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Protecting your brand & IP against look-a-likes and infringers

ADVISORY | DISPUTES | TRANSACTIONS

IP rights in your product

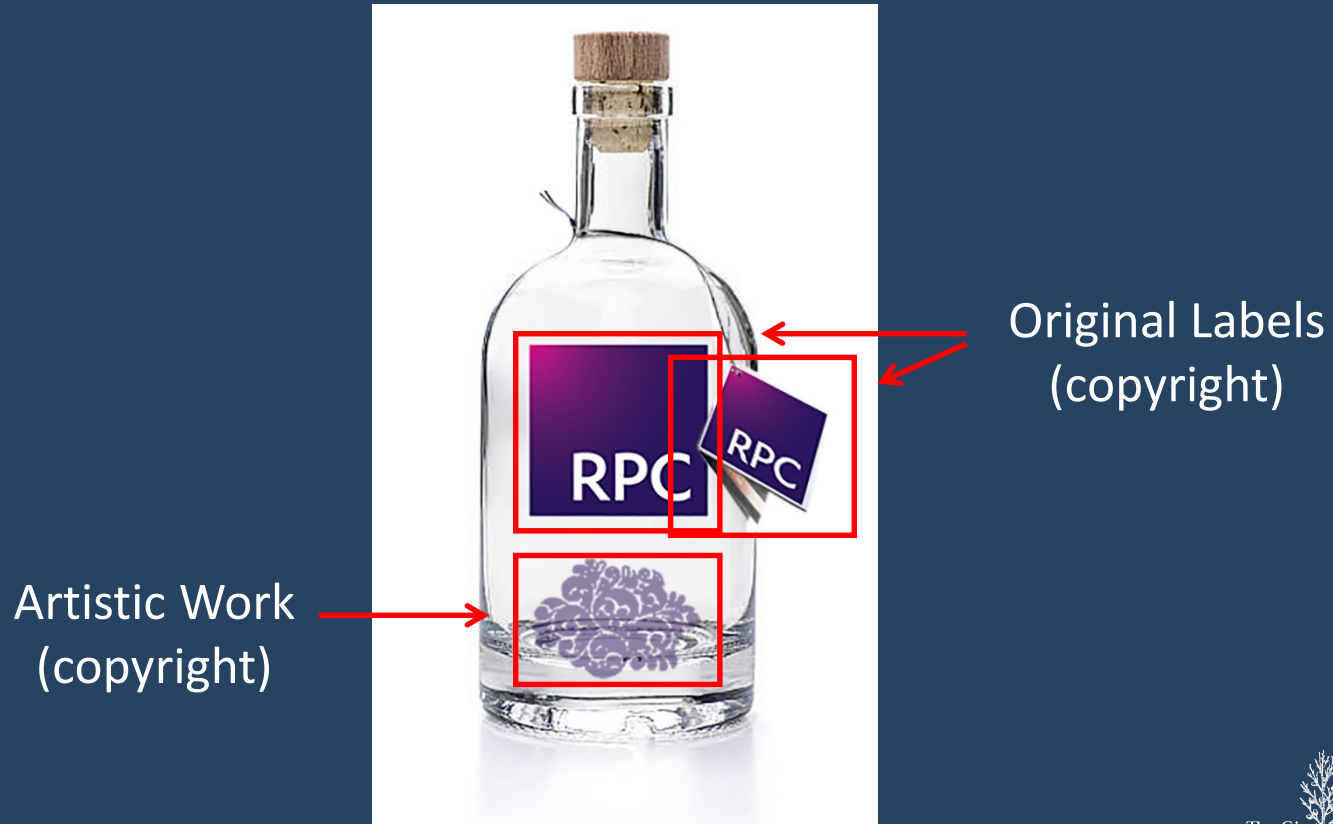


IP rights in your product

Brand
Name/Logo
(trade mark)



IP rights in your product



IP rights in your product

Design of Bottle/Box
(unregistered design
right, registered
design, trade mark)



Other IP rights

- Recipe (confidential information/trade secret)
- Distillation process/techniques (confidential information/trade secrets/patents)
- Website (Copyright/database right/passing off/trade marks)
- Advertising and Marketing campaigns (Copyright/trade marks)



Capturing your IP rights

A checklist

- Clear brand name
- Register trade marks in relevant territories
- Ensure trade marks are accompanied by ® (if registered), or ™ (if unregistered)
- Use copyright notices (eg © [year of creation] [name of rights-holder])
- Include clear statements on IPR ownership in website T&Cs
- Obtain written IP rights assignments from all third parties, eg design agencies and consultants
- Consider registering bottle/box design
- Keep recipe confidential – make sure any disclosure (even to potential investors) is subject to a NDA
- Consider if there is any patentable subject matter in the distillation process – if so, do not disclose details prior to filing a patent application

Tackling an infringer – the supermarket



*Champagne Louis Roederer SA v J Garcia Carrion SA [2015]
EWHC 2760 (Ch)*

Tackling an infringer – the online marketplace

L'Oréal SA v eBay International AG [2009] EWHC 1094 (Ch) – UK High Court

BACKGROUND

Users directed to infringing products via eBay sponsored links to their online marketplace

Liability of eBay as online marketplace

Online marketplace providers liable if:

- they play an active role in the promotion/sale of the trade marked goods; or
- if having gained knowledge that the offers for sale were unlawful, they fail to act expeditiously

Injunctions against future, as well as past, infringing activity available for brand owners

Steps to take if you suspect infringing activity

- Investigate
 - *identify the infringer (e.g. check Companies House and obtain filed accounts)*
 - *identify the extent of the infringing activity (eg Google searches, social media presence, consult your distribution network)*
 - *hire a private investigator*
- Collate evidence
 - *make a discrete test purchase*
 - *collate infringing marketing materials and take screenshots of infringing activity (social media, infringing website etc.)*
- Consider legal options/strategy
 - *notice and takedown*
 - *cease & desist letter with undertakings - IP infringement proceedings*
 - *ISP blocking orders*



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