
Inside track: BBC

The brand protection team at the publicly funded BBC must work within budgetary constraints that could confound even the thriftiest of private sector in-house teams. To compound the challenge, the infringers they must contend with may also be their shareholders

Diane Hamer, the trademark lawyer at media bastion the British Broadcasting Corporation (BBC), must grapple daily with a unique set of circumstances in fulfilling her role. But while the BBC's status as a public sector organisation means that its approach to brand protection, management and monetisation may seem unconventional to some, many of the trademark issues that it faces will ring true for brand owners from all commercial backgrounds – not least the challenges of budget.

The BBC – the world's largest broadcasting organisation – was established by royal charter on New Year's Day 1927. According to the charter, the BBC's objective is to "inform, educate and entertain" the public. It is prohibited from exhibiting political bias, offering its own editorial position on current affairs and carrying advertising. While commercial revenues from merchandising, DVD and video sales and overseas sales of programmes and formats represent a significant source of income, by far the lion's share of its funding comes from licence fees which are paid by every television-owning household in the United Kingdom.

Under hawkish public and political scrutiny, the BBC must continually justify its spending to the great British public – who are not only the BBC's main financiers, but also its key market. This peculiar duality adds an extra layer of complexity to the enforcement of its marks, where potential infringers can be both 'shareholders' and consumers. The strategies that Hamer and her team have developed to meet these challenges present valuable insights for brand managers across all industries.

All-round perspective

Hamer previously worked in television production for several years before deciding on a career change to law. She entered private practice in Australia before moving to London and joining Lovells, where she completed an in-house secondment in the pharmaceutical industry. This served as a stepping stone to becoming the BBC's trademark lawyer in 2004. "Law is my second career in life," says Hamer. "So joining the BBC, in a legal capacity,

means that I've come full circle. I've always loved working in TV and radio, so it feels like my natural home being here." Hamer believes that her broad past experience has made her a sharper brand strategist and trademark lawyer: "I love being in-house because you get to work much more closely with your clients and you become much more familiar with the needs, policies and strategies of the organisation as a whole. I think your legal advice gets tailored much more closely to what the organisation's overall objectives are. And that makes me a better, and a more engaged, lawyer."

Such an all-round perspective is a crucial tool in the BBC environment and is reflected in the way that the IP function is structured throughout the organisation. Lawyers embedded in specific business units handle everyday IP issues that arise in relation to their particular output, with more complex matters managed by a dedicated IP team which sits centrally and reports to the BBC's general counsel.

The IP team is itself subdivided into contentious and non-contentious groups. Hamer is based in the latter, alongside a trademark attorney, a patent and technology specialist, copyright specialists and a junior solicitor who works across each different area of intellectual property. It is a particularly lean team for an organisation of the BBC's size and scope. While Hamer's counterparts in the contentious group handle the bulk of the BBC's trademark disputes, she often works in tandem with them to proffer litigation-related advice. "I also advise on title clearance," she says. "That involves looking at programme titles to check for any potential third-party rights that could form the basis of claims of infringement that could be made against us."

Keeping the BBC's own activities in check is a central strand of Hamer's role – and indeed is vital to the values of the BBC itself: "As a good corporate citizen, the BBC understands the importance of intellectual property. The BBC wants to respect others' IP rights as much as we would like others to respect ours." For an enterprise with such a sensitive position in the public sphere, the strictest of standards must be upheld in order to preserve the reputation that is so integral to its role.

The BBC's international trademark portfolio comprises around 3,000 marks registered in various jurisdictions around the world, representing several hundred unique brands. Much of the administrative work involved in managing such a globally recognisable trademark portfolio is outsourced to private practitioners. UK-based law firm Bristows is a key partner in this regard. "We really benefit from economies of scale with Bristows," Hamer enthuses. "They host our trademark database, they manage

Flagship brands such as *Strictly Come Dancing* spawn a multitude of lookalike events, raising concerns that attendees will assume they are endorsed by the BBC



all of our deadlines, and they handle all the nuts and bolts of filings and prosecution. They also liaise with our foreign counsel and collate all of our foreign agents' fees with their own, so that we get a single bill. That's great for a small in-house team like us. And it means that I can always pick up the phone and talk to someone who really knows our business."

This in turn frees up Hamer and her team to focus on the strategic elements of trademark portfolio management: "What I am most involved in on a day-to-day basis is strategising about how the BBC brand is used, both internally and by our external partners. Our team's function is to service the whole of the BBC and its commercial subsidiaries, and I manage the BBC's 'house brand' all around the world, including trademark registration, prosecution and enforcement."

To protect and serve

The ubiquity of the BBC's audience means that many incidences of trademark misuse that Hamer and her team encounter are likely to

be perpetrated by BBC consumers. This necessitates a careful approach that balances audience diligent enforcement on the one hand against audience enjoyment on the other. "It is sort of counterintuitive for a trademark lawyer," admits Hamer. "For an organisation that is run for profit, the main concern is to protect its bottom line. Our main concern is that our brands don't get appropriated by third parties for their own commercial interests or for unsuitable purposes."

Hamer and her team are tasked with ensuring that the BBC's fee-paying audience are not short-changed by the misappropriation of BBC content. "Our brands are actually funded by licence fee money, and really, they're there for the nation to interact with and enjoy. The BBC feels it is really important that members of our audience have an appropriate experience of our brands. For example, one of our key brands is *Strictly Come Dancing*. It is our flagship Saturday night programme in the autumn schedules. Whenever the new season is launched, it seems to spawn tens, if not hundreds, of lookalike *Strictly Come Dancing*-themed dance weekends and dance classes, and the amount of infringing activity in relation to *Strictly* balloons in the autumn. If a member of the audience suddenly found themselves at a *Strictly Come Dancing* dance class, assuming it was somehow connected with the BBC, and was disappointed by the experience... that's something that we feel could be very damaging to our reputation."

Fan sites also present potential problems for the trademark team. In one much-publicised incident, the BBC accused a *Dr Who* fan of trademark infringement for posting knitting patterns of some of the show's characters on her personal website. The BBC argued that the knitted *Dr Who* characters created from the patterns could then be sold online for commercial gain. Fearing legal action, the fan relented and removed the patterns from the Web. But while ostensibly a success for the BBC, the media furore which its actions created suggests that the victory may have been a pyrrhic one.

As the BBC is entrusted with disseminating both information and entertainment to the British population, Hamer believes that public debate and criticism are in fact healthy for the institution.

With programming aimed at children, such as CBBC's *Hacker and Dodge*, there is a greater policing responsibility - while adults will, by and large, realise they are not on an official site, Hamer notes that "children are more likely to stumble across something without making that kind of distinction"



60-second interview

What aspects of your job do you find the most challenging?

I'd say that having only limited resources with which to protect the BBC's intellectual property is a major one, as well as juggling a high volume of work for a large number of clients from throughout the organisation. Trying to manage the often competing objectives of the organisation can also be challenging.

What aspects do you find the most rewarding?

One aspect would be the fact that I represent a brand that I am so proud of and committed to. I also relish the opportunity of working alongside clients to come up with creative solutions to their legal issues. Another aspect I enjoy is the people I work with. There is a real collegiate spirit among my colleagues.

Who has been the greatest influence on your career?

I would have to mention two partners I have worked with in my former life in private practice. Philip Kerr from Allens Arthur Robinson in Sydney and Robert Anderson at Lovells in London have both been a huge influence in my legal career.

If you could make one change to the industry, what would it be?

I wish that there was more alignment between the Internet and the protection offered by trademarks - but that is easier said than done, and I suspect it will be the Internet that drives brand protection in the future, not trademarks.

What career do you think you would have followed if not law?

I would still be in television production. That's where I started my career, and that's part of what led me to my current role.



Allowing fans to engage with the BBC, and with each other, enables them to feel more actively involved, rather than being mere passive consumers. "A brand protection lawyer's impulse is to control it all!" she admits. "But since the BBC is a public service institution, it isn't appropriate for us to be heavy handed with members of the public. For example, if someone sets up a fan site, we will take a look at it and take a sensible approach towards it. It certainly isn't our number one priority to stop it - we want our audiences to engage with our brands. The issue is more about quality control. We want to make sure that our brands aren't used in a way that is inconsistent with the BBC's brand values."

Marketing the brand

In addition to enforcing the BBC's trademarks, brand development is another important area of work for the trademark team. Hamer collaborates closely with her colleagues in the marketing department and business units to ensure that brands maintain their relevance with the audience, and that trademarks are used properly towards this end.

"We don't have a kind of niche market," she says. "Our audience is basically everyone in the UK, so we have a very complex demographic that we need to appeal to. Our marketing people are always trying to find ways to reach the hard-to-reach audiences, to keep our brands contemporary and to make sure that our brands retain a mass appeal and a value for the UK population as a whole."

One way in which these aims are achieved is through trademark licensing, and Hamer plays a pivotal role in advising the various business units on trademark-specific aspects of commercial deals they are involved in. "The everyday work on such deals will be

handled by business teams from our commercial subsidiary, BBC Worldwide, whose job it is to go out and make the sales and do the marketing. But when specific trademark issues come up - for example, if someone wants a particular type of trademark warranty - they will come to me for specialist advice."

A primary arena in which trademark licensing takes place is in the distribution of BBC programmes to third parties. As Hamer explains: "Primarily, the BBC makes, or invests in, programmes that you see or hear on air. Those programmes potentially have a life well beyond their initial broadcast on BBC One or Radio 4 - for example, in relation to books and DVDs, and other merchandise and overseas programme sales. Some typical examples are *Dr Who* and *Top Gear*, which have been phenomenally successful around the world. People who are picking up those rights overseas need to use BBC trademarks in order to market, promote and show those programmes."

Programmes aimed at young children have also proved wildly popular outside of the United Kingdom, presenting further opportunities in terms of product merchandising - and a concomitant need for trademark licensing. Much of this is handled by the BBC's wholly owned commercial subsidiary, BBC Worldwide Limited, and Hamer often teams up with her counterparts at BBC Worldwide on such matters.

Net worth

Inevitably, the Internet is an increasingly prominent feature of Hamer's daily workload. "The Internet was certainly up and running when I joined the BBC, but its scope has expanded so much in the past seven years," she says. "The BBC delivers so much of its content



BBC properties are used in a variety of media, requiring close control of their use both internally and by licensees

via the Internet today. That doesn't mean to say we've scaled back on the more traditional media channels like television and radio; they have developed a lot in that time period as well. But the Internet has evolved massively."

"The Internet is a fantastic tool, an amazing way to reach our audiences and to deliver our content," she adds. "But it comes with its own challenges for brand protection lawyers." Cybersquatting is a particular bane: the plethora of BBC brands necessitates a huge number of corresponding potential domain names – so much so that it is impossible in practical terms to try to register them all. "We simply don't have the budgets for that," states Hamer.

Pre-emption is thus a key tactic: "We have a domain name policy whereby we aim to register the most obvious domain names for each new brand we launch. Sometimes we do this because we actively want to use those particular domains. But more likely, we will register the names to keep them out of the hands of potentially malevolent third parties."

Due to restrictions of time and money, the BBC has to choose which infringers and cybersquatters to enforce against and which to leave alone. "That's a really major challenge for us. We have to tread a very fine line between doing what we can to protect the most obvious brand names, while bearing in mind that we haven't got an infinite budget." Risk assessment is thus crucial in evaluating which domain names need to be secured from an early stage. "We have to be circumspect about what we register and what we don't," she explains. "There is no examination process for domain names in the same way that there is for trademarks. We have to take it into account that if we don't register a particular domain name, and then someone else gets it and uses it to offer inappropriate content, it is often going to be very costly for us to resolve."

One tactic deployed in this regard is to imagine worst-case scenarios and then measure suspected infringements against them. "Talking speculatively, a very damaging scenario for the BBC would be a domain name under one of our children's brands that was hosting pornographic or excessively violent content," says Hamer. "That is a very obvious example of something we would consider very seriously."

The limited resources available mean that Hamer and her team must effectively entrust some of their brand and trademark policing to the market that they serve. "As our audiences become ever more attuned to the Internet, people are growing much more

sophisticated about recognising what is a genuine site and what isn't a genuine site," she explains. "And that is part of our thinking as our strategy evolves: you have to assume that if people find themselves on the wrong site, they will by and large realise they're on a website that is not associated with the BBC. But you can't necessarily assume that with a children's site. Children are perhaps more likely to stumble across something without being able to make that kind of distinction."

And the roll-out of the new generation of generic top-level domains (gTLDs) has given rise to new fears in this regard. "We have been very open about our concern with gTLDs," says Hamer. "During the consultation process, we've submitted comments to ICANN indicating how challenging we think this is going to be for us and organisations in a similar position. We have many different brands across many different regions. The huge challenge for us is going to be how we try to protect all of that."

Social media is another area where Hamer's expertise is in frequent demand, and here again her approach is underpinned by trust in the BBC's audience. The explosion of the online society means that people can now discuss, analyse and pass comment on brands with each other outside any geographic constraints, and in a very public space. While this might make many brand owners nervous, Hamer is more sanguine. "We are a public service institution," she reiterates. "People pay a licence fee to the BBC and people are entitled to criticise us. Free speech is one of the core values of the BBC; we ourselves thrive on free speech, so it would be wrong of us to turn round and try to stop other people from exercising that right."

Looking forward

When Hamer looks to the future, it is online issues and the continuing financial strains of an uncertain economic climate that she believes will continue to dominate the landscape at the BBC. "The Internet is international, it is growing and it is pretty much accessible to everyone – and that doesn't necessarily sit well with the national nature of trademark rights," she elaborates. "That is going to be an interesting test for brands as we look ahead. In our particular case, the licence fee has been frozen by the government, but the internet-related issues our brands face continue to grow. We are having to do a lot more with a lot less."

For Hamer, the BBC's audience holds the key to brand protection. "The BBC is immensely privileged to receive licence fee money. We are funded by members of the public, by individual households. What that means is that many people therefore feel a very personal connection to our brands, and have an opinion on how we should deal with them". This demands not only that the BBC's trademarks be used in a way that reflects its core values of impartiality and free speech, but also that a fine line be walked in identifying which unauthorised use might potentially be damaging and which can be left to continue unhindered.

While the BBC has an overarching duty to the public to protect its content from being exploited for commercial gain by third parties, its audience is not a passive spectator in this fight. Rather, it has a vested interest in the proper management of the BBC's valuable IP assets, and is increasingly acting as the corporation's eyes and ears when it comes to spotting infringement and misuse. In these cash-strapped times, perhaps the most valuable lesson that can be taken from the BBC's approach is the active role that consumers can play in the battle against infringement of the brands that have won their hearts and minds. [WTR](#)

Jack Ellis, *World Trademark Review*