

ANTI COPYING IN DESIGN

Issue 54



NEWSLETTER

## GUEST EDITOR

Dominic Young, CEO of  
The Copyright Hub P 6 - 7

## PROFILE

The IPO interviews ACID Member  
Rob Scarlett P 16 - 17

## BRAND PROTECTION

ACID Member Trunki Case Study P 14 - 15

## CASE STUDIES

ACID Member HALO- IP enforcement  
action in China

A Double for ACID Members Burgon &  
Ball in two IP Settlements

eBay obtains the cancellation of  
marks BEAUTYBAY

UK Copyright in Tableware Surface  
Designs Nick Boydell from ACID Legal

Affiliate Bird & Bird

P 8 - 13



## IN THIS ISSUE



Dids Macdonald, Letter  
from ACID's CEO

4-5



Case Studies:  
ACID Member HALO - IP  
enforcement action in China  
A Double for ACID Members  
Burgon & Ball in two IP  
Settlements

8-9



Guest Editor, Dominic  
Young, CEO of  
The Copyright Hub

6-7

Case Studies:  
eBay obtains the  
cancellation of marks  
BEAUTYBAY

10-11

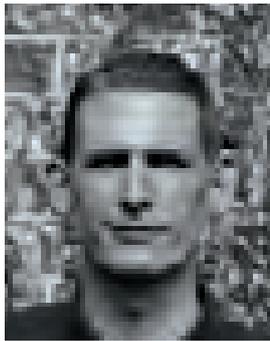


UK Copyright in Tableware  
Surface Designs  
Nick Boydell from ACID Legal  
Affiliate Bird & Bird

12-13

Brand Protection Online -  
ACID Member Trunki Case  
Study

14-15



ACID Member Profile: The  
IPO interviews ACID Member  
Rob Scarlett

16-17

How to access help from the  
Police IP Crime Unit (PIPCU)

18-19



Discovering Knock Offs  
Online- what can you do?  
Gavin Llewellyn from ACID  
Legal Affiliate Stone King  
discusses

Member Focus: Crofts and  
Assinder

20-21

Intellectual Property  
in a Digital Age by Kelly  
Hudson of ACID Legal  
Affiliate McDaniel & Co

22-23



Events

24

# DIDS MACDONALD



## DEAR ACID MEMBER

*Many thanks  
to all of you  
who responded  
to the request  
for feedback to  
contribute to  
the IPO 2020  
strategy ...*

... I created these into case studies which were forwarded to the IPO CEO John Alty in July. Sadly, some of the responses were not all positive. Notably, the message resonating was the cost and difficulty of taking legal action, the time/expense it took to get redress and the feeling that the UK Government was not doing enough to bolster IP enforcement. Respondents felt totally frustrated with what, in so many instances, appears to be impenetrable access to justice in the international arena.

I also took part in two round table meetings with Baroness Neville Rolfe who steered discussions around modernisation of the IP rights framework, education and awareness, enforcement and the international IP framework. The good news for designers is that design registrations are to be made more user-friendly and they will become digital by April 2016. True, it is so much easier to take legal action if you are in possession of a registered design, but this has to be matched with a much easier route to enforcement. I think what many policy makers forget is that before a case actually reaches a final Court hearing, even though the process has been vastly improved and simplified, a long chain of often wildly expensive



Delighted to be presented with the BIID Honorary Fellowship by Chairman and broadcaster Daniel Hopwood

letters between solicitors will have taken place. For most micro and SME designers, therefore, litigating is still the luxury of the few!

Discussions at both meetings highlighted alternative dispute resolution (ADR) and the need more education and awareness. ACID is in further collaborative discussions with the IPO to develop mediation as a real alternative to litigation. ACID's experience is that, "It's good to talk" and our mediations at 3500 exhibitions, and also our additional mediation framework without lawyers, works really well with a 97% success rate.

At a major IP insurance conference organised by the IPO in July, I shared ACID's new, affordable IP Insurance model "IP Insured" with delegates. If you haven't yet considered this it really is an affordable weapon in your IP armoury.

Further improvements for designers will mean that providing notice of registered intellectual property rights by marking a product is now optional and will allow the rights holder to highlight that the design is registered by linking to a website. This means that infringers cannot claim that they could not have known that the design was protected. Government is seeking views on proposals to help designers enforce these rights.

“

*Interestingly, during the meeting with the Minister, a BIID representative told us the continuing sorry saga of responding to tender and how little IP respect there is. I hope to work with BIID to establish positive talks about how we can change the status quo.*

”

June was a really memorable month for me when it was announced in Her Majesty's Birthday Honours that I had been made an Officer of the British Empire (OBE) for services to the Design Industry. I am immensely proud and honoured and will go to the Palace in the Autumn to collect my Honour. I also had the privilege of being made an Honorary Fellow of the British Institute of Interior Design. (BIID) at their **excellent annual conference "Who do we think we are?"** held at RIBA. Interestingly, during the meeting with the Minister, a BIID representative told us the continuing sorry saga of responding to tender and how little IP respect there is. I hope to work with BIID to establish positive talks about how we can change the status quo.

**Since improvements and development of the ACID Design Databank, we have seen a remarkable number of designs being lodged, so keep them coming! Many of you, during the last ten years, will have spoken to the remarkable Sheila Carter, custodian of the Design Databank since 2006, before it went online. Sheila is retiring at the end of the year and I would like to extend our enormous thanks and wish her all the luck in the world. They don't make too many like Sheila!**

And finally, **ACID COUNCIL** – do you want to shape ACID's future? ACID has reached a critical time in its growth and is looking forward to creating an ACID Advisory Council. We are therefore seeking applications from within membership to be part of the next exciting phase. The new Council will provide strategic guidance in line with ACID's mission, vision and objectives to ensure ACID's position as one of the leading voices for design and intellectual property in the UK continues to grow and gain traction within IP policy making. We are determined that the credentials of ACID are maintained whilst seeking ways in which ACID broadens its remit to protect intellectual property more effectively and achieve growth for its members and the wider design community.

The four ACID members companies chosen will commit to a two year term to become part of the ACID Council. To submit your application contact [jane.banyai@acid.uk.com](mailto:jane.banyai@acid.uk.com)

*Warm regards, Dids*

*Jane Banyai*



**GUEST EDITOR**

*Dominic  
Young,  
CEO  
of The Copyright Hub*



**The Copyright Hub is making copyright work the way the internet works - and now it's becoming real with the launch of our first working service.**

<http://www.copyrighthub.co.uk/Documents/Hub-Launch-Press-Release-300715.pdf>

It was born out of the Hargreaves Review proposal for a “digital copyright exchange”. The whole creative sector, including partners like ACID, got behind it with funding, ideas and help. We then partnered with the government-funded Digital Catapult to develop the technology to turn vision into reality. And now that we have started to make it real, with the launch of our first working implementation, it has become something with the potential to re-wire the internet to understand rights. We started by thinking about copyright at its most basic. At its heart is quite simple. It's a law which says two things. When someone creates something, they own it. And if they own it, they can say what happens to it. So for copyright to work well, creative work needs to maintain a connection to its creator.

### *So what is The Copyright Hub doing and how will it work?*

Firstly we're making it easy to attach unique, resolvable, identifiers to any piece of creative work.

Secondly we're making it possible for machines to talk to each other about rights. Existing systems, identifiers and databases, like ACID's, can plug into what we're doing and gain new capabilities by doing so. Behind the scenes it's all open source and it's a “distributed” architecture: every content owner is responsible for their own metadata. The Hub just makes the connections.

“

*Existing systems, identifiers and databases, like ACID's, can plug into what we're doing and gain new capabilities by doing so.*

”

In practice it means users who can find content online will be able to find rightsholders and get licences with a click or two, with all the complexity hidden away. Equally, anyone who creates anything, regardless of their status or motivation, will be free in practice to use their legal right to decide what happens to their work – whether or not they're making their living from their creativity or aspire to.

**The Copyright Hub is non-profit, not sharing revenue or levying charges, and the system is free to use globally. We exist only because of our broad support, and we will thrive as our support grows.**

If you value creativity and want IP rights to work better, please go to our new supporters site:

<http://www.copyrightdoneright.org/>, add your testimonials and logos, and be in touch. Please consider making a donation to support us as well, if you can.

We have 100 applications already in our pipeline, and we have launched the first one. The sooner we can launch the next 99, and the next 100 after those, the more we'll be able to change the internet for the better and empower every creator to fully use the freedoms copyright law gives them.

Wish us well!



# CASE STUDIES

## ACID MEMBERS HALO – IP ENFORCEMENT ACTION IN CHINA

### HALO

The first few months of 2015 have been successful in China on the IP front for the Halo Group (including Halo Creative & Design Limited, Halo Trademarks Limited, Halo Furnishings Limited and Halo International Holdings Limited, together “Halo”).

Halo has recently agreed settlement terms with the Chinese company Foshan Shunde Ronghe Trade Co.Ltd (“Ronghe”) who were copying many of Halo’s designs, most notably the Tom Cat Chair and the Mars Chair. Ronghe has confirmed that it will cease manufacturing, selling and offering for sale certain products which infringe Halo’s registered design rights in China, as well as destroying all brochures and internet marketing materials in respect of such products. Ronghe has also paid damages to Halo.

In addition, Halo is continuing to make waves on Chinese e-commerce platform Alibaba. To date, over 1000 links to copy product (including furniture and lighting) have been deleted as a result of Halo’s complaints. Halo is very grateful to Alibaba for their continued support in protecting Halo’s intellectual property.



Commenting on Halo's proactive IP strategy, Dids Macdonald, ACID's CEO said, "Following meetings last year with Halo's Chief Legal Counsel, Emily Haslam last year at the UK/China IP Symposium in Beijing, a UK meeting took place with designers and manufacturers and a China IP Group has been formed at the highest level to start positive dialogue, with China's IP attaché Tom Duke and the UK IPO's International Director Neil Feinson, to bring interested parties together. Its raison d'être is to discuss the real crises that many UK companies face with ongoing infringement. Information sharing is essential to raise awareness and we will be holding a 2nd IP symposium in October to deal with not only the challenges but to be a united voice against the continuing challenges."



Halo is continuing to send out cease & desist letters to infringers, as well as attend tradeshows to search for copy product. At the Canton Fair in April, Halo successfully enforced its registered design rights against three Chinese copyists who were displaying and offering for sale copies of the iconic Tom Cat Chair, Mars Chair and Valkyrie Desk. The copy products were labelled as infringing, covered and removed from the stands.

Halo takes pride in its dedicated design teams and has a strong history of original and innovative design under the Halo brand. It is dedicated to protecting its product designs and will not hesitate to take action required to enforce its rights and protect its intellectual property in all jurisdictions.

[www.haloliving.co.uk](http://www.haloliving.co.uk)

## A DOUBLE FOR ACID MEMBERS BURGON & BALL IN TWO IP SETTLEMENTS!



Anti Copying in Design members Burgon & Ball, renowned for their design-led innovation within the garden sector, are no strangers to IP issues. During the last two years the company has experienced numerous infringements and has developed a strident IP strategy resulting in two recent disputes settling. The first related to the unauthorised use of Burgon & Ball's products to advertise Greenman Garden Product's goods and the allegations related to passing off. The second, a dispute with VegTrug, related to Burgon & Ball's Verti Plant vertical planters, for which Burgon & Ball have UK registered design rights:

In each case Burgon & Ball received undertakings from the other party and therefore ensured continued protection of its valuable IP rights, which make up the core asset of its business on the basis that the vast majority of its innovative products are designed in house by their creative team.

ACID Comments, "After so many IP challenges, the message has to resonate within the garden sector that, as an innovative market leader, Burgon & Ball are determined to ensure that their significant investment in research, design and development will not be eroded by any unauthorised use of their intellectual property rights. "

Heather Culpan, MD of Burgon & Ball said, "Over the last few years we have undertaken a significant campaign to ensure protection and enforcement of our IP. That was not something that was easy but was necessary and thankfully we have seen significant results and a clear reduction in cases of infringement. It is an ongoing battle but for a design led business such as ours, it remains hugely important."

Kelly Hudson, an IP expert at McDaniel & Co, one of ACID Legal Affiliates said, "This is yet another positive outcome for Burgon & Ball. Their priority on IP awareness, registration and enforcement has paid dividends for them. Through ACID they have acquired a significant knowledge of their IP rights, a fundamental step in any effective IP strategy. The creation of tradable IP rights to see a return on investment is something which should not be eroded by those who would appear to take the fast track to market"

[www.burgonandball.com](http://www.burgonandball.com)  
[www.mcdanielslaw.com](http://www.mcdanielslaw.com)



## eBay obtains the cancellation of marks BEAUTYBAY



Many trade mark owners believe that if they succeed in registering their mark, the mark will then be secure. This is incorrect and the dispute between eBay, Inc. ("eBay") and Dotcom Retail Limited ("Dotcom") shows that even a registered mark can be attacked (and cancelled) several years later.

Dotcom registered marks for BEAUTYBAY, BEAUTY BAY and BEAUTYBAY.COM (the "BEAUTYBAY marks") in August 2007. However, in 2012 eBay requested their cancellation.

eBay owned various marks for "eBay" which had been registered before the BEAUTYBAY marks were filed. In eBay's view, the BEAUTYBAY marks created confusion with its eBay marks and took unfair advantage of eBay's reputation. Dotcom's response was that its marks had been registered for a long time and that by waiting so many years before attacking them eBay had, in practice, consented to these marks. That argument failed for

two reasons: eBay denied it had been aware of the BEAUTYBAY marks; therefore, it could not have consciously consented to them. More importantly, for this type of defence to work, Dotcom had to prove that its marks had not been attacked for at least 5 years after they were registered. Dotcom's marks were registered on 24 August 2007 but eBay filed its cancellation action on 22 August 2012, 2 days before the end of the 5 years period.

Dotcom successfully argued that the BEAUTYBAY marks were too different to the eBay marks for the public to be confused. However, eBay successfully proved that in 2006 (date when the BEAUTYBAY marks were filed) it already enjoyed a reputation in the UK and that, when seeing the BEAUTYBAY marks, the public would make an association with eBay.

**"That argument was crucial. The public may not have been confused into thinking that eBay was behind the BEAUTYBAY marks, but it would have assumed that**

**BEAUTYBAY was an auction site (specialising in cosmetics) like the eBay website. It was because of this connection with eBay that the public would choose to go and visit the BEAUTYBAY website."**

As a result of this connection Dotcom was able to increase the number of visitors to its website and its sales. The BEAUTYBAY marks took unfair advantage of the eBay marks because they benefited from eBay's power of attraction. On that basis, the BEAUTYBAY registrations were cancelled.

This dispute shows why it is important to conduct searches before a mark is applied for and/or used. If a mark conflicts with somebody else's rights it could still be attacked years later and this could prove extremely costly if, as a result, the mark has to be removed from all products. Costs and damages may even have to be paid.

The scope (and therefore cost) of searches can be adapted to the needs of the trade mark owner. However, this is a crucial investment which could save a lot of trouble and money.

Yoann Fouquet  
Trade Mark Attorney at Venner Shiplely  
[www.vennershipley.co.uk](http://www.vennershipley.co.uk)







adamant that she had never seen any designs by BSL. However she did admit that she read the Sunday Times Style magazine and attended the 2006 Maison et Objet design show; in both of which the BSL's Red Berry collection had been shown.

The judge was not convinced by Sabichi's evidence of an alternative source of inspiration for the designs; although the designer stated that the inspiration came from photographs found on the internet. Overall he found that Sabichi had not explained away the similarities between the designs; although he accepted that the designer did not recall seeing the BSL design, he could not exclude the possibility that she had seen them but had now forgotten. As a result, the judge found that there had been copying of a substantial part of BSL's design, which resulted in copyright infringement.

As a result, the judge awarded BSL an account of profits of over £30,000, plus interest. This case highlights the importance of creating a paper trail when making a design. As well as the date of the design and the

**“He noted various differences pointed out by the defendants (such as the smooth twig of the Red Blossom design as opposed to the more realistic and more detailed appearance of the Red Berry design), but overall the judge considered that he would struggle to say which was which without close inspection.”**

designer, the documentation should record the influences behind a design; this will help in the event of any future dispute, to either support the originality of the copyright work, or to rebut an accusation of copying.

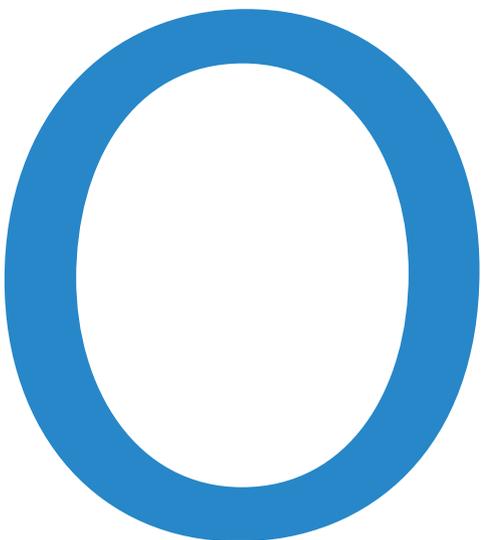


## BRAND PROTECTION ONLINE – ACID member Trunki Case study.

“

LAURA BREEN, TRUNKI'S HEAD OF LEGAL, WRITES:

IN THE EVER-EVOLVING RETAIL LANDSCAPE, SUCCESSFUL BRAND PROTECTION REQUIRES CONTINUAL MONITORING OF ONLINE AND OFFLINE INFRINGEMENTS. TO DATE TRUNKI HAS IDENTIFIED APPROXIMATELY 30 DIFFERENT FAKES AND 100% COPIES OF OUR RIDE-ON SUITCASE, AND CHINESE DESIGN PATENTS ARE CONTINUALLY FILED ON OUR ORIGINAL DESIGN. ”



### Online

*Within the UK, marketplaces, such as Ebay, respond punctually. The real challenges are beyond our shores. Originally, Trunki formed good relationships with Alibaba and tried to administrate takedowns directly, although this was unsustainably difficult and time-consuming. As they reached beyond China, and new 'sister sites' arose (Aliexpress, 1668, Tmall, Taobao and so on) Alibaba become an impenetrable fortress. Recent years have seen the rise of other prolific offenders in Europe, such as Allegro. Alibaba, to their credit, are working closer with Brand owners as they extend internationally, and are clarifying their rules. Taobao, however, being internal to China, is protected by the obscurity of Chinese IP law and the infinite paperwork and hoop-jumping that goes with it. The Polish and Russian justice systems expect take down requests to be reported to the police; something marketplaces seek to avoid. Consequently, language and legal barriers make contact and delisting infringements insurmountably difficult.*

So having an online brand protection company is truly invaluable and Yellow Brand Protection have provided global scope of protection, through employing staff with language ability and cultural understanding to communicate with marketplace offenders in all regions. Their relationship with Alibaba group enabled swift resolution to recent false claims made by a rival to Tmall and without Yellow's insider knowledge, the situation would have had an unthinkable impact on our brand. Chinese marketplaces can take up to three months to respond but success rates average 90%. In Europe, Yellow work hard to highlight design infringements to Allegro. By making a purchase of the most prolific copy from an infringing retailer and presenting detailed evidence as to why it infringes, Allegro are then bound to take down this infringing product from all retailers who offer it; something impossible to achieve without Yellow's systems and strategy.

Highly developed software and a mutually-developed library of key words flag up potentially infringing listings on a vast range of sites. Trunki copies have recently been found on Jumia.com – a Russian branch of Taobao - and Arabic Alibaba to name just two previously unknown to us. As you grow your brand in new markets, this foresight is invaluable. The personal contact with Yellow means their understanding of our brand quickly enables them to distinguish authentic listings from infringements. Once infringements are filtered from the list of potentials, takedowns are actioned based on our registered rights.

#### Offline

Registered rights are as invaluable offline as they are online. Much in the way that online protection companies work, specialist IP solicitors have both the skills and contacts to target retailers with cease & desist letters that adhere to the laws of that territory, and such knowledge has proven invaluable to Trunki across Europe. However, fighting the offline battle is considerably more costly.



“

Laura comments, “ACID are proof that reaching out wins wars. Members range from start-ups to SME's and larger firms so if you don't know the answer to a question, somebody will. Through working with Dids and the team, I am privileged to be involved with such initiatives as the China IP Group, forming invaluable links with Tom Duke, IP Attaché, Beijing and the China British Council. Closer to home, regular round table discussions and workshops keep me up to speed with IP developments in the UK, Europe and beyond. By working hard and together to protect our brands, we can stay one step ahead of the fakes.”

”

1. Ensure your IP strategy tallies precisely with your brand growth plans and sales in that region to justify this expense
2. Map your current areas of international distribution and protect accordingly
3. As you look to expand, enlist IP protection before you get there
4. As an absolute minimum, have your trademark fully in place before you launch
5. Develop an in house IP strategy in areas of little brand presence to inform of infringement in writing. NB: this approach relies on the assumption English is understood - Trunki have only had a 50% success rate, but positive results range from Greece and Cyprus to as far as China and Australia.
6. An in-house strategy rarely competes with legal language and the ability of a specialist IP lawyer
7. Keep watch! As well as Yellow's eagle eyes, Trunki regularly monitor online activity and liaise with their international distributors to ensure no online infringer goes unnoticed
8. Create & communicate - by developing in house tactics such as these letters, and registering as many alternative design ideas, Trunki are staying prepared for any eventuality
9. Creativity got you where you are today so use it to get creative with your IP strategy and keep you ahead of those taking advantage of your ideas

[www.trunki.co.uk](http://www.trunki.co.uk)

**If you want to belong to the China IP Group contact [help@acid.uk.com](mailto:help@acid.uk.com)**

# MEMBER PROFILE

[www.scarlettdesignuk.com](http://www.scarlettdesignuk.com)



A MEMBER OF  
**ACID**  
Anti Copying in Design

“ I sort of fell into furniture design gradually ”

**ROB**

## SCARLETT

**R**ob Scarlett founded his furniture design company “Scarlett” in early 2010.

He has enjoyed success with ranges launched through many well known UK retailers such as Heal’s, Marks & Spencer and John Lewis.

Rob studied ‘Furniture and Related Products’ at Birmingham Central University. Rob is a member of Anti Copying in Design (ACID) and relies on unregistered design rights to protect his work. He uses ACID’s Design Databank, a free benefit of membership, to record the date his designs were created.

**1** You established your company Scarlett in 2010 – when did your interest in design start?

I sort of fell into furniture design gradually. I didn't really have a specific career path in mind. I just chose to keep studying what I was good at and developed my artistic skills in the process.

**2** You won young designer of the year award in 2003 – how did that come about?

My lecturer was impressed with my work and entered me into the competition without my knowledge. I was very fortunate to win the award as it provided me with excellent connections, exposure and a job with a design company!

It was at the award exhibition that I was approached by ACID (Anti-Copying In Design) and heard about intellectual property (IP) for the first time. My knowledge of IP has continued to develop through becoming a member of ACID.

**3** You rely on unregistered design rights and use ACID's 'Design Databank' to provide third party proof of when your design was created – what do you think of this process?

The Design Databank is straightforward to use. It allows you to upload 2D or 3D depictions of your designs which then act as dated proof as to when your design was created.

I'm aware of cases where designers have been copied so it's important to have reliable, dated proof that the design is yours if you choose not to register your design with the IPO.

**4** Has one of your designs ever been copied?

No, to the best of my knowledge I've not been copied too closely. The nature of the furniture industry means that lots of new pieces are inspired by very traditional designs that have been around for centuries. Infringement in my industry is very common.

**5** What advice would you give to budding designers about maximising their potential?

**Be brand savvy** – Develop a brand that appeals to your clientele and be prepared to change it. I have changed my brand a few times since 2010 to refresh the look and feel of my company. Your brand should change as your style evolves and you attract a new client base but remember if you change your brand name or style you may need to apply for a new trade mark each time to remain protected.

**Date what you create** – Whether you decide to register your design with the IPO or rely on unregistered design rights, having a reliable dated copy of your designs is important to prove a design was created by you first.

**What are you licensing** – Be aware what IP you are signing away when you license your product to another company or wholesaler. Generally, the larger the company, the more complex their contracts tend to be.

**Promote yourself** – Be sure that your website really shows off what you and your company are about. Utilise social media channels to get your name and brand recognised in the industry. It would be near impossible for large retailers to take on pieces of your work when no one has heard of you.

**Get industry experience** – my time working for a design company following graduation was invaluable and taught me a lot about setting up on my own. Seek out opportunities to work for successful companies.

**Be prepared to sign an NDA** – Some companies may make you sign a non-disclosure agreement (NDA) if you intend to work for them so that they can keep their ways of doing business a secret (also known as trade secrets). Trade secrets can be hugely valuable assets to companies and they use NDAs to protect them.



# HOW TO ACCESS HELP FROM THE POLICE IP CRIME UNIT (PIPCU)



The **Police Intellectual Property Crime Unit (PIPCU)** is a specialist police team dedicated to protecting UK industries, that produce legitimate, high quality, physical goods, from intellectual property crime and combating online digital piracy where it impacts upon the UK economy. ACID supports PIPCU's valuable work as a partner and together PIPCU and ACID have produced a co-branded booklet **"Design out IP Crime"** aimed at providing guidance for IP protection and guidelines for buyers on how NOT to infringe IP.

The operationally independent unit was established in 2013, with funding from the Intellectual Property Office and is part of the Economic Crime Directorate within the City of London Police, the National Policing Lead for Fraud.

PIPCU's priorities are to investigate, disrupt and prevent cyber enabled serious and organised intellectual property crime which causes significant harm or damage to the UK economy or the general public in both in terms of counterfeit physical goods and digital piracy.

Rights holders can refer investigations to PIPCU via a dedicated online referral portal that can be accessed at [www.cityoflondon.police.uk/pipcu-make-a-referral](http://www.cityoflondon.police.uk/pipcu-make-a-referral) referral portal that can be accessed at [www.cityoflondon.police.uk/pip](http://www.cityoflondon.police.uk/pip)

**PIPCU provides the following advice for rights holders who are considering making a referral, Rights holders should;**

- Clearly explain what criminal activity you have investigated, how the offences were identified.

- Provide a summary of your investigation and the lines of enquiry that you have conducted.
- Provide all known details about the suspects, how they were identified and the roles they are believed to play.
- Clarify whether you believe others to be involved in the criminal activity.
- Provide key evidence and describe the other relevant material that you hold.
- Identify the individuals who will provide evidence in the case.
- Identify any potential evidence from other sources.
- Summarise the harm that has been or is likely to be caused to rights holders or the general public.
- Not take any action that would alert the suspects without prior consultation with PIPCU.
- Contact PIPCU if unsure about a specific question and would like guidance.

As well as utilising traditional police enforcement tactics, PIPCU also manages two disruption operations. Operation Ashiko targets the sale of online physical counterfeit goods and aims to seize the domains of infringers. To date, Operation Ashiko has disrupted over 6000 infringing sites. Operation Creative targets digital piracy by restricting payment provision and advertising revenue on infringing websites. PIPCU is currently disrupting over 300 of the worst infringing websites.

**If you would like to refer an investigation to PIPCU you can access the dedicated online referral portal at [www.cityoflondon.police.uk/pipcu-make-a-referral](http://www.cityoflondon.police.uk/pipcu-make-a-referral) or contact PIPCU for advice at [PIPCUreferrals@cityoflondon.pnn.police.uk](mailto:PIPCUreferrals@cityoflondon.pnn.police.uk)**

## DISCOVERING KNOCK OFFS ONLINE - WHAT CAN YOU DO?



Gavin Llewellyn, an ACID Affiliate lawyer and an IP specialist at Stone King

On-line retailers generally exclude liability for the intellectual property infringements of their suppliers and sellers. However, they may be liable for these infringements if they fail to take action once they are informed and have assessed the claim. Amazon, eBay, Alibaba, all have procedures for notification of infringements but these are often complicated. However, they are starting to become more compliant.

**Gavin Llewellyn, an ACID Affiliate lawyer and an IP specialist at Stone King said, "To circumvent the on-line merchant's claims process, you can write directly to the company to notify it of your rights. If the letter is appropriately drafted it will not constitute a groundless threat and the company is likely to take the letter seriously as its liability (and reputation) will be engaged if it fails to act. If the on-line merchant refuses to remove the items, you will need to bring a claim to enforce your rights, but the threat of legal proceedings is likely to result in the prompt removal of the items."**

You can complain to the Internet service providers (ISPs) of websites that contain infringing goods, but they may require you to obtain a Court Order before removing websites. However, there is no legislative provision for trade mark infringement, unlike copyright, and until recently website-blocking orders have not been used in this respect. One word of warning, if you don't, own the rights that you claim to own you could be liable for making a "groundless threat" which could entitle the seller of the allegedly infringing goods to sue you for damages caused by your threats.

*What if the copies and counterfeits sold on-line are available for purchase in the UK, but the website is not based in the UK or subject to UK law?*

If copies of your designs are marketed to a UK audience, your rights are being infringed. If contacting the seller or ISP does not result in the items being removed, you will need to consider whether the extent of the infringement is sufficient to take legal action. Consider contacting HM Customs & Excise with a view to preventing the importation of the infringing products. To maximise your chance of success, you should obtain as much information as possible about the goods, from where they are being shipped to what their packaging looks like. Increasingly, the UK Courts are willing to consider granting orders against UK-based ISPs preventing access to foreign-domiciled websites.

*How can you find infringing items in the first place?*

Monitoring the web for potential copies by conducting searches – either directly on websites offering similar products or use mainstream search engines. Unfortunately, it is not easy to search for images or designs. If this is too labour-intensive, some brand protection companies offer monitoring services for a fee. ACID members have utilised companies such as Yellow Brand Protection and MarkMonitor.

*What can you do if a competitor is using your brand name to direct traffic to its products?*

Counterfeiting and piracy is becoming more sophisticated, making it harder for consumers to identify genuine products. If your brand name is protected by a Registered trade mark, unauthorised use is likely to be an infringement of your trade mark. If you haven't registered your brand, you may still have a passing off claim if the other party's use of the name amounted to a misrepresentation of your business which caused confusion and damage to your brand.

<http://www.stoneking.co.uk>

# Crofts & Assinder

*Established in 1875, Crofts & Assinder Limited has a long and proud history in the design and manufacture of quality handles and fittings to the furniture and allied industries alike, catering to both high and low volume consumers.*



**C**rofts & Assinder has been creating bespoke designs since 1875. What is the importance of your brand to your company?

Our brand is very important to our company; it represents our quality, our design, our heritage and our service. It is a core part of the business and is something we value very highly.

**Y**our company prides itself on its expertise in the design and development of products to suit your customer requirements. What level of importance does this craftsmanship contribute to the future of Crofts & Assinder?

This is a vital part of the future of our business. Design is an important part of our strategy in that it enables us to bring leading edge consumer focused products to the market.

## MEMBER FOCUS



**H**ow does IP infringement impact upon your growth potential? Have you experienced an increase or decrease in copying in recent years?

It is a major threat to us. One of our unique selling points is our design innovation. When this is infringed it impacts our brand in a number of ways.

Firstly, it has a direct impact on our operating revenue. Secondly, it impacts our brand quality because in the instances where we have been copied, the infringing product is often of an inferior quality and does not match our quality standards. Thirdly, it has the ability to weaken our brand profile. From my personal experience the level of copying has remained at a consistent level over a number of years.

The threat of copying from foreign countries who then import into the UK continues, but I feel that some UK organisations are becoming increasingly bold in copying products across the industry. The only way to prevent this is to address this through the legal channels where necessary.



**T**he intellectual capital which underpins your business combines creativity and innovation with the quality of design, product, service and people. How do you protect these valuable assets?

We currently register and enforce protection all of our designs and trademarks on an international basis.

**A**CID values the support of Crofts & Assinder as a longstanding member and supporter of the organisation. How has Crofts & Assinder benefitted from this association?

ACID has been a big help over the years. On a personal aspect, Dids Macdonald is very receptive to feedback and incredibly supportive when it comes to providing advice on infringement matters.

On a business level, we have benefited from ACID in a number of ways. Firstly, the ACID newsletters keep us abreast of ongoing developments and case studies in the field. Secondly, the legal workshops have given us an opportunity to speak first hand to legal experts in the field and understand the best way of protecting our products not just in the UK, but also in our export territories. Thirdly, ACID has been very supportive in the case management of instances where we have been copied and this includes providing access to legal advice.

**W**hat 2 recommendations would you give to Government to support industry and those that work in the design sector?

I personally would like to see an extension of the UK IP law for unregistered designs to fall in line with the length of protection that registered designs have and a similar to the term for copyright law which benefits the entertainment world (music & film). The process to register new designs is expensive and I would like to see these costs significantly reduced.

I would also like to work with insurance companies to include design infringement clauses in standard business insurance policies to ensure if legal challenges do take place that your insurance covers this.

[www.crofts.co.uk](http://www.crofts.co.uk)

If you would like to take part in our Member Focus please email [info@acid.uk.com](mailto:info@acid.uk.com)



# INTELLECTUAL PROPERTY IN A DIGITAL AGE



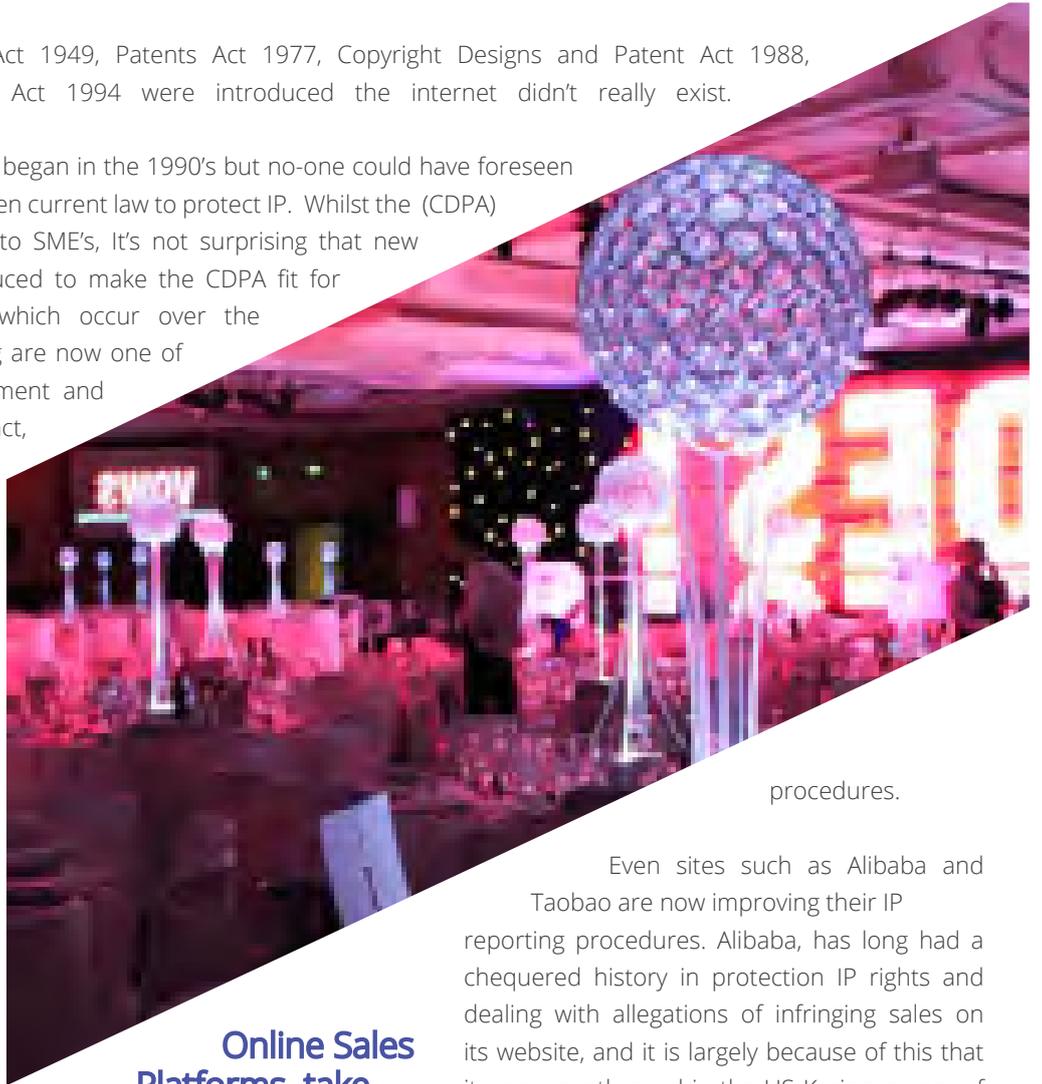
When the Registered Designs Act 1949, Patents Act 1977, Copyright Designs and Patent Act 1988, (CPDA) and the Trade Marks Act 1994 were introduced the internet didn't really exist.

Commercialisation of the internet began in the 1990's but no-one could have foreseen the impact it would have on the then current law to protect IP. Whilst the (CPDA) still offers the most protection to SME's, It's not surprising that new legislation has had to be introduced to make the CPDA fit for the digital age. Infringements which occur over the internet and online counterfeiting are now one of the main sources of IP infringement and whilst statistics reinforce this fact, it isn't all doom and gloom.

## Marketing and selling new designs online

Online marketing or online sales platforms is usually a necessity of any effective marketing plan so ensure you evaluate the risk factors and create a proactive approach to IP protection. However, online marketing greatly increases the chances of discovering knock offs and dealing with it effectively as there are now many more positive options if you do discover copies. Improved IP tracking

If someone copies your work to sell online, there's an automatic digital record of the infringement which you can use in evidence. Prior to the internet existing, it was much harder to discover infringement and more difficult to prove because often there was no audit trail in proving copying had taken place. Whilst it is obvious the internet has benefitted copyists with easy access to new designs, it has made IP rights more enforceable.



## Online Sales Platforms take down access

Because of the rise in IP claims, online sales platforms have had to respond with better means of enforcement. There had been various claims against eBay by big brands for infringing and grey market goods being sold on the site, one example is L'Oréal. This served as a warning to other sites the majority of which have good IP takedown policies. eBay has its VeRO reporting policy which enables rights holders to have infringements removed and also to obtain the name of the account holder in question if it is a private seller. Sites such as Etsy and Amazon offer similar

procedures.

Even sites such as Alibaba and Taobao are now improving their IP reporting procedures. Alibaba, has long had a chequered history in protection IP rights and dealing with allegations of infringing sales on its website, and it is largely because of this that it was recently sued in the US Kering, owner of brands such as Gucci and Yves St Laurent..

In September 2014 at the UK/China IP Symposium an MOU was signed between the China British Business Council and, as a result, there have been improvements but there is still some way to go.

**Case Study - Alibaba.** An ACID member had numerous infringing products being listed for sale on the site, many of which were being marketed with use of their photographs (protected by copyright). They experienced difficulty seeking redress because Alibaba's online reporting facility is far from user friendly. As a result of legal intervention a response was received within 2 hours from Alibaba confirming the goods would be removed next time the site refreshed. A cost and time effective result!

Kelly Hudson, [www.mcdanielslaw.com](http://www.mcdanielslaw.com)





# EVENTS & CALENDAR



**Managing Intellectual Property**

## *MIP Luxury Brand & Retail Forum London, September 23, Le Meridien Piccadilly Hotel*

**ACID**

6th - 9th September 2015  
NEC Birmingham

**ACID Accredited Exhibition  
Find ACID at Hall 5 Stand K75**

ACID Members with in-house counsel, IP counsel or brand protection managers and ACID Legal Affiliate firms are invited by Managing Intellectual Property to attend the inaugural MIP Luxury Brand & Retail Forum on September 23 in London, at Le Meridien Piccadilly Hotel. The Forum aims to meet and address the growing challenges impacting upon the luxury brand and retail industry, resulting in key takeaways for legal and brand management teams to use in their strategies.

**glee**

14th - 16th September 2015  
NEC Birmingham

**ACID Accredited Exhibition  
Find ACID at Hall 20 Stand A37**

Experts in corporations, industry associations and international legal experts will unite to discuss and exchange business critical knowledge. 80+ IP counsel from leading luxury and retail brands have already confirmed their attendance, including Chanel, ASOS, John Lewis, Alexander McQueen, Kurt Geiger, BBC, SKY, Dyson and more. In addition, with speakers from Aston Martin, Georg Jensen, Marks & Spencer, London College of Fashion and more, delegates will be sure to hear from experts in the industry. Nick Kounoupas, Chief Legal Counsel at ACID will also be speaking at the event.

**IP**

20th - 23rd September  
2015

Syon Park  
London

- Registration is free of charge for In-house counsel, IP counsel and brand protection managers.
- ACID legal affiliate members can attend at an exclusive discounted rate of £795 + VAT.

**Register online today:** <http://bit.ly/Luxury-ACID>

**Email us:** [registrations@managingip.com](mailto:registrations@managingip.com), quote LUX-ACID

**More information:** <http://bit.ly/Luxury2015>

**100% design  
india**

23rd - 25th September  
2015

Olympia Station,  
Hammersmith Road,  
London

**ACID (Anti Copying in Design) Ltd**  
PO BOX 5078  
Gloucester  
GL19 3YB

**HOTLINES**  
Membership Office: +44 (0) 845 644 3617  
Email: [info@acid.uk.com](mailto:info@acid.uk.com)

ACID Registered Head Office: 68 Lombard Street, London. EC3V 9LJ

Company Reg. No 3402512 VAT Reg. No 707 5923 23



Have a look at our Event Calendar for upcoming events on our website at [www.acid.uk.com](http://www.acid.uk.com)

Nothing in this newsletter is intended to be a complete statement of the current law and you should always take specialist advice in respect of your own particular circumstances © ACID 2015