

IP in the news

Recent actions to protect trade marks demonstrate the value of protecting your brand, and the potential reputational damage of too heavy-handed an approach to enforcement.

By the **Bates Wells trade marks team.**

Greta Thunberg trade marks her name

Climate change activist Greta Thunberg has taken the (in our judgement, entirely wise) step of registering her name as a trade mark. We can't find a form of words for describing the rationale better than her own Instagram post, which explained that her name and that of the #FridaysForFuture movement:

'are constantly being used for commercial purposes without any consent whatsoever....It happens for instance in marketing, selling of products and people collecting money in my and the movement's name.'

'This action is to protect the movement and its activities,' the activist continued. 'It is also needed to enable my pro bono legal help to take necessary action against people or corporations etc who are trying to use me and the movement in purposes not in line with what the movement stands for. I assure you, I and the other school strikers have absolutely no interests in trademarks.'

But unfortunately it needs to be done.'

We can forgive her avowed non-interest in trade marks given all the unqualified good that she is doing. It's really depressing that even someone like Ms. Thunberg finds that unscrupulous types are taking advantage of her good name and reputation. Unfortunately, in our work with charities, we do sometimes see commercial parties borrow our clients' brands in ways that amount to blatant abuse. Trade mark registration is probably the single most important thing you can do to help ward off this kind of behaviour. Even if you are unlikely ever to sue a third party (and one hopes that Ms Thunberg's 'pro bono legal help' doesn't get over-excited on her behalf), the mere fact that your name or brand is registered will function as a 'hands off' to potential wrongdoers.

Ms Thunberg's actions also help to underline that there are all kinds of things that are potentially eligible for trade mark registration. These include not just conventional 'brand names' but also logos,

Trade marks team



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I help businesses and charities of all kinds, from start-ups to world-famous institutions. We have a super-specialisation in working with INGOs to secure control of their brand in their 'field' territories, and work with networks of local contacts throughout Africa, China and the Indian sub-continent. I've been at Bates Wells for more than a decade and know the non-profit world – and the challenges you face – inside-out.



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I'm a dual-qualified Chartered Trade Mark Attorney and European Patent Attorney. That means that I clear, register and enforce many different types of interesting Intellectual Property (IP).

From big charity names to fashion designs. From cancer campaign logos to social media use. From financial business brands to surgical instrument inventions. The team and I advise charities, membership organisations and socially responsible businesses.

personal names, and in some cases, slogans, shapes and even colours: in short, anything that the public will recognise as being distinctive of you or your organisation.

Non-profit owner bosses big corporate

Every so often, big business, in conjunction with the media, reminds us of the folly – and potential PR consequences – of taking too-strong legal action against charities.

Khadijah Ward set up a non-profit organisation called Dark Girl Boss (<https://darkgirlboss.com>), which aims to encourage women and girls to be economically independent and start their own businesses. She applied to register the word and logo trade mark below, covering, among other things, printed publications and clothing.

She was surprised to receive a threatening letter from lawyers acting

for Hugo Boss, who by her account, asked her within seven days not only to withdraw her trade mark application, but also to cease all use of the name 'Dark Girl Boss', including deletion of Twitter accounts and other social media pages.



Not deterred by the threat of litigation by a major corporate, Ms Ward took her complaint public, talking to major media outlets including the BBC about what she perceived as a heavy-handed approach with no merit.

It seems to us that Hugo Boss saw a potential PR storm brewing and (in our view, wisely) backed away, issuing

a relatively bland statement that they had 'reviewed' the matter and 'elected not to pursue it'. However this did not come soon enough to stop allegations of Hugo Boss' 'intimidation and bullying' making it into the press. We won't offer a view on whether or not these accusations are fair; we will say that there are ways of dealing with a potential dispute with a small charity that don't involve the threat of imminent court proceedings. The irony here, of course, is that Hugo Boss, in seeking to protect its brand, may have done its image a lot more harm than good.

STOP PRESS

After this piece was written, comedian Joe Lycett changed his name by deed poll to 'Hugo Boss' in protest at the fashion brand's heavy-handedness. We think an opportunity for an 'I am Spartacus' moment may have been missed.



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Prior to joining Bates Wells, I gained extensive experience with more than 18 years in private practice working across a breadth of market sectors from business and technology through to fashion, pharmaceuticals and media, as well as those in the biotechnology and oil and gas sectors.

I also have particular knowledge of conducting IP audits, and management of complex disputes.



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I advise on what to do if someone is using your name, brand or copyright work, or if there's a dispute over a contract, grant or another legal relationship.

I'm also the joint lead on our counter-fraud work. So, I advise charities, social enterprises and businesses on how to prevent fraud, and what to do if someone does take their money or data.



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I am a CITMA-qualified Trade Marks Paralegal and assist with all aspects of brand protection, including the filing and prosecuting of trade mark applications in the UK, Europe and around the world, and the management of domain name registrations. I also conduct legal and commercial research on intellectual property matters.

IPO rules theirs is nothing like a dame

On a slightly lighter note, centenarian Dame Vera Lynn may just have become the oldest successful trade mark claimant in history.

Drinks company Halewood International Brands Limited applied to register the name VERA LYNN as a trade mark for 'alcoholic beverages'. Dame Vera, 102, lodged an opposition at the Intellectual Property Office, and was successful in blocking registration. Dame Vera was able to persuade the IPO that use of her name in this way amounted to a 'misrepresentation' that there was a business connection, leading to a finding of 'passing off' – infringement of an unregistered trade mark right. This was despite the fact that she had no background in 'endorsing' products for

commercial benefit. The IPO also found that Halewood had acted in 'bad faith' when filing its application.

Halewood ran the novel argument that its choice of brand was derived from Cockney rhyming slang: 'Vera Lynn', or more correctly simply 'Vera', is used to denote 'gin'. But it provided little evidence to back up this claim, and more importantly was not able to persuade the IPO that the choice of name would be recognised by consumers as a reference to the beverage rather than the singer.

Aside from the novelty value, this outcome goes to show that well-known people (including those in the charity sphere) should stand a good chance of protecting use of their names where that use would be obviously misleading or otherwise unfair.

BRANDWARE TRAINING FOR CHARITIES

Bates Wells' BrandAware training is provided by our sector-leading trade mark lawyers. It explores the key elements of legal brand awareness for charities:

- What counts as 'brand' from a legal viewpoint.
- When your people need to think legal.
- Common pitfalls for your charity in the branding sphere, and how to avoid them.

Our BrandAware training draws on real-life examples (anonymised of course – confidentiality is important to us) and tailor-made fictional case studies based on your own branding and trade marks.

The cost is £350 (plus vat) for a 90-minute session.

We can either come to your offices or we can host – there is no extra charge either way.

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