to get the terms and policies that are found on an e-commerce platform right. These documents will need to cover customers’ use of your platform/website, the terms on which they purchase your products or services as well as ensuring sufficient information is provided around their consumer and data protection rights.

In this module

We will help you understand the issues involved in putting together appropriate Terms of Use, the Consumer Rights Act’s impact on your Terms of Sale, and the thought process required to develop an appropriate Data Protection Policy/ Notice, which will help you to manage the legal issues that arise in e-commerce.





Module 15

Software projects; development, licensing & SaaS — what needs to be covered

Presented by James Talbot
Solicitor

Overview

Whether improving an existing system/platform or developing a new one, software projects can, and often do, raise a number of risks and require input from a legal perspective to avoid potential overspend or being left with an unsatisfactory results. Whatever development model is used, having a clearly set out endpoint needs to be balanced with sufficient flexibility.

In this module

We will look at key terms around responsibilities, deliverables, rights to intellectual property, acceptance, liability, services and exit. We will also discuss the balance of risk between on-site and hosted solutions in a session which is designed to demystify what is sometimes a challenging area of practice.



Meet the team



Antony Gold

Antony leads HGF's retail team and specialises in advising clients in the retail sector on branding, designs and online issues. Antony has handled many intellectual property cases in the retail sector including *Fields v Klaus Kobec Limited*, *Julius Saaman and others v Tetrosyl Limited* and *Specsavers v Asda*.

Antony is one of the experts appointed by the World Intellectual Property Organisation for determining domain name disputes and has given over 150 decisions to date. He has been consistently ranked as a leading individual in intellectual property by Chambers, the independent guide to law firms. Recent client commentary on Antony from Chambers has included; "He is a spectacularly good IP lawyer" and "excellent in the area of contentious IP".



Alexander Hagen

Alexander is a Benelux & European Trade Mark Design Attorney and works for clients from start-ups to global sports, fashion, technology brands and his fortes are design IP management, design and branding strategies, counterfeit, cross-border litigation, conflict advice, structuring, due diligence and licensing.



Ellis Parry

Ellis is an expert in global data protection, privacy and e-marketing laws with 20 years of experience in leading international organisations' global compliance programmes. Areas of expertise include advising on the data privacy implications for whistleblowing hotlines, internal investigations, international e-discovery requests, anti-bribery and anti-money laundering monitoring, regulatory "dawn raids", data lakes and the deployment of artificial intelligence.



Claire Jones

Claire is a Chartered Trade Mark Attorney, who focuses predominantly on trade mark prosecution, filing strategies and portfolio management, together with contentious matters and dispute resolution. Claire manages the IP portfolio and enforcement for an independent spirits company as well as advising an American premium clothing company on UK enforcement and protection. Claire has had experience dealing with a range of fashion and cosmetic brands, together with Michelin star chefs and restaurant chains.



James Talbot

James joined HGF in 2017 moving from a specialist digital and technology legal team. He has experience working in-house for a major financial services provider as well as in the pharmaceutical sector. Working across a variety of sectors, such as technology, life sciences and retail, James specialises in transactional work, brand management and licensing. James also advises on wider commercial issues including contractual matters and data protection.



Lauren Somers

Lauren is a Trade Mark Attorney who works with a varied range of retail clients, from fashion and cosmetics to consumer electronics and automotive products. Lauren has delivered IP training to the management, marketing and design teams of a number of leading UK retailers, and provides strategic IP portfolio management advice.



Lee Curtis

Lee is a Trade Mark Attorney who focuses on supporting clients in the retail sector and works with many leading brands. Lee has a particular interest in multijurisdictional trade mark issues and has extensive experience of working with retailers in protecting intellectual property in their supply chain.



Martyn Fish

Martyn leads the IP litigation practice at HGF. He has considerable experience of providing advice on all areas of IP law. He advises clients in many sectors, including FMCG and luxury goods, and has acted for a number of high profile IP disputes for retailers.



Michelle Davies

Michelle is an experienced solicitor and transactional IP specialist, working regularly within the retail and commercial sector to provide specific advice on commercial contracting, T&Cs, data privacy and other consumer facing responsibilities.



Rebecca Field

Rebecca is a Trade Mark Attorney who actively manages the trade mark and design portfolios of retail and fashion clients. Rebecca also files domain name actions and deals with custom notices in relation to counterfeit goods. Rebecca has experience of working with retailers in protecting IP across the globe, notably in China and the US.

For more information or to book your training please contact HGF Head of Retail Antony Gold on — agold@hgf.com.

HGF is dedicated to providing a comprehensive service both across the UK and internationally. If you would like to contact us and find out how we can work with your business, please email us at enquiries@hgf.com to be referred to the right person for you.

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Sarah Gualtieri. Mona Eendra.
Phil Aicken. Markus Spiske.
Scot Van Daalen. Franki Chamaki.
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