

Protecting your brand in the Web 2.0 environment

Global trademark practitioners offer practical guidance on the creation and execution of a resilient social media strategy

The Web 2.0 environment allows users to interact and collaborate with each other, creating content themselves rather than merely acting as passive observers. Whether through social networking sites, blogs, wikis or mash-ups, consumers have now become active participants in the generation of online content, creating an increasingly complex relationship between brands and their customers. For trademark counsel, this has made the resulting trademark, legal and brand reputation challenges posed in this environment more complicated – with the explosion of generic top-level domains (gTLDs) set to multiply the space to be policed. Given the ever-changing nature of the challenge, the need for regular, clear strategic advice has never been greater.

Reflecting this, *World Trademark Review* sat down with a number of different specialists – Malia Horine from Corporation Service Company; Marina A Lewis and Julia Anne Matheson from Finnegan, Henderson, Farabow, Garrett & Dunner in the United States; Pooja Dodd and Omesh Puri from LexOrbis in India; Oliver Löffel and Sascha Abrar from Germany's Löffel Abrar; and Matt Sammon from Marks & Clerk in the United Kingdom – to discuss practical strategies for social media engagement, protection and enforcement.

In terms of the Web 2.0 environment – which encompasses social media networks, blogs, wikis and mash-ups – what do you feel currently presents the greatest trademark challenges and is a separate policing policy required for each?

Matt Sammon (MS): Each presents its own challenges. However, the complexities of social media platforms make it particularly difficult for rights holders to complain about trademark issues relating to them. Often matters of concern arise across more than one platform, making it necessary to think through an approach that deals with the problems in their entirety. This

often means that separate policing policies are advisable. Tools do exist to help you to police your trademarks across multiple platforms, but you need to think hard about which are likely to best serve your needs. For example, if you see a competitor denigrating a brand, you would likely take an aggressive approach seeking immediate action to prevent further damage, an undertaking that it will not happen again and possibly some form of recompense.

On the other hand, if an employee is posting inaccurate information about your company online, you would want to deal with it on a one-on-one basis in line with internal policies. The ultimate key is to identify the individuals or entities behind the offending activity. Unfortunately, this is often the greatest challenge of all.

Pooja Dodd (PD): This is very true. Since it is the virtual world we are referring to, the source of misuse can be from anywhere in the world. Usually, it is impossible to determine the actual source behind the misuse on any social media. Therefore, rights holders must watch and monitor activities in the Web 2.0 environment to restrict others from infringing their intellectual property. Separate policing policies may not be required if a uniform, comprehensive policy is drawn up and adopted for all social media networks. But this is a big job. While the Web 2.0 environment undoubtedly presents extraordinary business openings for corporate relationships, customer services, advertising and brand building, the use of trademarks on social media has become something which rights holders must pay attention to. Current challenges include wrongful affiliation and sponsorship, detrimental information about the goods, dilution of the brand with inferior goods and sale of counterfeit products through the Web 2.0 environment – the whole range of issues.

Oliver Löffel (OL): It is always important, though, to ensure that the response to infringement is proportionate. A hard

response towards a small-scale enterprise can create a backlash – a chorus of outrage on social media – and may cause more damage than the original infringement. In Germany, for example, Jack Wolfskin ultimately had to give in after a backlash triggered by cease and desist letters sent to retailers selling handmade products through the online marketplace DaWanda.de. By contrast, a friendly letter can be as effective as a cease and desist letter in individual cases and can ultimately be a better approach.

A related challenge is how to react to such backlashes. This is currently a major topic in Germany. Companies must respond to such threats quickly and via suitable communications, to protect their trademarks. A good example is Vapiano, which successfully fought a chorus of outrage in Germany after a video was published on Facebook showing a caterpillar in the dressing of a customer's salad, using a humorous crisis PR strategy. Ultimately, companies require good lawyers with tact and sensitivity who can respond to individual cases quickly and effectively – if required, they must be able to work closely with PR experts.

Marina A Lewis (ML): For me, the biggest challenges presented by social media are threefold. The first is figuring out how to stretch legal resources most effectively in a constantly evolving world of potential infringement. The second is navigating this new terrain with a minimum of damage to customer relationships. The third is ensuring a relentlessly positive message for your brand. Social media websites are, by nature, dependent on the active participation of their users. Rather than passively viewing a website with its site-generated content, Web 2.0 users themselves provide the content. Given this dynamic, rights holders would be wise to develop a protocol for prioritising infringement cases in the digital space, simply because the sheer volume of potentially infringing activities is so high. For instance, a company might decide not to pursue passive pay-per-click websites and instead to conserve its efforts and resources for more serious cases, such

as counterfeit sites. The active involvement by internet users in generating content also means it is crucial that brand owners strike the delicate balance between enforcing their rights and preserving their relationships with customers. The volume and speed of the ever-changing user landscape also mean that old tools for combating infringement often do not work or are ineffective.

Malia Horine (MH): One of the greatest issues that rights holders are experiencing right now is when third parties use and misuse their trademarks in social media user names. If a rights holder needs to register a user name that is already in use or registered by a third party, it can be very difficult to get it back and there is no governing body to assist with enforcing brand rights. Rights holders can either go through each social media site's terms of service and use its mechanisms for recovery and proving rights, or contact the owner directly. However, many corporations that we work with have run into issues obtaining their user name of choice. This in turn can affect their branding strategy and sometimes their reputation, and it can be a difficult and labour-intensive process to recover user names. Second, even if a rights holder does not expect to use a particular social media channel or user name, problems can occur if someone is infringing their rights with a specific user name. I would advise companies to create a social media policy – much as they would a domain name or trademark policy – to help with consistent registration practices, including proper authorisation and access controls.

As a first step, then, what are the fundamental elements to include in an internal social media policy and how should this be communicated to staff?

MS: It is certainly important to have clear guidelines on how a brand should be represented, whether on a personal or a company social media account. Personal accounts must be clearly identified as such to avoid confusion over whether opinions or advice are given in a professional capacity or a personal one. The ramifications and procedure for abuse of this policy need to be clear. However, any policy should be flexible enough to evolve along with the nature of social media.

Communicating this policy to employees is key. It is far better to avoid problems before they occur and to ensure



Malia Horine
Global director of monitoring and enforcement services,
Corporation Service Company
Malia.Horine@cscglobal.com

Malia Horine has spent the last decade partnering with Global 2000 companies and law firm clients to develop and maintain strong business practices for the management of their intellectual property in the online environment. She is also responsible for developing new tools to help clients promote and protect their brands online as the market changes and the challenge of brand protection grows. Ms Horine has prior experience working in both law firm and corporate environments, particularly in brand protection.

that employees are clear on what is expected of them as far as social media is concerned. Any policy needs to be addressed before employment contracts are signed, but it should also be communicated regularly following initial employment to remind employees of their responsibilities.

Julia Anne Matheson (JAM): The goal is to create an accessible company-wide policy through which employees can judge their activity online and understand the basic rules of engagement. Key components include the need to:

- cover employees top to bottom;
- cover professional and public use of social media;
- cover web name registration;
- cover writing social media content on the company's behalf;
- cover authorship of content unrelated to the company, but showing company affiliation; and
- clarify who specifically has the authority to write content on the company's behalf.

The policy needs to remind employees about information that should never be discussed outside work, including sales data and plans, company financial results, product launch information, engineering and technology roadmaps, customer or partner information and other things considered confidential. The best approach is to make the policy part of the employee handbook/written code of conduct.

MH: With regard to personal behaviour, it is important to remind employees to exercise caution when mixing personal life and business, and to take responsibility for their own actions, particularly when talking about their employers. They should be mindful of the company code of conduct and be aware of brand integrity issues, reporting any problems when they encounter them. And, of course, they need to own their own opinions. When employees are interacting on behalf of the company, they must first acknowledge this. Then, it is important that they follow correct trademark and copyright practices and stick to any social media communications and record management policies. Finally, they need to follow relevant regulatory practices – for example, determining the lockdown status of individual sites and whether comments are allowed.

PD: Ultimately, the policy must be clear and consistent. Specifically, each employee:

- should be personally responsible for the content that he or she publishes online and understand the site's terms of use before publishing;
- must ensure that he or she publishes a disclaimer stating that he or she is speaking for himself or herself and not on behalf of the company, and that the views stated do not necessarily represent the company's position or opinions on the subject;
- must ensure that the company's trademarks are not used in any posts unless specific permission has been obtained;
- must ensure that he or she respects IP laws and does not infringe, inadvertently or otherwise, the intellectual property of the company or that of third parties;
- should respect privacy, fair use and other applicable laws while posting online;
- must respect the sensitive nature of confidential information in his or her possession and take all steps not to divulge it; and

- must ensure that he or she is politically correct in all posts made online and does not hurt the sentiments of any particular community.

Sascha Abrar (SA): Each employee should be informed as to how he or she should deal with social media correctly from the viewpoint of the company. For this purpose, employees should be told to point out in personal profiles that any statements are private and do not relate to the company. Moreover, employees should be asked to ensure that any opinions expressed within the scope of their personal or professional profiles do not damage the company.

A social media policy must define, among other things, who is in charge of corporate communications on social media (eg, Twitter) and, crucially, how other employees can reach these people quickly. Moreover, a social media policy must identify things that managers should bear in mind in when communicating via social media, including politeness, accuracy, objective handling of criticism, responses to questions by other users and limits in that respect (eg, protection of trade secrets).

How should the social media portfolio be best managed internally (eg, to increase security and communicate the social media policy) – and which departments need to be involved?

MH: We recommend that rights holders centralise this function, much as they do with their trademark or domain name portfolios. Registrations for social media are driven by the email address used to register the user name. If this function is centralised, the company can ensure that if the account gets hacked or an employee goes rogue, it has a quick way to reset that information and reduce potential damage. It is also important to have a strategy around this area if you are using multiple agencies or firms, and to determine how these registrations will be handled from the outset (especially the email address used to establish the registration) as they relate to your social media portfolio.

PD: Perhaps the best way to manage the social media portfolio is to make a single point of contact – that is, a particular individual/spokesperson to deal exclusively with the company’s activities in the Web 2.0 environment. Such person – along with a team, if necessary – should be given the task of managing the social media portfolio



Julia Anne Matheson
Partner, Finnegan
julia.matheson@finnegan.com

Julia Anne Matheson focuses her practice on trademark and internet-related issues, including strategic international portfolio management, counselling and clearance, opposition and cancellation proceedings, licensing, due diligence, domain name disputes, and litigation and enforcement matters for US and international clients with extensive international portfolios. Ms Matheson has practised in this area for more than 20 years, and has worked with numerous Fortune 500 companies and multinational organisations throughout the world.

end to end, including preparing the professional material to be posted on social media. The human resources and corporate communications departments need to be involved very closely to manage the social media portfolio. Additionally, this team can be entrusted with the task of building the brand on social media.

SA: A social media manager plays a critical role. On the one hand, he or she must monitor what users communicate to others about the company and its trademarks on social media. On the other, social media managers themselves must communicate on social media and be able to respond to acts by third parties which are detrimental to the company. As the use of social media by companies also requires answers to questions asked by social media users, the manager must have a good network within the company. The legal department or external consultants must be involved in dealing with the question of whether and which information is to be distributed on social media and how they should respond to possible infringements.

Moreover, the product departments can be involved – for instance, if questions on special products arise on social media. Ultimately, social media managers must redirect inquiries and comments to the right people or departments within the company and to external consultants – and must ensure that they can respond quickly.

JAM: Obviously, social media engagement will also vary considerably depending on the type of company involved. However, as an initial matter, companies need to ask themselves whether social media is really necessary to their marketing – if they are not consumer driven, it may not be, and in that case reducing the company’s social media footprint may be an important way of reducing a brand’s vulnerability.

Presuming that social media is relevant to your company, the first step is to figure out what the critical channels are so that you can be sure to devote the proper coverage to monitoring them. Depending on the nature of your business, blogs, message boards and comment sections on industry and trade publication websites may be critical. Companies should also consider putting together a list of keywords that people are likely to use in order to track conversations around these. Also, making sure that your marketing/PR groups are establishing company accounts on key social media websites and posting to them regularly will ensure that the majority of users who encounter your brand will view it in the manner that you intend.

Finally, as part of implementing a social media policy, companies need to put together crisis-management decision trees that specifically address, in advance, how coordination should work between the various departments. Any social media policy should anticipate the involvement of key players in marketing/public relations, legal, product development and company executives.

MS: A policy relating to the use of social media by employees needs to be developed with input from the HR, marketing and IT departments at the bare minimum. The HR department can define the policy, and communicate and enforce it. The marketing department – which in most instances would encourage the positive use of social media to promote a company’s brand or brands – can then provide guidance on use of the brand and any accompanying information. The role of the IT department is normally to monitor and police social media use in accordance with the established policy.

Turning to external issues, how should companies approach the monitoring of social media sites for trademark infringement/brand misuse?

Omesh Puri (OP): Most important is an attentive pair of eyes and ears! Due to the viral nature of the Web 2.0 environment, companies must indulge in real-time brand monitoring and should appoint dedicated personnel to monitor social media sites for trademark infringement/brand misuse and brand/business mentions. Smart monitoring may also reveal information related to individuals that can cause significant and consistent damage to a brand. Once identified, companies can devise a strategy to deal with such individuals. Helpfully, technology renders the task of monitoring easier than ever, as a number of tracking tools are available

MS: Different approaches should be considered for internal use of brands on social media platforms and use by third parties. One of the difficulties is monitoring such a broad array of content and assessing what needs to be dealt with and what does not. Companies need to establish a policy on what they consider to be of strategic importance. For example, many price comparators will display other parties' trademarks. While you would not want to discourage this kind of use, as it is potentially beneficial to your brand, you would want to make sure that any information presented on your company or offering is accurate. Meanwhile, a libellous blog post is something you would want to act against urgently and aggressively in order to minimise damage. A large number of monitoring products are available and these should be considered carefully to ensure that business needs are met. Internal management time is a valuable resource and it is important to select a monitoring product that effectively locates the right kind of brand misuse and provides all the information necessary for immediate action.

JAM: I always say that the best defence is often a good offence. Companies need to consider developing detection strategies that can help protect against uncharacteristic activity that purports to originate from the company or its management. At the same time, it is important to recognise that it is impossible to monitor the entire Internet. So companies need to identify, in advance, the types of abuse that are most important to their business and prioritise their detection strategies. Companies should



Marina A Lewis
Attorney, Finnegan
Marina.Lewis@finnegan.com

Marina Lewis focuses on trademark, domain name and internet law. In particular, she counsels clients on a broad range of internet and cyber law issues, including online brand enforcement, UDRP proceedings and anti-cybersquatting procedures. Ms Lewis also advises clients on consumer privacy and regulatory issues, including compliance with the Digital Millennium Copyright Act, the Communications Decency Act and the Children's Online Privacy Protection Act.

also consider taking steps such as adding a reporting function on their official website for fan/customer reporting of abuses or infringements or adding a reporting function on their company intranet for employee reporting. Additionally, consider starting the dialogue with potential infringers in a more informal manner by explaining the issue, presuming innocence or lack of knowledge, and asking for compliance.

Also, and as with most aspects of social media, managing volume is key. Conducting frequent and regular sweeps of relevant industry-specific sites increases the rights holder's chances of staying abreast of the ever-changing landscape of social media content. It does not take long for internet users and competitors alike to learn who the aggressive brand owners are.

OL: On the issue of volume, companies need to ensure that the monitoring is kept within reasonable limits in terms of expenditure of time and money. No company can monitor every comment on all social media. Thus, it is imperative to monitor the key media – such as Twitter, Facebook and Google+ – to determine whether third parties are using

confusingly similar trademarks or making misleading or unlawful negative statements about the company's trademarks or products. Companies may also commission third parties with social media monitoring expertise for this purpose. In this context, however, companies must always bear in mind that the monitoring or the capture of social media inputs must be admissible under data protection law.

MH: I think the guiding principle here is to choose your battles. Prioritising popular sites and content that are seen by large numbers of people is much more important than chasing down an annoying mention on a page that has no followers. Rights holders should make sure they are monitoring for the things that can have the greatest negative impact on their brand equity.

With the advent of new gTLDs, some of which may incorporate elements of Web 2.0 as part of their offering, how significantly will policing challenges be impacted – and what should trademark counsel be doing now to prepare?

ML: Brand protection today means way more than simply registering your trademark. Companies need to be thinking not only about first-level domain names, but also about secondary domain names, the reservation of vanity URLs, user names and the creation of official company pages on existing and emerging sites as they become relevant. The launch of the new gTLDs over the last several months has increased these concerns exponentially and the potential for online domain infringement continues to grow. That said, in many ways policing efforts will remain the same, albeit in greater volume – those that already monitor the Web for infringing domain name registrations can certainly expect their watch reports to get a bit thicker. Rights holders that do not already employ watch services should seriously consider starting now. Even rights holders that choose not to register new domains under the new gTLD offerings will still want to watch for abusive domain registrations by others seeking to register their brands under the new gTLD programme.

MS: That is a good point. New gTLDs do mean that there are increased opportunities for abuse of trademark rights, but the ability to monitor this kind of abuse is more advanced and effective than in other areas such as social media,

so rights holders are in a strong position to police the new domains immediately. The Trademark Clearinghouse should aid enforcement, allowing issues to be dealt with at an early stage for companies that have registered their marks with the monitoring system. However, its effectiveness remains to be seen. At the end of the day, any new development in the online space presents opportunities for those looking to exploit brands and misappropriate the goodwill of businesses for their own gain, and it can take the legal system time to adapt and become effective against such threats. Trademark counsel need to ensure that portfolios are in order, be aware of available monitoring products so they can select the most appropriate in order to identify issues and deal with them quickly. Generally speaking, the quicker the enforcement, the better the result.

MH: In terms of social media, we have a long road ahead of us with new gTLDs. While Facebook and social networking sites recognise them as links in posts, it is not clear that other Web 2.0 companies will do the same in the short term. At this time, Shopify and Squarespace do not yet support or recognise URLs that include new gTLDs within their applications (ie, as clickable links). In fact, it is not even clear whether Google apps support and recognise new gTLDs – and this is a company that has invested heavily in applying for and managing its own new gTLDs. I think we can expect to see inconsistencies like this through the first half of 2014, as new gTLDs progressively increase in visibility and social media sites begin to add support and functionality within their web and mobile applications. There is no clear-cut path or standard that Web 2.0 companies can rely upon to automatically add support; they have to make it a priority on their own.

As such, the overall impact of new gTLDs – including the policing challenges faced by rights holders – will depend on several factors. The first is the level of success that the domain industry will have as a whole in increasing awareness and education about new gTLDs. The second is the marketing success (or not) of new gTLD registries. Also important will be the rate of adoption, and visibility, of ‘brands’ and their investment in these new spaces. We will all be looking closely at rights holders to see how quickly they begin using their ‘brands’ in marketing and advertising, and the unique ways in which they launch new business models around them.



Pooja Dodd
Lawyer, LexOrbis
pooja@lexorbis.com

Pooja Dodd has over 14 years of experience in the IP field and heads LexOrbis’s trademark practice. She earned her LLM in intellectual property from Franklin Pierce Law Centre, United States and her LLB degree from the University of Delhi. Ms Dodd regularly advises clients on identification, protection, clearance and registration of all forms of intellectual property in India, as well as on anti-counterfeiting strategies. She also offers litigation support for cases involving IP violations. In addition, Ms Dodd has vast expertise in drafting, negotiating and vetting contracts related to the exploitation of intellectual property, as well as to the media and entertainment industries.

PD: Ultimately, the advent of new gTLDs is still fairly new and trademark holders and practitioners are still tackling the implications they bring. Rights holders are likely to face numerous challenges to protect and enforce their trademark rights. However, there are also constructive opportunities for companies to register category-specific domain names with strong keyword value to improve their market share. The key point in enforcing trademarks is to be acquainted with the established range of rights protection mechanisms. These include legal rights objections, the trademark clearinghouse, the Uniform Rapid Suspension System, post-delegation dispute resolution procedures and the Uniform Domain Name Dispute Resolution Policy.

SA: Companies should monitor the launch of new TLDs and make use of the existing protection possibilities. It is logical that the extent of monitoring for cybersquatters and

subsequent policing will increase as a result of the new domains. However, companies must also decide to what extent monitoring is economically justifiable, taking account of the costs and the benefits. A company will never be able to control everything on the Internet at reasonable expense.

In terms of protection, how useful are the specific trademark and user name policies of key social media and information sites, such as Twitter, Google+, Facebook, LinkedIn and Sina Weibo?

OL: Trademark and user name policies are useful, as most social media and information sites have a special takedown procedure in the event of contraventions of their policies. Our experience has shown that such procedures frequently allow for quicker and more effective measures than any other available. Moreover, due to the anonymity of many cybersquatters, takedown procedures are sometimes the only way to take action against such infringements.

OP: It is true that social media sites have policies in place which prohibit their users from violating others’ intellectual property, including trademark rights, and these are useful. However, the practicality of such mechanisms depends on the diligence of rights holders in monitoring misuse or abuse, the degree of urgency they demonstrate in relation to the violation and how they follow up with social media websites to reach a resolution.

ML: Another problem is that while many website operators acknowledge some steps in their policies to protect trademarks, they often fail to outline their trademark investigation strategies or set parameters for what constitutes ‘abuse’ of a mark. Frequently, the operator’s ability to take action is discretionary and rights holders cannot always predict the circumstances in which they will receive assistance. Moreover, the website operator’s decision to take action to remove an infringement is also highly dependent on its own perception of the rights holder as a threat. If the website operator is confident that the rights holder is unlikely to take action against the website itself, it has less incentive to take action. Often, the employees charged with handling the dispute resolution strategy are not schooled in dispute resolution or trademark matters. Many are simply overwhelmed by the deluge of trademark complaints and

find themselves struggling to stay abreast of the number of complaints they receive. Since rights holders cannot always depend on an intermediary website operator to safeguard their rights, they should always be considering alternative defensive action.

MH: I would say, though, that there has been a bit of a transition in this area over the past couple of years, where mitigation for rights holders has improved on these types of site. I believe that has happened for a couple of reasons. First, sites' policies and processes have matured and now have different forms that can be easily located to cover different types of misuse/infringement. Second, many of these sites rely on rights holders' marketing efforts to fund the growth of their companies and have thus started to work with brands more actively.

MS: In my experience, results have been mixed. In Europe, platforms are not liable for the content of individual posts, as long as they have some kind of policy for dealing with disputes and complaints. Often, these policies prove to be ineffective and inflexible, which makes resolving issues arising from problem posts extremely difficult. The issue of trademark infringement can be complex and it is difficult to convey some of its subtleties within the confines of each platform's trademark policy. Even if complaints receive quick responses from the platforms, some policies seem to have the primary aim of protecting the provider's interests rather than servicing the needs of the rights holder, or indeed the user.

What initial steps should a rights holder take when it discovers cases of infringement (including how to assess the likelihood of a backlash if it takes the wrong approach)?

OL: First and foremost, rights holders should preserve evidence. They should then try to obtain information on the infringer and check with their in-house counsel or external counsel whether the trademark has been infringed on an individual basis or been used in an admissible way. Next, in the event that infringement has been established, the appropriate means should be chosen to fight it on the one hand and to avoid detrimental adverse responses (eg, a chorus of outrage) on the other. In many cases, takedown procedures may also be chosen in the event of contraventions of trademark and user name policies. Finally, it is advisable to consult a PR agency to allow



Omesh Puri
Senior associate, LexOrbis
omesh@lexorbis.com

Omesh Puri is a senior associate with the trademarks practice at LexOrbis, having over seven years' experience in IP practice. He has undertaken a wide array of work in the fields of trademarks, copyright and designs. In addition, Mr Puri has significant experience in litigation before various courts in India, as well as the Intellectual Property Appellate Board. His current focus is contentious and transactional practice across other areas of intellectual property.

the rights holder to communicate its own legal position as quickly as possible and thus make its own behaviour comprehensible to the public.

If a rights holder intends to file a motion for an interim injunction against a possible infringer, it must act quickly and file this with the court within one month of becoming aware of the infringement, if possible. The court may then issue the injunction overnight – often without holding a hearing. However, if the rights holder waits too long, it can take measures only by bringing an action, which may take several months or even years.

ML: Without a doubt, the first step is to identify the nature and scope of the infringement because that will tell you a lot about the approach you want to take. With active public participation on social media sites, there is a much greater likelihood that companies will encounter so-called 'innocent infringement', such as customers using the brand to start a fan page or a blog for product reviews. The approach you take with a single mom in Des Moines who has started an unauthorised *Lord of the Rings* fan page should be

very different from that you take with a counterfeiter selling unlicensed products. Additionally, pay special attention to the level of sophistication that the infringer has with respect to social media in general. For instance, an infringer who calls himself a 'culinary blogging guru' and who starts a website featuring recipes for organic produce is much more likely to take to the Internet to spew hostility towards a rights holder that demands the end of his beloved site. On the contrary, websites that feature a simpler or less sophisticated degree of tech savvy suggest that the owner's presence in social media is less pervasive.

MS: Returning to evidence collection, one of the problems with the Internet is that content can quickly disappear when this is convenient for the owner or service provider. The next step is to carry out in-depth research into the source (eg, the individual responsible) of the content. After all, you would not want to threaten to sue an important customer who was simply expressing an opinion when a simple phone call might deal with the issue at hand. If some kind of enforcement does seem appropriate, rights holders should consider the most effective way of achieving the desired result, meaning they need to understand clearly what they want to achieve and the range of enforcement options available. I have seen numerous examples of heavy-handed approaches leading to excessive cost and negative publicity. That said, businesses should not risk eroding the value of such an important valuable asset through a reluctance to enforce. Have a clear idea of what you are prepared to accept and what you are not.

ML: As an aside, social media enforcement – if done properly – can be a huge boost to a brand's reputation and consumer goodwill. When Tennessee whiskey producer Jack Daniel's learned that a fan had used a mock-up of the company's famous label as the cover for his book, the results could have been a publicity disaster. Instead, the company decided to approach the infringer with an exceedingly polite letter explaining the issues and its concerns, acknowledging and thanking the infringer for his brand enthusiasm and enlisting his support. The approach was so successful that the letter went viral, appearing in publications such as the *ABA Journal* and the *Huffington Post*.

PD: It is true that misuse might be due to an ignorant customer/loyal fan of the company and therefore an indulgent and creative



Oliver Löffel
Partner, Löffel Abrar
loeffel@loeffel-abrar.com

Oliver Löffel is a founding partner at Löffel Abrar. He studied in Mainz and Lausanne and graduated from the University of Mainz. Mr Löffel has been a member of the Dusseldorf Bar Association since 2003. He specialises in intellectual property, dealing with trademarks, unfair competition, anti-counterfeiting, domain names, litigation and in particular IP litigation. Mr Löffel is a member of the MARQUES cyberspace team.

approach may work better, especially in the case of an innocent infringer. Once an infringement is identified, as a first step, the company should send a written communication informing the infringer of the rights held by the company and highlighting the infringing use. As a next step, the social media site's complaint procedure should be utilised. If the infringer pays no heed to this, then a cease and desist from an attorney should be sent. If there is no resolution, then litigation should be used as a last resort.

MH: Ultimately, your first recourse is the terms of service agreement specific to each social media site. Report your claim of copyright or trademark infringement to the social networking site and have the infringing content or page removed or access to it disabled. Facebook, for instance, has two forms of action available to aggrieved parties: an automated IP infringement form and a Digital Millennium Copyright Act notice of copyright infringement. If necessary, companies can attempt direct communication with the infringer or



Sascha Abrar
Partner, Löffel Abrar
abrar@loeffel-abrar.com

Sascha Abrar is a founding partner at Löffel Abrar. He achieved his doctorate from the University of Cologne, Germany and an LLM in intellectual property from Queen Mary College, University of London. Dr Abrar teaches IP law at the Dusseldorf University of Applied Sciences and is a member of the MARQUES unfair competition team. He specialises in trademark law, unfair competition law, design law and copyright law, with a focus on litigation.

pursue arbitration or litigation actions. The specific problem with social media user names is the lack of a governing organisation overseeing their ownership, and social media site guidelines tend to be geared towards consumers, creating problems for brand owners. It is a violation of the terms of service to buy and sell user names, so this limits another potential option for recovery. While this is not a widely accepted practice, it certainly does occur. You can also contact the infringer directly or litigate, but both of these approaches take time and resources – often with mixed results and potential impact from a public relations perspective. The best option is to be proactive and register branded social media user names well before you need them, as a way to future-proof the opportunity.

Wikis allow users to edit information on brands and add links to third-party sites, as well as offering discussion pages. Does Wikipedia need to be part of brands' online policing plan and how should such efforts be approached or integrated?

OP: Absolutely – Wikipedia should form an integral part of a brand's online policing plan and should be monitored closely and regularly. Any edit on Wikipedia that is found tarnishing/infringing/incorrect should be immediately reported. The company should ensure that any edit that is found to be tarnishing/infringing/incorrect is rectified within a reasonable time.

MS: Insofar as Wikipedia allows, it is essential that rights holders be aware of what information is held and presented on wikis and be in a position to provide the necessary information to the right people to ensure that their brand and business are represented in an accurate manner. Consumers and potential consumers will regularly use Wikipedia as a source of information and it is difficult to overstate its importance as a reference tool. It is highly visible and has become a trusted source of information. Monitoring and contributing to discussion pages can help to ensure that the brand is represented accurately and issues are dealt with. These activities should therefore be incorporated into any wiki policy.

MH: As with any site, being aware of what people are saying about your brand and the accuracy of their statements is important. On wikis, it may not always be infringement that you are dealing with, but rather the accuracy of reporting on the company – who owns what brands and what is being said about them. Making sure that you validate and correct content that can impact on brand or reputation is important.

SA: Unfortunately, wrong entries on companies and trademarks can be found in wikis quite often. Rights holders should ensure that false or unlawful presentations of their trademarks and companies are corrected quickly.

ML: While the type of trademark use that rights holders are most likely to encounter on Wikipedia is also likely to qualify as fair use reporting or commentary, they would be well advised to treat Wikipedia (and similar sites) in the same way as they would their own internal branding standards. This means monitoring at regular intervals for accuracy, as well as compliance with proper trademark usage. For example, a search for the term 'hula hoop' redirects the user to a page that presents the HULA HOOP brand as a generic term for plastic toy hoops, even though the mark HULA HOOP has been a registered trademark of the Wham-O Corporation and its assignees since the early

1960s. Companies that take an active role in monitoring their presence on Wikipedia should be editing the wiki entry as often as needed to remove commentary that portrays the brand in a false light or as generic. This is another example of where the best defence is the best offence.

To what degree does the rise of app technology make the policing process more difficult and should brand owners have a separate app policy or integrate it into current online policing plans?

MH: The rise of mobile apps adds another dimension which rights holders must police. They not only face the normal types of infringement issues here, but can also be subject to phishing, counterfeit sales and other types of fraud. Having in place a policy about who is creating and releasing apps related to your organisation and business – whether this is internal or via agencies – is vital to ensure you have some control over your intellectual property. If you know what is authorised, it will be easier to maintain vigilant monitoring for unauthorised mobile apps or infringement within apps.

MS: One complication is that consumers may be less aware of what infringement looks like in the app marketplace and may find infringers harder to spot than they do on more traditional online channels. App marketplaces can be harder to search than the Internet and are less transparent, meaning that specialist tools are required. The policing of apps and app marketplaces should be part of the online policing of a business, as instances of app infringement are only likely to increase given the boom in the downloading of apps for both business and entertainment purposes. Given the difficulties presented by app technology, policing will almost certainly have to differ and a specific app policy is advisable to achieve the best results and be alive to the specific threats it presents.

ML: I would argue that, for several reasons, the methodology of enforcement has actually become more straightforward and streamlined. For instance, most apps today are sold or downloaded from centralised app marketplaces, such as the Apple App Store or Google's Play marketplace. Being able to monitor specific platforms where infringing apps are made available means less time trolling the Web for rogue apps and more time dedicated to having the offenders removed. Plus, most of the online app marketplaces have established protocols for



Matt Sammon
UK head of trademarks, Marks & Clerk
msammon@marks-clerk.com

Matthew Sammon is head of Marks & Clerk's UK trademark practice. He specialises in the management of global trademark portfolios and regularly advises clients in relation to clearance searching, filing strategies and enforcement of trademark rights. His clients cover a broad range of industries, including the food and drink, finance and consumer goods markets. Mr Sammon has particular expertise in trademark matters relating to the Internet, with Marks & Clerk being the only UK patent and trademark attorney firm registered as a Trademark Clearinghouse agent.

requesting the removal of infringing apps, so rights holders can easily integrate these protocols into their existing enforcement programmes.

OL: App technology requires an extension of monitoring plans with respect to overlapping app designations. In Germany, the designation of an app may acquire protection by its mere use as a work title – according to a judgment rendered by the Regional Court of Hamburg. Those planning a new trademark should thus search not only for earlier trademarks and firm names, but also for earlier app designations. Further, the monitoring of signs must also cover apps to take account of confusingly similar designations.

PD: It has become important for rights holders to keep a watch over any misuse or abuse in the app world. The main concern stems from clone apps and apps that are deceptively similar to well-known apps, which ride off the reputation of the original

apps. Policing these on the app stores is difficult due to the proliferation of multiple app stores and the lack of policing by most of the app stores themselves. Brand owners need not have a separate app policy, they can simply integrate it into current online policing plans.

Are there any other issues you would like to raise?

ML: We would like to see more cooperation between international jurisdictions in combating infringement in the digital space. So many challenges stem from the fact that online infringement takes place on sites hosted in jurisdictions that are not favourable to trademark owners. In these cases, the options for rights holders are usually limited and if they do not work, the rights holder will probably have to spend a great deal of money combating the infringement or simply live with it. In cases of truly egregious behaviour, the rights holder may choose to file suit in the country where the site is hosted, but – as we all know – litigation is extremely expensive and time consuming. Besides, the infringer can always move the site to another host in a different jurisdiction, leaving the rights holder holding the litigation bag. An ideal solution would be an internationally sanctioned safe-harbour provision that would permit notice and takedown for rights holders – something akin to the Digital Millennium Copyright Act in the United States, or its European counterpart, the EU E-commerce Directive.

MH: In the absence of this – and with the amount of new media types and content increasing all the time – I recommend that you prioritise what can cause your brand the most harm and start with a manageable proactive plan. Making a dent in high-priority instances and sending a consistent message both within the organisation and to the outside world that brand integrity is key to your overall brand strategy is well worth the investment.

OP: In conclusion, all companies must define their approach to social media as a matter of priority to protect their proprietary rights. Trademark enforcement on social media requires a methodology which should be different from the traditional approach. Given the viral nature of Web 2.0, calculative and swift action is required upon knowledge of misuse or abuse. [WTR](#)