

Protecting your charity against counterfeiters

Charities are not immune to the increasing counterfeiting trend.



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Catharina's specialities include registration and management of large international trade mark portfolios, drafting and prosecution of European patents, and a wide range of trade mark and patent opposition work.

Catharina Waller explains how charities can best protect themselves

The words fake and counterfeit are usually associated with 'designer' handbags available across markets in Asia, DVDs with poorly photocopied sleeves or 'official' football scarves sold by street sellers before a football match.

These are relatively low-value items that consumers purchase (usually knowingly) to avoid the higher cost of the real deal, often believing that there is no damage beyond a small loss to the rights holder. But aside from the fact that proceeds from these sales tend to go back into money laundering, people trafficking and drugs, the (increasing) counterfeiting trend has led to counterfeiting in unexpected areas.

Just prior to the most recent Remembrance Day, customs at Tilbury Docks seized £150,000 worth of counterfeit poppy merchandise arriving from China. Over 1,200 scarves, 5,400 badges and 1,200 key rings infringing the Royal British Legion's two-petal poppy symbol and/or the phrase 'Lest We Forget' were seized and destroyed. These would otherwise have been released into the market and sold for the profit of third parties, diverting funds away from the charity.

Every so often, the spotlight is shone on fake charity collection bags, where scammers copy charities' clothes collection bags and sell the items on in Eastern Europe or Asia for their own profit.

When consumers donate or purchase items in good faith, believing that funds are ultimately going towards supporting the charity's work, the problem of counterfeiting becomes even more disturbing. No longer is it a fashion giant or a Hollywood studio that is losing out, but a charity's beneficiaries.

What can a charity do to protect itself and those it aims to help? The first step is to register a trade mark for the name or logo that it uses and that the counterfeiters are most likely to copy. A trade mark registration is not cheap but it is a relatively cost-effective tool for protecting one's rights, and can last indefinitely, provided it is renewed every 10 years.

The second step is vigilance. Monitoring markets and the internet are key to knowing the state of play. If a consignment of fake items shows up, contact Trading Standards immediately and be ready to provide as much information as possible, including details of the infringement and copies of the trade mark registration(s). Trading Standards have limited resources, so cooperating with them is likely to provide a better outcome.

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If items are entering the UK from outside the EU, it is often possible to pre-empt their entry into the UK by having filed a form with customs setting out the details of the trade mark rights (and any additional detailed information you may have on specific consignments). If suspected counterfeit items are found, you will receive a letter requesting authentication within a short time frame, or else the items will be released. Be prepared to bear the cost of storage and destruction of the items if they are found to be counterfeit.

Tracing the source of counterfeit items can set the groundwork for bringing an action for infringement, and – if ultimately successful – can potentially even result in a 'Proceeds of Crime' payment.

Find out more

Protecting your charity against counterfeiters hinges on having a registered trade mark. BWB's specialist team of in-house trade mark attorneys and dedicated solicitors regularly advises charities on trade mark protection and enforcement. Please contact Catharina Waller or Mat Healey if you would like to discuss protection for your charity.

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