

Brand Protection in the Social Media Frontier

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Your client's primary brand has just been hijacked! This is not about some poorly made, "Swoosh" emblazoned shoes from parts unknown. A third party has actually registered your client's primary trademark on Facebook or Twitter. Moreover, they are disseminating information that is not just opposite of the company position, it is patently false.

Just about every relevant description of the impact of social media and the internet on personal interaction and the business world has become cliché. In an effort to avoid hyperbole, we will let the numbers speak for themselves – 2008 to 2009 year over year growth rates for Twitter and Facebook, as measured by Nielsen Online, are 1382% and 228% respectively.

As with any new technology, social media presents legal challenges that, in a narrow sense, were not contemplated when the current laws were enacted. Although these new challenges are faced on myriad fronts, brand owners are one of the groups disproportionately affected by the social media explosion. This article focuses on the challenges social media and user-generated content presents for brand owners, as well as strategies to effectively resolve or prevent potential problems.

Technical Terms and Explanations

Part of the analysis in this article hinges on domain names and how they are protected – sometimes as trademarks – under the law. A basic primer on social media and domain names is necessary to better understand the forthcoming analysis.

Depending on who you ask, the term "social media" has been around since the mid-1990's or the early part of this decade. In the macro sense, social media refers to websites and internet applications where the core component is user-generated content that can be updated in real-time. Another key characteristic is that most social media platforms allow users to choose unique identifiers or screen names to identify themselves to other users. The username usually appears as some part of a subdomain in the URL for each user's page.

Internet users locate specific websites on the internet by entering unique Uniform Resources Locators (commonly referred to as "URL's") into the address line on their web browsing program. Each URL is made up of several unique parts in this order: protocol – secondary Level Domain Name (sTLD) – generic Top Level Domain (gTLD) or sometimes an international country code. Also, websites with even minor levels of complexity have what are called subdomains. Subdomains are sequenced after the entirety of the primary web address, and direct users to individual pages "within" the primary website.

In order to put social media and domain names in context, observe the following example: in the URL www.facebook.com/underarmour, the word "facebook" is an example of a sTLD, ".com" is the gTLD, and "underarmour" is a subdomain.

Problems Faced by Brand Owners

Most commonly brand owners will face a situation similar to the following. At some point, someone in marketing or another part of the organization will decide that the organization should have a greater presence on social media. Alternatively, someone will discover that a third party has possession of a username, usually on a popular social media site such as Twitter or Facebook, which is a registered mark of the organization. In either case, the organization will be faced with the situation that a third party has claimed a username which uniquely identifies the company, most likely the actual company name or a high-profile product.

Many organizations and companies will face this dilemma. However, social media sites, whether dealing with trademark claims or copyright violations, tend to follow the take-down procedures laid out in the Digital Millennium Copyright Act. If the third party is attempting to impersonate an individual from the organization or pass himself off as a representative of the company, then most social media sites will take down the offending account shortly after being notified. This has especially been true since Tony LaRussa filed suit

against Twitter for failing to remove an account of an individual who was impersonating him. Similar easy success can occur when a third party registrant utilizes a logo or some other proprietary design. A simple email notification will usually result in an offending account being terminated and removed.

Problems have arisen, however, when an offending username is not clearly violating internal terms of service. In this instance, Company A has discovered that its company name has been claimed by a third party on Twitter. The company name is a registered trademark and clearly fits all other necessary criteria for registered marks. A notification is sent, Twitter responds by saying that the username in question does not violate their terms of service, and then offers to contact the third party to see if an agreement can be reached.

All future attempts at communication with Twitter then are either ignored or simply repeat the original response. Company A is then faced with attempting to negotiate with a third party who may or may not respond, filing suit against Twitter, or waiting with the hope that the offending username will go inactive for the requisite time period and Twitter will then cancel the account.

Domain Name Theory as Resolution to Social Media Disputes

The apparent similarity between domain names and user names on social media sites is compelling. Both direct internet users to unique locations on the internet that provide user generated content. For example, www.coca-cola.com, <http://twitter.com/CocaCola>, and <http://www.facebook.com/cocacola> are the internet addresses for the official Coca-Cola website, Twitter page, and Facebook page respectively.

Forget for a moment that Coca-Cola is one of the most recognized brands in the known universe. Ignore also the trademark savvy gaggle of in-house counsel. If a competitor registers the URL [\[www.coca.com\]\(http://www.coca.com\), Coke has available, in addition to more traditional trademark actions, two remedies unique to the internet: suit under the Anti-Cyber Squatting Protection Act \(“ACPA”\) and arbitration under the Uniform Domain Name Dispute Resolution Policy \(“UDRP”\).](http://www.coca-</p></div><div data-bbox=)

All domain name registrants of .com, .net, .biz, and .org gTLDs agree to arbitration under the UDRP. The trademark owner needs to show the arbitrator (or occasionally arbitration panel) three things in order to recover the domain name: (1) the domain name in question is identical or confusingly similar to the owner’s mark; (2) the domain name registrant has no right to or legitimate interest in the contested domain name; and (3) the registrant registered and/or is using the domain name in bad faith. If a trademark owner loses its arbitration, it may still bring a lawsuit under the ACPA.

The ACPA is codified as part of the Lanham Act at 15 U.S.C. § 1125(d). Under the ACPA, the trademark owner needs to prove: (1) the mark is valid; (2) the website owner registered the domain name with bad faith intent to profit from the mark; (3) the mark was distinctive when the domain name was registered; and (4) the domain name is identical or confusingly similar to the mark.

Both the UDRP and the ACPA can be powerful remedies for brand owners faced with domain squatters or brand hijackers. However, it appears unlikely that either remedy is of much use to a trademark owner with a dispute against a social media user.

First, the congressional history of the ACPA indicates a clear intent that the definition of domain name specifically exclude things like usernames and screen names. At this juncture, the “squatting” quandary with social media is based heavily around misappropriation of brands via the creation of fake Facebook or Twitter accounts. Second, and in all likelihood more clearly, the UDRP and ACPA govern disputes over sTLDs registered with a domain name registrar. The unique subdomains on social media

sites are user-created content and are not registered with a domain name registrar. Therefore, it is unlikely that they implicate either the ACPA or the UDRP.

Terms of Service Remedies

As noted above, the simplest and most effective approach for dealing with an infringing mark is to go directly to the terms of service and related policies of social media sites. Twitter has continued to evolve its terms of service as problems such as impersonation and infringement have continued to grow. Attorneys should reference not only a site’s terms of service, but also additional policies and procedures.

For sites like Twitter, this can involve several different and sometimes overlapping policies. In general, these policies will provide instruction for lodging of various kinds of complaints and the information requested to accompany such complaints. However, specific remedies dealing with a variety of situations can be found. These usually include take down of the offending username, consultation with a third party who inadvertently acquired the mark as a username, and transfer of control of the username.

Tiffany v. Ebay – How to Notify

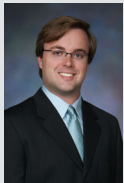
Another point of practice to remember is that the owner of the mark has the duty to notify third party sites that are displaying infringing material. As noted above, the DMCA specifically applies to copyright, but the procedures have been extended in practice to instances involving trademark violations. Social media sites are basically innocent infringers until they possess knowledge of the infringement activity.

In practice this means a mark owner has to notify a social media site when infringement is occurring. While *Tiffany v. Ebay* 576 F.Supp.2d 463 (S.D.N.Y. 2008) involves a number of complicated issues, including definitions of what constitutes “use in commerce,” the decision indicates

that a blanket cease-and-desist letter to Ebay or other sites is insufficient. As is the case with the DMCA, owners of marks have to inform third party websites of particular instances of infringement. This requirement places a heavier burden on mark owners to monitor various sites for infringement.

Best Practices

1. Have a policy and a plan. Organizations need to make a business decision about how third party owners of their trademarks on social media sites should be treated. Will a strict approach requiring the taking of all possible steps to prohibit third party ownership be followed or does the organization want to work with third parties as “brand ambassadors?” A middle approach can also be followed.
2. Preempt with defensive registration. Organizations desiring a stricter control of their marks should seek registration on social media sites of marks as well as possible misspellings and “negative marks,” i.e., disparaging marks. Care should be taken to follow the Terms of Service of social media sites which either prohibit corporate registration or restrict commercial activity on a particular site. Additionally, even though a brand owner may be successful in stopping an infringement by getting a social media site to take down a page, the transfer process, if it exists at all, can be cumbersome. When a brand owner fails to first register its brand on a social media site, it runs the risk of losing the ability to use that particular name or address all together.
3. Remain vigilant. It never hurts to know which names, if any, have been registered by third parties, and where. Websites like www.knowem.com provide an easy way to search large numbers of social media sites quickly. However, part of the organizational policy should include independent monitoring of social media sites of particular interest to your business or organization.
4. Include a provision in an organization’s social media policy. Many businesses are just finalizing formal policies. Clients should be advised to place a provision about not registering the company’s name. All too often employees register the offending usernames, especially in the instances of “negative marks.”
5. Always look to the Terms of Service first. Much of the law involved with these situations is evolving and subject to broad interpretation. It is *much* easier to submit a complaint to a social media site about an offending user name citing the site’s own Terms of Service as opposed to quoting cases and statute.



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