

The Internet and Your Brand: Policy and Enforcement Strategies

2018 Lavender Law IP Law Institute

Brian J. Winterfeldt
Winterfeldt IP Group
Principal

August 2018



Content Overview

1. Elements of Brand Protection on the Internet
2. Overview of ICANN's New Generic Top-Level Domain Program
3. Introduction to the Trademark Clearinghouse and Other Rights Protection Mechanisms
 - Changes to WHOIS Data
4. Social Media Enforcement Strategies

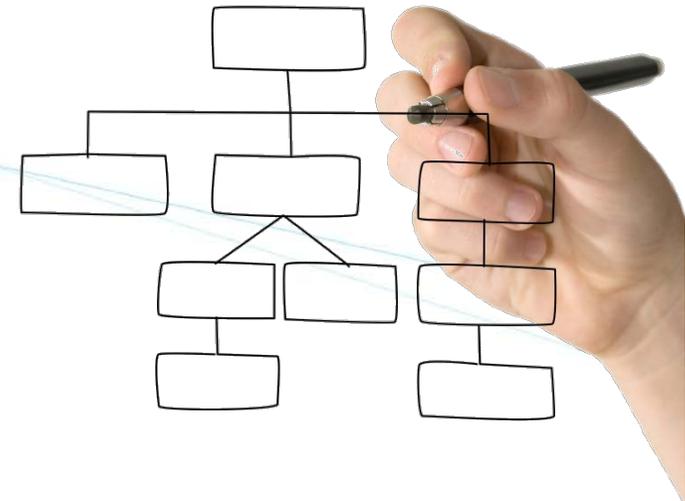




Elements of Brand Protection on the Internet

Brand Protection on the Internet

- Domain Name Strategy
- Social Media Strategy
- Website Content – Use of Branding Elements



Domain Name Strategy Elements

Domain name portfolio management

- Actively used domain names
- Defensive registrations
- Enforcement – acquiring or disabling infringing domain names

New gTLD considerations

- gTLD applications and registry operations
 - Earliest next round in 2021
- Use of the Trademark Clearinghouse
 - 35 / 1,230 new gTLDs not yet delegated
 - 324 new gTLDs not yet formally launched
- Participation in sunrises and early registration programs
- Evolution of overall portfolio management and enforcement strategy



Social Media Strategy Elements

Registration of social media profiles for key brands

Active presence on social media sites

Internal and external social media policies

Development and marketing of applications

Enforcement against infringing social media profiles, content and apps

Gold Standard: 35 Social Media Platforms Worldwide

Less Obvious Platforms: Odnoklassniki; Qzone; Ren Ren; Sina Weibo; Bebo; Lowyat; RuTube; Bilibili; etc.





Overview of ICANN's Generic Top-Level Domain Program

Internet Corporation for Assigned Names and Numbers (ICANN) Basics

A global multi-stakeholder organization that collaborates with companies, individuals, and governments to ensure the continued security, stability, and interoperability of the Internet

Created and empowered in 1998 through actions by the U.S. government and U.S. Department of Commerce to privatize the Internet

- Encourage greater international participation

- Bolster commercial competition

- Consumer Choice

Memorandum of Understanding – Officially recognized ICANN as the entity that would oversee development and implementation of domain name policy and standards for technical operations

On September 30 2016, transitioned historical USG stewardship role to the multi-stakeholder community (the “IANA transition”)



What Does ICANN Do?

Coordinates Internet Functions

- Domain Name System (DNS)

- Internet Protocol (IP) Address Allocation

- Generic Top-Level Domain Name (gTLD) System Management

- Country Code Top-Level Domain Name (ccTLD) Coordination

Security and Stability: Best practice education and new security protocols like DNSSEC

Interoperability: Secure connections between Internet Users

Competition and Consumer Choice:

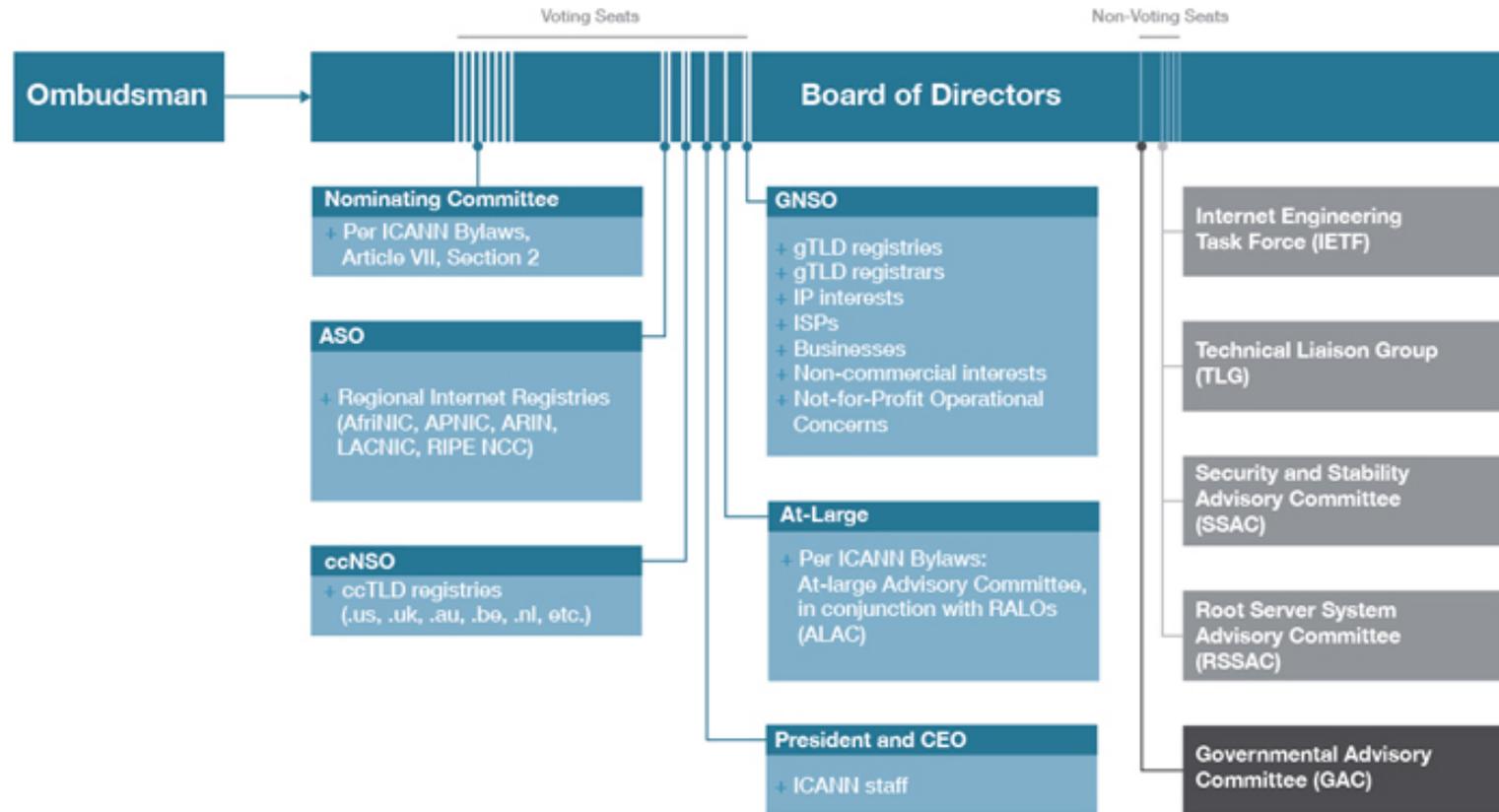
- Accreditation for over 1,000 registrars

- Introduction of new gTLDs; Accreditation of over 1,200 new gTLDs

Ensures an open and transparent policy development process for subjects within its remit



Structure of ICANN

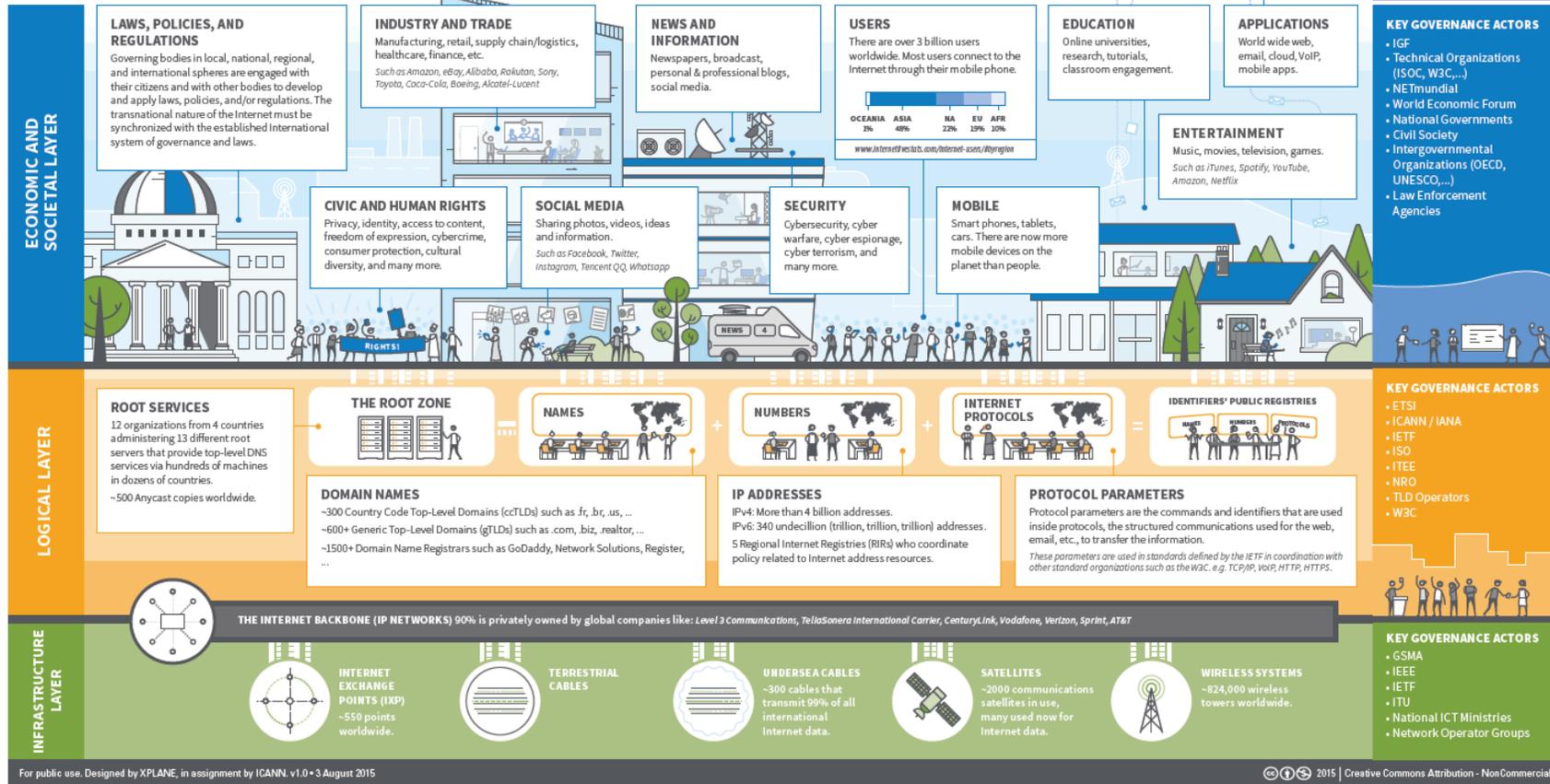


Source: icann.org



THE THREE LAYERS OF DIGITAL GOVERNANCE

No one person, government, organization, or company governs the digital infrastructure, economy, or society. Digital governance is achieved through the collaborations of Multistakeholder experts acting through polycentric communities, institutions, and platforms across national, regional, and global spheres. Digital Governance may be stratified into three layers to address infrastructure, economic, and societal issues with solutions. For a map of Digital Governance Issues and Solutions across all three layers, visit <https://map.netmundial.org>



MULTISTAKEHOLDER COLLABORATIONS
Solutions to issues in each layer include policies, best practices, standards, and specifications developed by the collaborations of expert stakeholders from actors in business, government, academia, technical, and civil society.



WHO RUNS THE INTERNET?

NO ONE PERSON, COMPANY, ORGANIZATION OR GOVERNMENT RUNS THE INTERNET.

The Internet itself is a globally distributed computer network comprised of many voluntarily interconnected autonomous networks. Similarly, its governance is conducted by a decentralized and international multistakeholder network of interconnected autonomous groups drawing from civil society, the private sector, governments, the academic and research communities, and national and international organizations. They work cooperatively from their respective roles to create shared policies and standards that maintain the Internet's global interoperability for the public good.

WHO IS INVOLVED:

IAB **A C P S R**
INTERNET ARCHITECTURE BOARD
Oversees the technical and engineering development of the IETF and IRTF.
www.iab.org

ICANN **C O P V**
INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS
Coordinates the Internet's systems of unique identifiers: IP addresses, protocol parameter registries, top-level domain space (DNS root zone).
www.icann.org

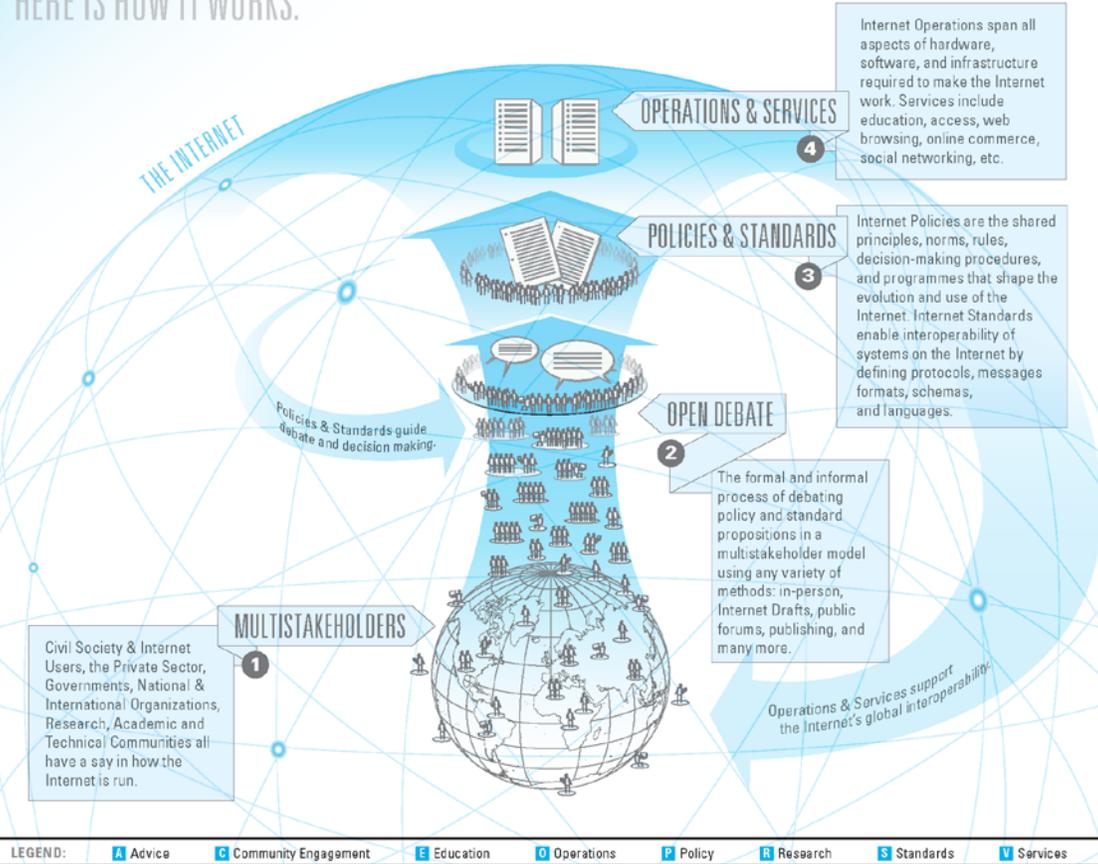
IETF **C P S**
INTERNET ENGINEERING TASK FORCE
Develops and promotes a wide range of Internet standards dealing in particular with standards of the Internet protocol suite. Their technical documents influence the way people design, use, and manage the Internet.
www.ietf.org

IGF **A C P**
INTERNET GOVERNANCE FORUM
A multistakeholder open forum for debate on issues related to Internet governance.
www.intgovforum.org

IRTF **R**
INTERNET RESEARCH TASK FORCE
Promotes research of the evolution of the Internet by creating focused, long-term research groups working on topics related to Internet protocols, applications, architecture and technology.
www.irtf.org

GOVERNMENTS AND INTER-GOVERNMENTAL ORGANIZATIONS **C P**
Develop laws, regulations and policies applicable to the Internet within their jurisdictions; participants in multilateral and multistakeholder regional and international fora on Internet governance.

HERE IS HOW IT WORKS:



WHO IS INVOLVED:

ISO **S**
INTERNATIONAL ORGANIZATION FOR STANDARDIZATION
Develops international standards. The ISO 3166 standard establishes internationally recognized codes for the representation of names of countries, territories or areas of geopolitical interest and their subdivisions. ISO 3166 does not establish the names of countries, only the codes that represent them.
www.iso.org/iso/country_codes.htm

ISOC **C E P V**
INTERNET SOCIETY
Assure the open development, evolution and use of the Internet for the benefit of all people throughout the world. Currently ISOC has over 90 chapters in around 80 countries.
www.internetsociety.org

RIRs **O P V**
5 REGIONAL INTERNET REGISTRIES
Manage the allocation and registration of Internet number resources, such as IP addresses, within geographic regions of the world.
www.afrinic.net Africa
www.apnic.net Asia Pacific
www.arin.net Canada & United States
www.lacnic.net Latin America & Caribbean
www.ripe.net Europe, the Middle East & parts of Central Asia

W3C **S**
WORLD WIDE WEB CONSORTIUM
Create standards for the world wide web that enable an Open Web Platform, for example, by focusing on issues of accessibility, internationalization, and mobile web solutions.
www.w3.org

INTERNET NETWORK OPERATORS' GROUPS **A O V**
Discuss and influence matters related to Internet operations and regulation within informal fora made up of Internet Service Providers (ISPs), Internet Exchange Points (IXPs), and others.



Domain Name Registration Hierarchy

Registry – organization in charge of database of domains ending with a particular top-level domain (including gTLDs such as .com or .net and ccTLDs such as .us or .jp).

Registrar – organization that sells rights to use particular second-level domains (such as inta.org or winterfeldt.law).

Registrant – user who purchases right to use a second-level domain for a designated period of time (e.g., Winterfeldt IP Group PLLC for the winterfeldt.law domain name).



Anatomy of a Domain Name



Overview of the New gTLD Program

“Old” gTLDs vs. “new” gTLDs:

Previously 23 gTLDs in operation (e.g., .com, .net and .org).

ICANN program allowed applicants to create their own (e.g., .fashion or .coupons).

Successful applicants executed a Registry Agreement with ICANN – 10-year commitment to operate the gTLD.

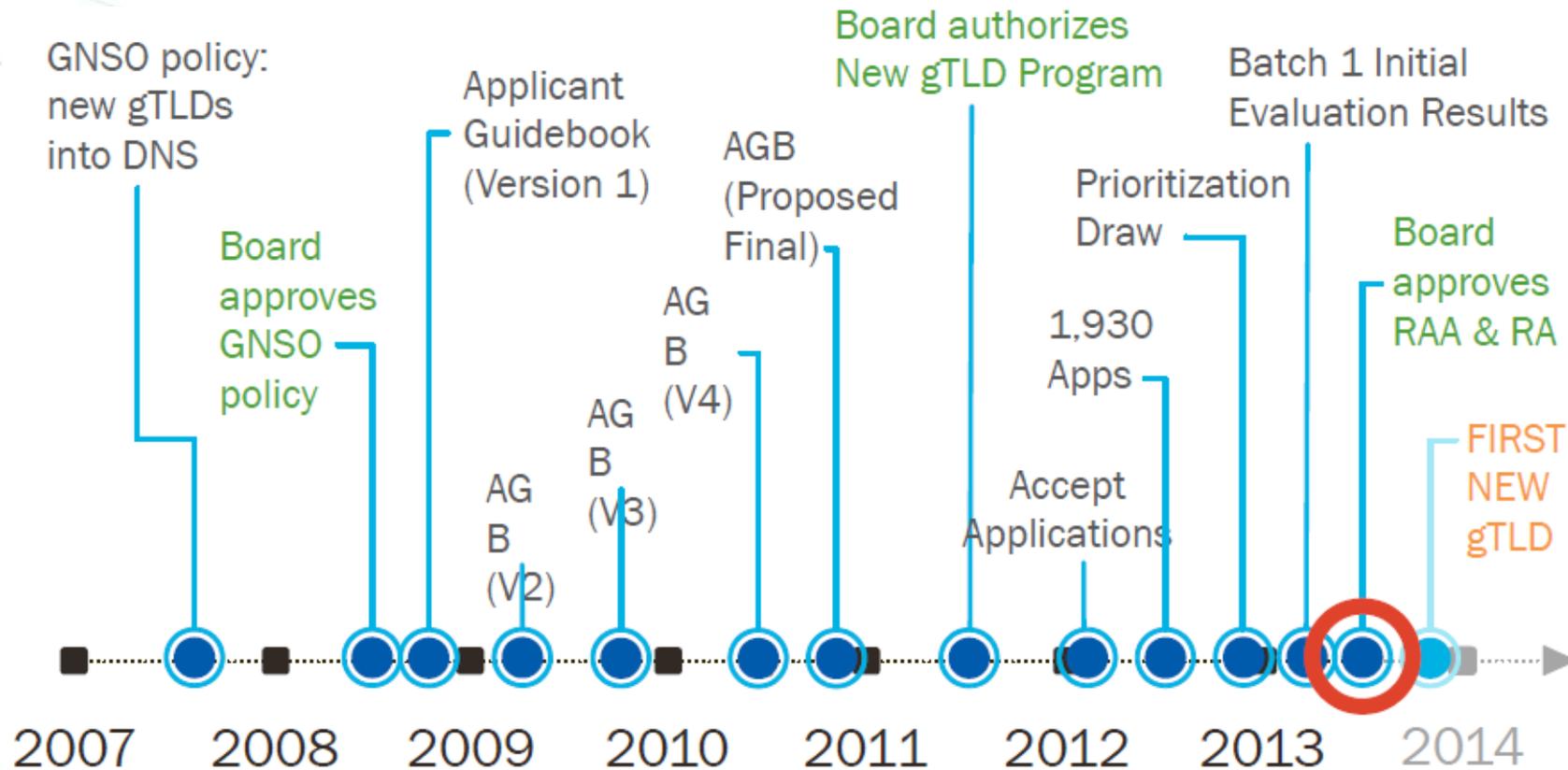
Includes internationalized domain names (IDNs), such as Arabic, Cyrillic and Lao, allowing for special (non-ASCII) characters.

1,930 complete applications submitted; 1,230 total approved; approximately 700 expected to be open to third parties to register second-level domains.

First new gTLDs went live Q4 2013; over 1,200 delegated to date.



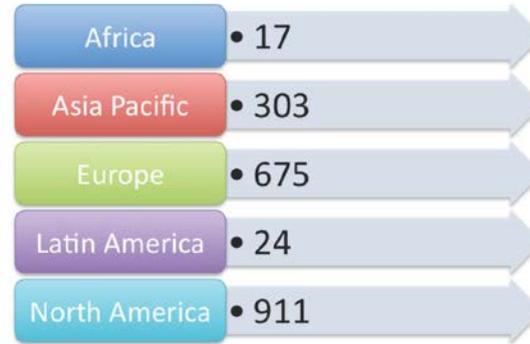
Overview of the New gTLD Program



Source: ICANN



New gTLD Application Process Recap



Applications by ICANN region



Top contested strings

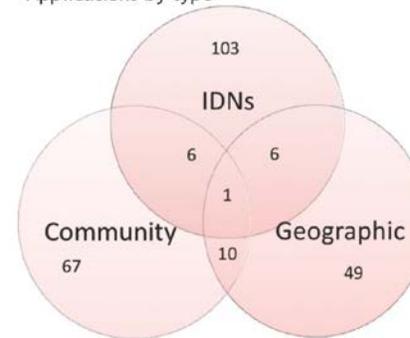
By the Numbers

230
Strings with more than one applicant

751
Applications for contested strings

116
Applications for internationalized domain names

Applications by type



New gTLD Growth

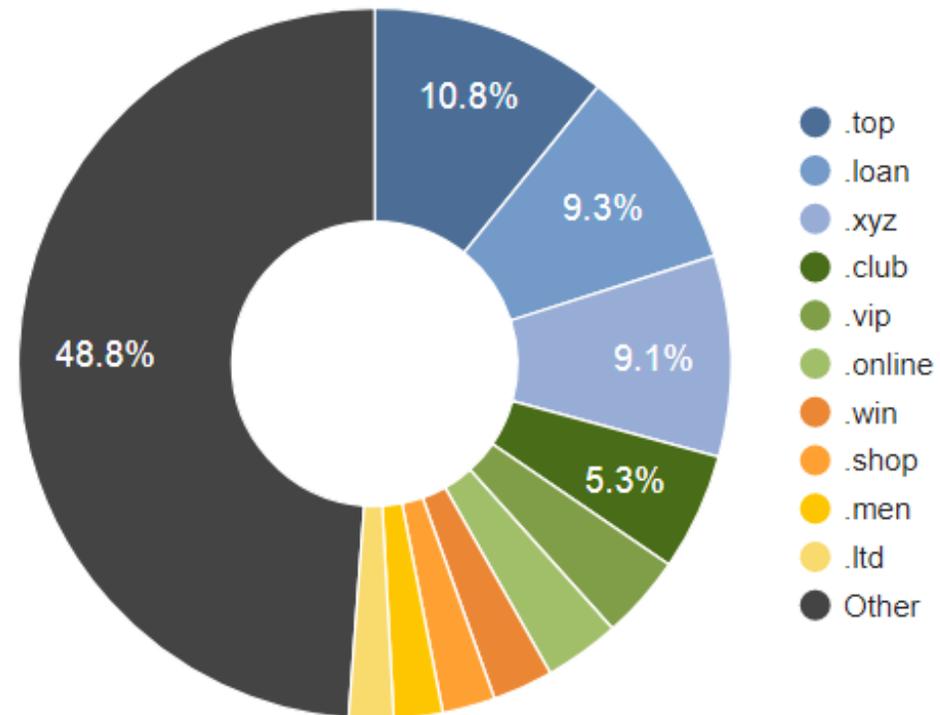
new gTLD Domains



Source: ntlstats.com. Last Accessed: May 14, 2018

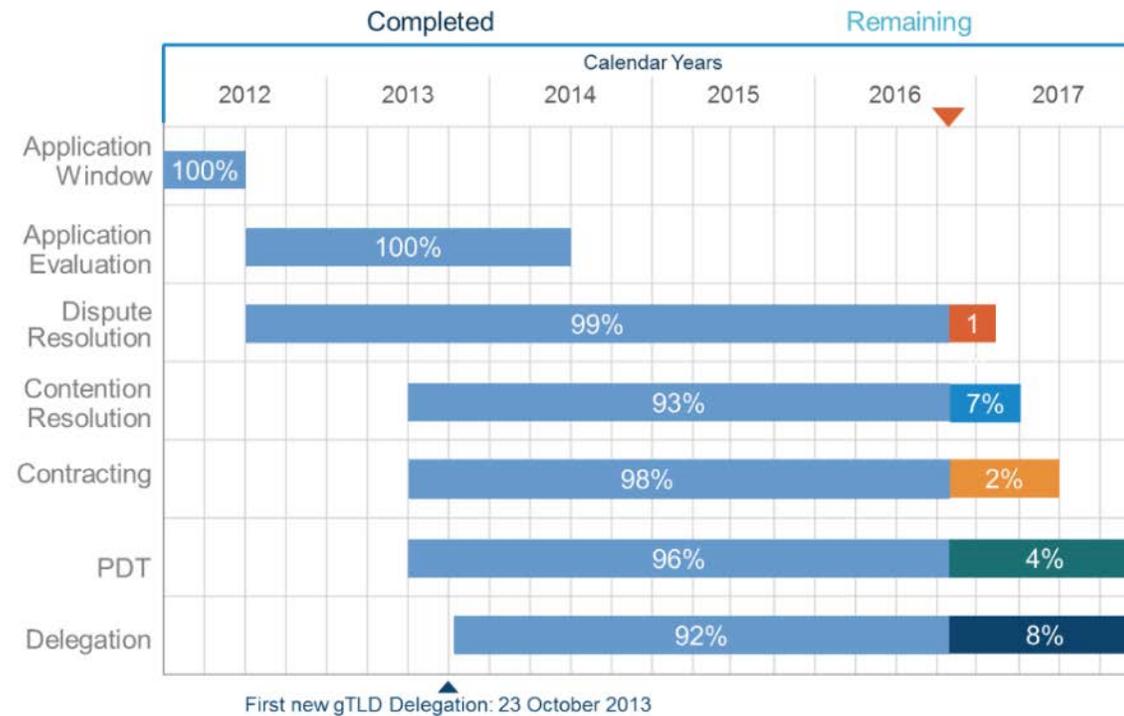
New gTLD Distribution

new gTLD distribution



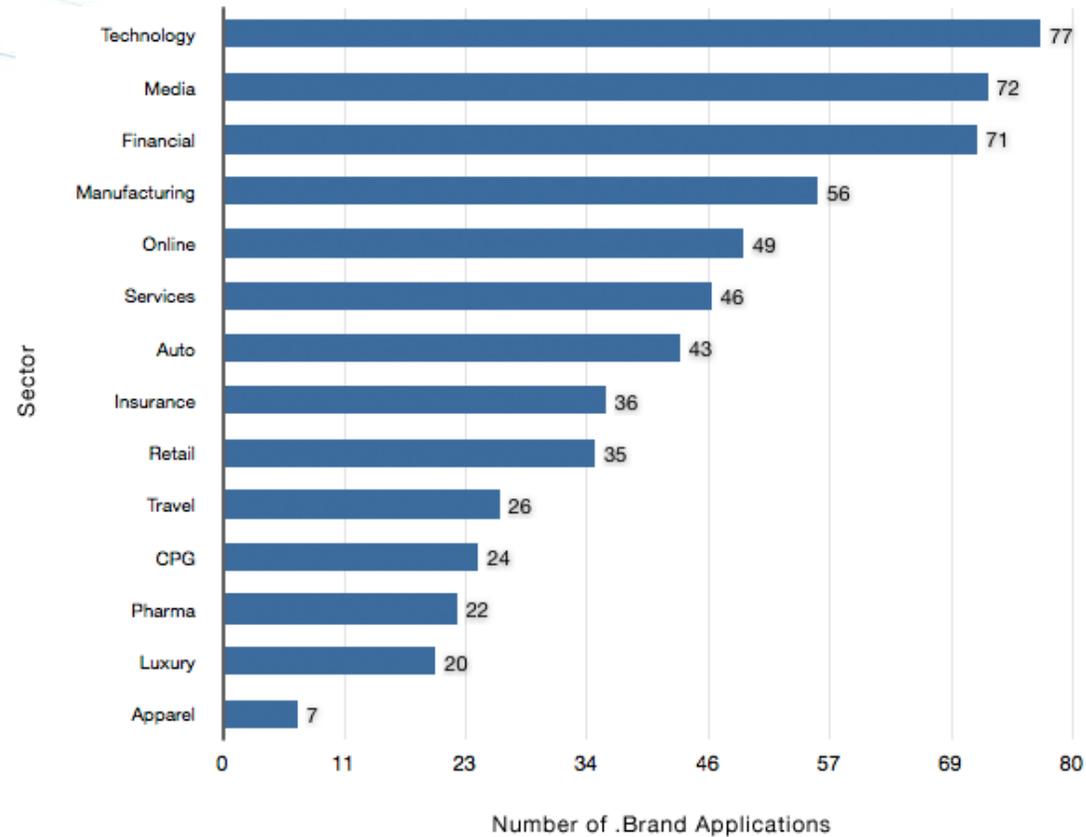
New gTLD Program Timeline

New gTLD Program Timeline



New gTLD Application Process Recap

.BRANDS account for over 30% of new TLDs.



Examples of .BRAND Applications

Johnson & Johnson

.jnj and others

L'ORÉAL®

.loreal and others

Walmart 

.walmart and others



TARGET

.target



macy's

.macys and .bloomingdales

Google

.google and others

AARPSM

.aarp

 **amazon**
web services

.aws and others



.nationwide and .onyourside



Sample .GENERIC Applications

.ads
.auction
.bargains
.beauty
.bid
.blackfriday
.buy
.cards
.clothing
.company
.cool
.coupon(s)
.deal(s)
.direct
.discount

.ecom
.fashion
.forsale
.free
.fun
.gift(s)
.gratis
.guide
.kaufen (shop)
.life
.living
.luxe
.luxury
.moda (fashion)
.new

.pay
.promo
.qpon
.report
.review(s)
.rich
.sale
.save
.shoes
.shop(ping)
.store
.style
.tienda (shop)
.wedding



Sample IDN .GENERIC Applications

.بازار(bazaar)
.كوم(com)
.ストア (store)
.セール (sale)
.企业 (company)
.公司 (business)
.商城 (mall)
.商店 (shop)
.商标 (trademark)

.网店 (web store)
.购物 (shopping)
.通販 (online shopping)
.集团 (conglomerate)
.餐厅 (restaurant)
.珠宝 (jewelry)
.时尚 (fashion)
.ファッション (fashion)



Brand Owner Strategy for New gTLDs

- Will have to reevaluate your existing domain name and brand protection strategy.
- Defensive registrations are like insurance: brand owners pay a little now (cost of defensive registration) to avoid having to pay a lot later (cost of enforcement action).
- But perhaps that insurance equation is changing with the new gTLDs. More gTLDs means more defensive registrations, and if the cost of the insurance exceeds the cost of the thing that you're trying to insure against then it no longer makes sense.



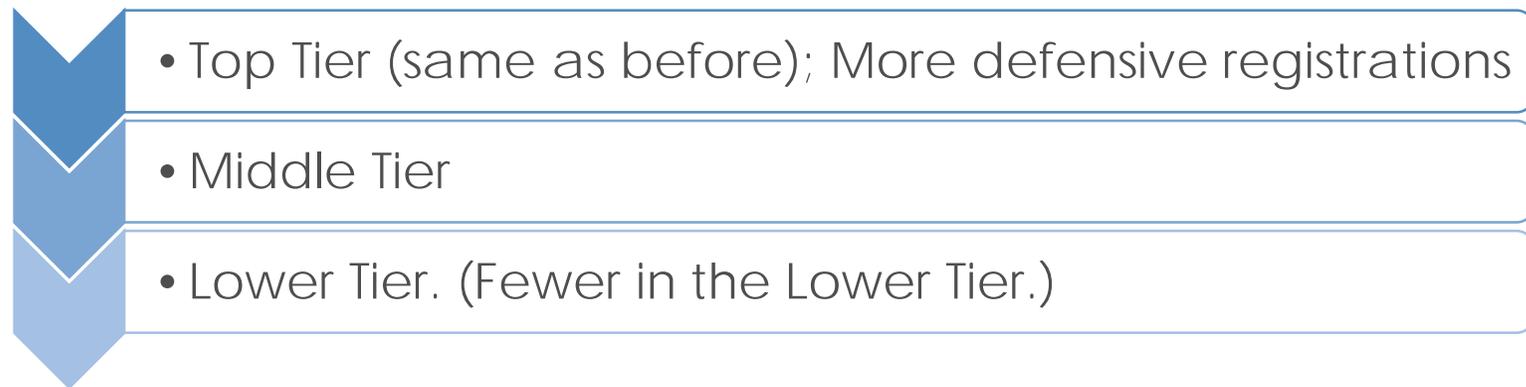
Brand Owner Strategy for New gTLDs

First step: understand and think about your defensive registration costs.

What are you spending now? How many domains are in your portfolio? Any you can live without?

How aggressive should you be with defensive registrations in the new gTLDs?

Again a tiered approach can help:



Brand Owner Strategy for New gTLDs

- Second step: understand and think about your enforcement costs. In the new gTLDs enforcement mechanisms may be more cost-effective than completing and maintaining numerous defensive registrations.
- URS: cheap and quick. Relief is limited, but does that matter?
- Uniform Domain Name Dispute Resolution Policy (UDRP): cost-effective alternative to litigation that allows for recovery of the infringing domain name.
- Litigation (i.e., ACPA actions) also an option for the most egregious incidents of infringement – use judiciously due to cost and time investment.



Brand Owner Strategy for New gTLDs: Conclusion

- Cooperate, educate and communicate with others in your organization to meet your goals – especially as to budget and cost expectations.
- Monitor ICANN developments or partner with an ICANN specialist to assist with education training and strategic planning.
- Develop or adapt online enforcement program to account for new gTLDs.
- Coordinate with industry peers.
- Evaluate successes and failures openly.
- Continuously reassess and adapt. There is much we don't yet know. Stay flexible.





Introduction to the Trademark Clearinghouse (TMCH)

Trademark Clearinghouse

- Purpose – central repository for information to be authenticated, stored, and disseminated pertaining to rights of trademark holders.
- Entry makes marks eligible for Trademark Claims and Sunrise services – both mandatory for all new gTLD registries. Entry also facilitates proof of use for URS complaints.
- Operates separately from ICANN – Deloitte performs authentication functions and IBM performs technical database functions.
- Costs borne by registries (portion of the new gTLD application fee) and trademark owners (filing fee generally about \$150 per mark per year, plus service provider submission fees).



Trademark Clearinghouse Basics

Standards for inclusion:

- Nationally or regionally registered text marks from all jurisdictions.
- Any text mark validated through court of law or other judicial proceeding.
- Text marks protected by statute or treaty currently in effect or in effect on or before June 26, 2008.
- Does not include any common law rights other than the above.
- Proof of use required for participation in Sunrise services.



TM



Trademark Clearinghouse Basics

Example:

DealSafe – OHIM		DealSafe – US	
Trade mark name :	DealSafe		
Trade mark No :	005744313		
Trade mark basis:	CTM		
Date of receipt :	26/02/2007		
Number of results:	18 of 49		
Trademark		Word Mark	DEALSAFE
Filing date:	26/02/2007	Translations	The wording "DEALSAFE" has no meaning in a foreign language.
Date of registration:	19/02/2008	Goods and Services	IC 035. US 100 101 102. G & S: Economic forecasting and consulting services.
Expiry Date:	26/02/2017		IC 036. US 100 101 102. G & S: Financial risk management consulting services.
Nice Classification:	35, 36 (► Nice classification)	Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM.
Trade mark:	Individual	Trademark Search Facility Classification Code	SHAPES-COLORS-1 Design listing or lined for a single color.
Type of mark:	Figurative	Serial Number	79040502
Vienna Classification:	27.5.1, 29.1.4 (► Vienna Classification)	Filing Date	May 25, 2007
Graphic representation		Current Basis	66A
		Original Filing Basis	66A
		Published for Opposition	June 24, 2008
		Registration Number	3499292
		International Registration Number	0929413
		Registration Date	September 9, 2008
		Owner	(REGISTRANT) DELOITTE FINANCE Société par actions simplifiée

Based on the above trademark, the recorded name of the mark is DealSafe. In no event would the Clearinghouse accept "DEAL", "SAFE" or "SafeDeal" based on the reported name of the trademark.



Sunrise Service

- All new gTLDs must provide a Sunrise period, i.e. a priority opportunity for owners of marks recorded in the TMCH to register these marks as second-level domain names in new gTLDs before the TLD is made available to the general public for registration.
- Dates and requirements published 30 days pre-Sunrise period.
- Offered for a minimum 30-day period; some applicants voluntarily extending the Sunrise period.
- Wholesale and retail fees for registering domain names set by registries and registrars respectively – ICANN will not regulate prices.
- Trademark owners should be judicious in determining in which sunrises to participate – choose gTLDs most important to the brand and business.
- System became functional on August 16, 2013.



Trademark Claims Service

Like Sunrise, all new gTLDs must provide Trademark Claims Service.

Trademark Claims Service is really comprised of two services, both of which apply only to “identical matches” – no plurals, variants, contained-in, etc., apart from “Previously Abused Labels” documented by prior UDRP, URS or court determinations:

- Trademark Claims Notice

- Notice of Registered Name

Trademark Claims Notice:

Provides a warning notice of potential trademark infringement to potential second-level domain name registrants seeking to register a domain name that matches a mark recorded in the Trademark Clearinghouse.

Notice of Registered Name:

Provides notice to trademark owner in the event a second-level domain name is registered that exactly matches the trademark owner’s Clearinghouse-recorded mark

Trademark Claims Service must be provided for a minimum of 90 days after the completion of the Sunrise period



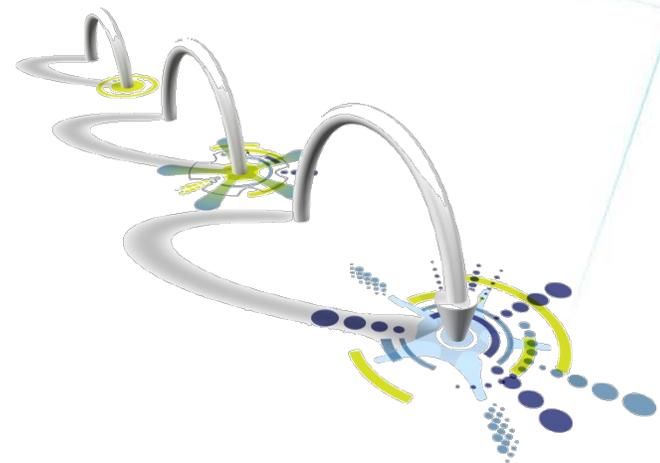
Trademark Claims Service

- The Trademark Clearinghouse offers a free Extended Claims Service wherein it will provide Notice of Registered Name service to brand owners whose marks have been recorded in the Clearinghouse indefinitely, even after the end of the minimum 90 day Trademark Claims Service period.
 - Brand owners must opt-in for the service.
- The Trademark Claims Service system became functional on September 11, 2013.
- According to Deloitte, 95% of queries for TM terms resulting in Claims Notices do not result in a live registration. This represents either a significant deterrent effect for prospective innocent infringers, or automated queries intended to farm data in the Trademark Clearinghouse.



Thinking About Trademark Clearinghouse Strategy

- TMCH is a valuable tool, but to enter every mark in your portfolio may be cost prohibitive.
- One potential strategy: select “Crown Jewels” – marks you’ll want to defensively register during Sunrise.
- Determine which marks are your Crown Jewels and get them into the TMCH for protection in subsequent new gTLD launches.
- Data in the TMCH (the strategic selection of your Crown Jewels) is currently held in confidence, but that could change in future new gTLD rounds.



Thinking About Trademark Clearinghouse Strategy

Next, identify "Top Tier" gTLDs most relevant to your business model. Some examples for the fashion and retail industries:

- .ads
- .auction
- .bargains
- .beauty
- .bid
- .blackfriday
- .buy
- .cards
- .clothing
- .company
- .cool
- .coupon(s)
- .deal(s)
- .direct
- .discount
- .ecom
- .fashion
- .forsale
- .free
- .fun
- .gift(s)
- .gratis
- .guide
- .kaufen
(shop in German)
- .life
- .living
- .luxe
- .luxury
- .moda (fashion in Italian & Spanish)
- .new
- .pay
- .promo
- .qpon
- .report
- .review(s)
- .rich
- .sale
- .save
- .shoes
- .shop(ping)
- .store
- .style
- .tienda
(shop in Spanish)
- .wedding



Thinking About Trademark Clearinghouse Strategy

- Track your Top Tier applications. Some may be in contention sets; different applicants may have different plans.
- Decide which additional trademarks to add to your Crown Jewels in the TMCH based on how your Top Tier gTLDs shake out.
- One potential downside of the Crown Jewels approach: Requires diligence. The new gTLDs have not been delegated or launched in the order of their Prioritization Numbers!



Trademark Clearinghouse Fees

TMCH Registration (including up to 10 domain labels)

1, 3 or 5 years at \$150, \$435 or \$725 per registration

Previously Abused Labels (up to 50, claims service only)

\$1 per label per year

Verification fee per case: \$50–75 (UDRP) \$150–200 (Court)



Trademark Clearinghouse Changes on the Horizon

ICANN is currently working to review all RPMs, and proposals are on the table to change the TMCH:

- Severe limitation of the marks eligible for entry, limited solely to standard character marks;

- Elimination of the option to add in "Previously Abused Labels" for claims notices;

- Expand matching rules to include plurals, "marks contained," or "mark+keyword" and common typographical errors.



Other Rights Protection Mechanisms

- In addition to the Trademark Clearinghouse and supported services (Sunrise and Trademark Claims), a host of other RPMs are available to combat infringement:
 - Uniform Rapid Suspension (URS)
 - Uniform Domain Name Dispute Resolution Policy (UDRP)
 - National anti-cybersquatting or unfair competition or trademark infringement legislation (e.g. US Anti-Cybersquatting Consumer Protection Act)
- Each of these has pros and cons, depending on the circumstances and remedial needs.



Uniform Rapid Suspension

- Designed as a lower-cost, faster alternative path to relief to complement the UDRP.
- For use to combat the most clear-cut cases of infringement.
- Fees to file are around \$375 for a single domain name.
- Can be decided in 14-day span, although lengthy *de novo* review and appeals processes even in event of default by respondent (potentially a year or more).
- Relief limited to suspension of the domain for remainder of registration period, plus one additional year.



Uniform Rapid Suspension Changes on the Horizon

ICANN is currently working to review all RPMs, and proposals are on the table to change the URS:

- Remove de novo review period for defaulting respondents;
- Heighten consequences for “repeat offenders”;
- Provide additional remedies, like transfer or a right of first refusal to register expired domain names;
- Reduce 15 name threshold for response fees;



Uniform Domain Name Dispute Resolution Policy

- In use for many years to protect brand owners from cybersquatting and infringement in legacy TLDs. Also applies to all new gTLDs, and has been integrated in principal into many ccTLDs.
- Lower standard of proof than URS -- "preponderance of evidence."
- Fees to file are around \$1,300 - \$1,500 for a single domain name.
- Generally decided within 30-60 day span, appeals must be made to courts of competent jurisdiction.
- Relief available includes cancellation of domain name, or transfer to complainant.



UDRP Changes on the Horizon

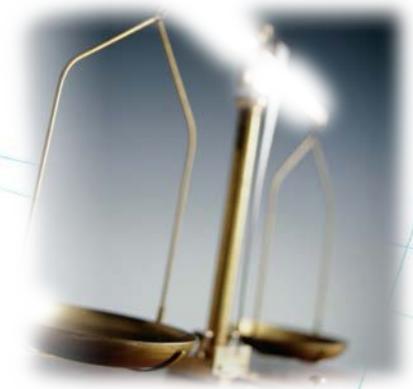
ICANN is currently working to review all RPMs, and proposals are on the table to change the UDRP:

- Superfluous additional appeal mechanisms;
- Inappropriate statute of limitations for filing complaints;
- Bulky mandatory mediation mechanism;
- Micro-management of Panel appointment standards through ICANN policy;
- Inappropriate recognition of laches in UDRP cases;



Anti-Cybersquatting Consumer Protection Act (ACPA)

- U.S. law integrated into Lanham Act that provides avenue of relief in U.S. federal court for cybersquatting.
- Can proceed *in rem* against foreign-registered domain names, so long as U.S.-based domain registration authority involved, such as Versign for the ubiquitous .COM TLD.
- Similar standard of proof to UDRP (preponderance of the evidence).
- Cost similar to general civil litigation in U.S. Federal District Court.
- Relief similar to UDRP – cancellation or transfer. However, damages are available depending upon personal jurisdiction over bad faith registrants.



URS / UDRP / ACPA Elements

URS	UDRP	ACPA
Domain name is identical or confusingly similar to mark in which complainant has rights pursuant to (i) national/regional registration, (ii) court-validation of mark, or (iii) statute/treaty;	Domain name is identical or confusingly similar to mark in which the complainant has demonstrated rights;	Defendant has a bad faith intent to profit from a protected mark; and
Registrant has no legitimate right or interest to domain name; and	Registrant has no legitimate right or interest to domain name; and	Defendant registers, traffics in, or uses a domain name that is identical or confusingly similar to that mark, or is dilutive of the mark if the mark is famous at the time of registration.
Domain name registered and being used in bad faith.	Domain name has been registered and used in bad faith.	Bad faith intent shall not be found in any case in which the defendant reasonably believed that the use of the domain name was a fair use or otherwise lawful.



Domain Name Registration Data (WHOIS)

- Due to the European Union General Data Protection Regulation (GDPR), the WHOIS system is already changing...
- Much of the data that used to be public will no longer remain readily accessible;
- Only public domain name registration details will likely be:
 - Registrant Organization (if any)
 - Registrant State / Province and Country
 - Registrar
 - Creation / Expiry Dates
 - Name Servers



Domain Name Registration Data (WHOIS)

- These changes will significantly hamper IPR enforcement efforts
- Brand owners must advocate within ICANN to preserve more public WHOIS data (including critical registrant email address)
- Unfortunately, access to non-public data will become entirely ad hoc after the May 25 effective date for penalties under GDPR, until a uniform accreditation system can be implemented (potentially a year from now, or more)



WHOIS Changes Impact on Online Enforcement Strategies

In light of these WHOIS changes, IPR owners will need to adapt their enforcement strategies, including:

- Establish whitelist access to non-public data with top registrars;
- Shift enforcement to web host notice and takedown demands based on readily available IP addresses;
- Channel enforcement through registrar and registry abuse points of contact;
- Revisit and reinforce theories secondary liability against recalcitrant domain name registration authorities;
- File John Doe lawsuits to subpoena registrant contact information from domain name registration authorities;
- Contact registrants through anonymized email addresses or web forms provided by some proxy services;
- File bulk URS and UDRP complaints for vast quantities of problematic domain names to reveal the underlying registration data for each one.





Social Media Basics and Enforcement Strategies

Social Media Explained

SOCIAL MEDIA EXPLAINED With Coffee

- I Like Coffee
- I am drinking #Coffee
- I am good at drinking Coffee
- Watch me as I drink coffee.
- I am 13 and I drink coffee when I'm not taking pictures of myself.
- Here is a collection of pictures and recipies of coffee drinks.
- What is the difference between a Latte and a Macchiato?
- Let's Get together (in person) and drink coffee together.
- Here are a bunch of popular articles about coffee.
- I am a Google employee who drinks coffee.
- Here is where I drink coffee. I come here alot, I am the Mayor.
- Here is a vintage picture of me drinking coffee. *(more than likely also making the "duck" face)*

© 2012 Marketplace Maven
Facebook.com/MarketplaceMaven | www.MarketplaceMaven.com
Credits: This is based on the White Board Picture with the Donut analogy. I do not know who created that originally!



Social Media Strategy

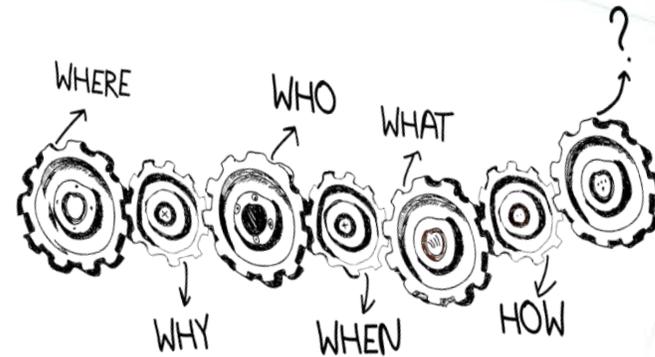
Who uses social media?

- Users are decision-making consumers with strong purchasing power—78% of Internet users with \$75k+ annual household income use social networking sites
- Almost 80% of Internet users between the ages 30 and 49 use Facebook; 16% of Facebook users earn \$100k+ annually
- YouTube overall reaches more 18-34 and 18-49 year olds than any cable network in the US.
- Each global Internet user spends an average of over 106 minutes per day on social media activities
- Over 2.7 billion social media users globally as of January 2017
- Almost 80% of the time spent on social media platforms happens on mobile devices.



How and Why Should Brand Owners Use Social Media?

- Social media usage can serve as evidence of secondary meaning to support trademark rights
- Social media can also provide positive buzz and press for a company looking to [rebuild its reputation](#), restoring and increasing the value of the brand and its trademarks
- Official social media channels can also steer consumers away from unauthorized third-party resources
- Active social media participation can provide an effective and inexpensive means of addressing complaints and misconceptions about products



Selecting Social Media Platforms

The most popular social media platforms today each appeal to different consumers in different ways, offer different functionality and present different legal problems.



Profile Content

A proper account page should include:

- Use of “TM” or ® notice with the branding to reinforce trademark rights

- Copyright notice to better protect content (e.g. © 2017 Mayer Brown)

- Notices and disclaimers relevant to your industry



Understand Individual Platform Usage Policies

Links to Relevant Policies:

<https://twitter.com/tos>

<https://www.facebook.com/legal/terms>

<http://www.youtube.com/t/terms>

<https://business.pinterest.com/en/business-terms-service>

http://www.tumblr.com/policy/en/terms_of_service

<https://www.snap.com/en-US/terms/>



Social Media – Best Practices for Use

- Establish clear guidelines and use policies at the outset about when and to whom administrative control of the account is granted
- Avoid pitfalls that can bring negative publicity, such as overbroad enforcement, including targeting fan sites or preventing fair use
- Observe any applicable regulatory requirements
- Understand key social media platforms in each market and their specific terms of use—these may vary by country and region
- “Verify” accounts whenever possible to protect credibility, reputation and accountability
- Have fun! – give your brand a personality



Social Media – Best Practices for Use

- Develop and distribute brand usage guidelines to employees and external personnel
- Ensure that content created by employees for company social media profiles is explicitly created as work for hire under a written agreement, either in an employee handbook or elsewhere (See Eagle v. Morgan, 2013 WL 943350 (E.D. Pa. March 12, 2013))
- Confirm employee understanding regarding who is and is not authorized to post on behalf of the company and what content is prohibited
- Establish clear protocols for approval for the use of third party trademarks and fair use assessments.
- Establish clear guidelines about when and how to escalate matters for legal review, for approval, or for clearance
- Ensure social media postings reflect proper use of trademarks and brands, where permitted, and provide training to appropriate personnel



Social Media – Best Practices for Use

- There are many unique IP related legal risks associated with using social media
- In order to manage risk, brand owners should:
 - Maintain and enforce IP rights across social media platforms: Gold Standard 35 global social media platforms.
 - Adhere to terms of use and advertising policies established by social media platforms
 - Comply with all applicable advertising, promotional, and sweepstakes laws. See e.g. UL LLC v. Space Chariot Inc., 2017 WL 1423706 (C.D. Cal. Apr. 20, 2017).
 - Ultimate strategic goal is to **strike the right balance** between creating a presence, evoking consumer engagement, protecting intellectual property, and avoiding exposure to liability



Additional Considerations: International Regulations

- Online and mobile social media usage can often trigger additional compliance requirements by brand owners
- Brand owners should remain aware of compliance requirements for international regulations, notably privacy protections in the European Union
 - Privacy laws in the EU are more stringent and far reaching than the limited and specialized privacy statutes in place in the US
 - The implementation of the EU's [General Data Protection Regulation](#) will further expand the reach of the EU's privacy protections to US citizens and internationally, in many instances



Additional Considerations: Public Relations Risks

- Brand owners should be aware of potential public backlash to robust enforcement, whether or not that backlash is warranted, and have a plan to address it
- Brand owners must recognize a difference—and strike a balance—between exercising their exclusive rights and participating in a public-domain discourse
- Efforts to assert exclusive rights in “viral” phenomena have often been characterized as misappropriation by the relevant target consumers, such as:
 - [REACT](#) for reaction videos
 - [CREEPYPASTA](#) for short, iterative horror stories
 - [LET’S PLAY](#) for streaming video game playthroughs
 - Exception: [GRUMPY CAT](#)
- Beware of the [Streisand effect](#)!



Enforcement on Platforms and Social Media

- Private services, including social media platforms and marketplaces like Amazon.com, enforce their own policies regarding trademarks and other intellectual property rights.
- Design marks can also embody original works of authorship that are entitled to copyright protection under the notice and takedown provisions of the Digital Millennium Copyright Act (DMCA)
- Most platforms have similar notice and takedown measure for trademark infringement, although these are less uniform
- In the event that platforms refuse to cooperate in trademark or other enforcement, they may be secondarily liable for users' infringement, allowing for federal claims against most US-based online services.



Expanding Definitions: The New Social Media

- The lines between social media and all media are increasingly becoming blurred
- Specifically, the definition of social media has expanded to include video gaming
- With the development of virtual reality, brand owners are likely to see their IP infringed within augmented and simulated reality spaces
- Brand owners should be mindful of how their brands are being incorporated into these growing artificial digital worlds





Q & A

Thank You

Brian Winterfeldt

Principal

brian@winterfeldt.law

(202) 759-5833

For more information please visit us at www.winterfeldt.law



WINTERFELDT
IP GROUP