

Remedies for Imposter Syndrome

When someone uses your charity's brand without permission, it is frustrating to have to spend time and energy on legal wrangles rather than focusing on your core activities.



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Mindy Jhittay explains how to resolve name disputes quickly and effectively

*'Names are very important to charities as they are the key means by which the public **identify** them'* (Charity Commission Operational Guidance 330).

Donors and customers come to you because they recognise you by your 'brand' – your trade names and marks. It is important to prevent confusion among your supporters, particularly if you are a fundraising charity, so when someone starts using your brand without your permission you are forced to react. Here are some key tips on how to resolve the situation.

1. Civil proceedings – cease and desist letter

You can ask the court for an order to prevent someone else from using your name (or a similar name), in respect of the same or similar services to yours, if you can show that the use is liable to cause confusion between you and the infringer.

In most cases, the court will expect that you first ask the infringer to 'cease and desist' from using your marks, by sending them a letter setting out your rights and giving them an opportunity to resolve matters voluntarily before you involve the court.

Preparing a letter before claim is a necessary first step that can also have a tactical advantage. In our experience, sending a letter swiftly, before an infringing party has invested significantly in the infringing name, improves the prospects of persuading them to stop using it. In other words, taking the first step towards bringing a legal claim can help you to resolve the dispute without having to go to court at all.

Once you have issued your claim, there will be a number of steps to take before you get to the final hearing (trial) of the issues. These will include considering the infringer's defence and exchanging your evidence, which means documents and witness statements.

2. Agreement

What types of agreement can you reach with an

infringing party? The most obvious is a commitment by them to stop using the name altogether – to rebrand completely. This is the best outcome as it should completely eliminate the risk of confusion.

However, there are alternatives. Apart from being quicker and much cheaper than pursuing a claim at court, the major advantage of settlement is that the terms of your agreement may be more flexible than the remedies a court can award. The latter are generally limited to financial compensation or an injunction preventing further use of the name.

This means it is possible to secure a commitment to use the name only in a certain way, for example, to avoid any colours associated with your brand or to display an express disclaimer that the other party is not associated with you. You may wish to give similar undertakings in return when, for example, you are both well-established and have effectively been co-existing for some time, and where there is no significant 'real world' overlap between your respective supporters.

3. Civil proceedings – interim injunction

In some cases, where the damage caused is immediate and significant, the court might be willing to make an order that prevents the other party from using the infringing marks without making you wait until trial. This is called an interim injunction – an order made pending a full trial of the issues.

The legal threshold is high – you would usually need to show that you have a strong case and that financial compensation would not be sufficient. The court would usually also ask you to pay a sum of money into court, which would be used to compensate the defendant if it turns out that you have asked the court to make the order too soon, and that the defendant has suffered loss as a result.

However, where you are able to persuade the court to grant an interim injunction, this can be an effective way of bringing the matter to a head. The defendant is often willing to settle your claim by agreeing not to use your name any more, without waiting for the case to go to a full trial.

4. Charity Commission

Where you are concerned that another charity is using the same or a similar name to yours, an alternative option is to ask the Charity Commission to exercise its powers under charities legislation to issue a direction to the infringing party for a change of name.

The Commission can issue a direction on the basis that the names are ‘too like’ each other or that they give a ‘misleading impression of a connection’ between the parties.

However, the Commission notes:

*‘in the context of disputes about names, we expect the parties involved to take **all reasonable steps** to resolve the dispute (including, for example, mediation) before we will be prepared to exercise our powers.’*

This means that it will usually want to see evidence that the trustees have already made extensive efforts to settle the matter through negotiations, before it will consider stepping in.

However, if you want to persuade the infringing party to negotiate with you and agree terms for a rebrand or for co-existence, giving an indication that you may refer a dispute to the Commission can be just as effective as sending a letter before claim.

5. ISP takedown

If an internet service provider (ISP) becomes aware that it is hosting material that infringes your intellectual property rights, but it does not remove it ‘expeditiously’, then it, as well as the infringer, may become liable.

Most ISPs have terms and conditions that allow them to suspend or remove a website if it is being used unlawfully. So if you are not able to reach agreement with the infringing party, you could consider contacting the company that hosts its website to request that they suspend the offending pages. This usually results in the website being taken offline.

Taking decisive action in this way sends a clear message about your commitment to protect your

brand and, in our experience, it can have a strong deterrent value.

However, it is important to be confident that your claim is a good one before taking this step, because if the website is taken offline at your request and the infringer suffers financial loss as a result, you could be liable.

6. PR-based approaches

Charities often have fewer financial resources than commercial organisations, which can make it difficult to take effective action against a commercial infringer with more money to invest in defending itself, and can weaken the charity’s position in negotiations.

At the same time, charities may have greater public support than a commercial business, which means that charities may be able to leverage the threat of bad PR to persuade a commercial organisation not to engage in a public dispute, such as defending a claim at court. In our experience, this can be a key factor in successfully negotiating settlement with well-established and wealthy commercial organisations.

Summary

Issuing a claim at court is not the only option when another party uses a similar name that confuses your supporters. Whether a traditional, legal approach or more creative route is best will depend on who the dispute is with and the nature of your case.

Find out more

Our Intellectual Property team can advise on any aspect of protecting your brand, including the best options in your specific situation.
<http://www.bwbllp.com/services/intellectual-property-and-information-law/>