

Tweeting and Liking Your Way to Brand Protection: The Practical (And Somewhat Tech Savvy) Guide to Protecting Your Brand Online

By Natalie Sulimani and John S. Morales

According to the definition by the American Marketing Association, the legal term for brand is a trademark.¹ While that may be true, and brand may not be possible without a trademark, a brand should be viewed as more than that. Saying that a brand is a trademark seems too passive, as if merely registering a mark, or marks, is enough to maintain one's brand. On the contrary, the owner of a brand has to be very active in building and policing that brand in order to build up goodwill in that brand and its marks, increase value in the market and avoid losing those marks and/or market share in the marketplace.² In this article, we will explore the steps brand owners need to take in order to build and protect their brand online with the advent of social media.

First, it is important to understand the difference between social media and social networking. There is a real distinction even though they are often used interchangeably. Social media is a way to share information with a wide audience through social networking. The brand owner can directly engage with people who have things in common. This is an outward act of communication. Social networking, on the other hand, is a two way communication between, in this case, a brand owner and the public. While it is harder to gauge the return on investment with social media, with social networking it is easier because it is possible to see the traffic on a site as well as how many more "likes" or "followers" from specific campaigns. There are other differences, but the main theme here is dissemination with social media versus engaging the public through social networking.³ It is important in managing and promoting a brand online to keep these distinctions in mind while taking advantage and integrating both aspects into brand strategy.

Branding is becoming a critical part of marketing, especially in the online world. The very definition of a trademark is the association of a mark with the goods or services. The mark has to elicit specific images and information to consumers. Just like the distinctive red and white style on the can of Coca-Cola evokes in the mind the fizzy sweetness on the palette, consumers should associate the look, feel or even taste of a service or product when they see the mark. And it should be the look and feeling that the brandholder wants them to associate with the product. After all, an important aspect of trademarks, which has been recognized by the courts as well, is to cut down on consumer search costs, making it easier for the public to find the product.⁴ The benefit to the mark owner is that more people will seek out the product that they

know and will buy it more often than other products that have not built up the same goodwill in the consumer's mind. This goodwill in a mark means goodwill in the brand, so that the same red and white stripe associated with Coca-Cola will also be able to more effectively sell beach towels bearing this mark. That is the power of branding and the reason why it is important to pay close attention to how the marks are being used and discussed online.

The first step to brand protection is to own the intellectual property. While the laws of the Internet are slow to progress, protection of intellectual property is the best offensive to protecting the brand online. While one way to do that is to register the trademarks, such as name, logo or slogan, another great protection is copyright registration. Whether it is to register articles, blog posts, designs or even the website, copyright protection is part of protecting the brand offering and another line of attack against infringers.

Why is brand protection so important? It is easy to get lost in the massive amounts of information online, but at the same time, it can also be easy to differentiate from the rest through effective branding. Social media and social networking are especially suited to developing and maintaining the brand. Done the right way, connect to consumers, build a following and then remain relevant as the market changes. Doing so will help create customer loyalty and make it easier to sell existing and new products and services. At the same time, it can control any likelihood of confusion in the marketplace with other products, avoid dilution and more importantly genericide, and even control the cost of marketing. Branding online can also make it easier to quantify the return on investment. Social media allows one to monitor online campaigns. By using certain tools one can see what is and is not working in the online marketing strategy and make changes accordingly.

On the other hand, the effects of not monitoring the brand or letting someone else dictate how the brand is portrayed online can be devastating to the company. In such tight economic times, it is unnecessary to point out how every marketing dollar counts. The effects of brand abuse will bring a decline in revenue and more marketing dollars to offset the damage. It is important to remember that a brand can suffer from a death by a thousand cuts as easily as big scandal. For instance, if a competitor decided to use the mark in a pay-per-click campaign, without proper vigilance, it could easily divert consumers to its

products. To offset that kind of damage, one would have to pay more for one's own PPC campaign or more money for the web developer and search engine optimization (SEO). Moreover, allowing competitors or even consumers to use the mark generically, or in ways that are not unique to the brand, can risk the mark getting cancelled in the Trademark Office for becoming generic.⁵ Next time you have a headache and turn to your trusty aspirin, take a moment and consider that aspirin was once a trademark.⁶ The other effect of brand abuse can even be a harm to reputation and loss of goodwill. If someone should write a less than glowing review of the services on Yelp and you were not paying attention and did not respond in any way, the bottom line will reflect it. Mind you, the remedies are not always legal, but may have more to do with good old-fashioned business sense.⁷ Well, that and a good web person. Given the terms and conditions of most of the review sites, a bad review is one thing, but when falling victim to a fake review by a competitor, sometimes the only thing to be done is bury it, bury it, and yes, bury it, *i.e.* make sure that the glowing reviews far outweigh the bad.

Here are some specific examples of brand abuse and what can be done about it:

Keyword or Pay-Per-Click Abuse. Websites cannot exist in a vacuum; you cannot get the message out there if there is no one listening. One measure of a website's success is the amount of traffic. Just like a brick and mortar store, there are several ways to drive consumers to the online store. There is direct traffic (they specifically typed in the URL), foot traffic (they were searching around the web for the product or service and found the site), advertising that directs people to the store (online ads with links to the website) and referrals (someone followed the link that was posted on another site). More than any other method, the Internet is uniquely situated to take advantage of cross promotion and linking. While direct traffic is nice, most of the time, people do a search, or "Google," and then find the website. Even there, there are two options, a "sponsored" ad or organic search. An organic search relies on really good search engine optimization (SEO). A good organic search depends on proper keywords, descriptions, tagging and things of that nature. Note, Google, as well as the other search engines, no longer pays attention to metatags so we can move on from there. Keywords, however, are a different story. They are, in a word, key. While most people will use their mark and a description of services as keywords, some people will use their competitor's mark as a keyword either with the SEO or by buying the keyword. Pay-per-click (PPC) advertisements are the sponsored ads you see at the right or top of the search page. Companies pay for keywords and Google has made it quite clear that it will sell registered trademarks as keywords. Other search engines have not engaged in this practice thus far. Google's argument is that there is no likelihood of confu-

sion and that, technically, it is not a use in commerce. This attorney disagrees and so should any brand holder. As, in fact, the Second Circuit did, at least on the issue of "use in commerce."⁸ Essentially, competitors are taking a free ride on the goodwill and marketing dollars to divert legitimate traffic from one site to theirs.⁹ After all, didn't they search for your trademark? Keyword and PPC abuse is something you can monitor by having the proper analytics and alerts in place (analytics are a way to monitor who is visiting the site and how they are getting there). Some vendors are Google Analytics or StatCounter. Alerts are a way to monitor any mentions of the brand. A good source for this is Google alerts or paid monitoring companies.

Cybersquatting. While still a problem, it is no longer the cybersquatting of yesteryear. First, as a trademark holder, the remedies are laid out through domain name disputes administered through the Internet Corporation for Assigned Names and Numbers (ICANN). It is important to be the rightful owner of the trademark before pursuing a domain name action, meaning that the mark is federally registered or there is at least a common law claim to the mark. Gripe sites are still around, but for the most part, that's protected as nominative fair use under the Lanham Act or as free speech under the First Amendment.¹⁰ The real threats now are the emails coming from abroad threatening to register sites overseas lest you pay them for those sites. Still, domain name disputes are cost effective and fairly straightforward under the Uniform Domain-Name Dispute Resolution policy. As long as the brand holder has a registered trademark and the cybersquatter has no legitimate use besides holding the site hostage, more often than not, the decision will be in the brand holder's favor, even if the defendant appears in court. Practically speaking, cybersquatters rarely show up to defend themselves—for every domain name lost, there is someone else down the road that would rather pay than litigate.

Defamation. This is a false statement that is harmful to someone's reputation, and published "with fault," meaning that one knew or should have known that it was false. Libel is a written defamation; slander is a spoken defamation. Defamation is determined differently by the laws of each state, but generally, the elements to prove defamation are:

1. A publication to one other than the person defamed;
2. A false statement of fact (this does not include opinions or statements of hyperbole); and
3. That it is understood as being of and concerning the plaintiff; and tending to harm the reputation of plaintiff.
4. If the plaintiff is a public figure, he or she must also prove actual malice.

One cannot sue under defamation for statements of truth. Another stumbling block with defamation is that although you may hold the party that wrote the defaming content online liable, you cannot reach the provider that posted the content because of the immunity provided by Section 230 of the Communications Decency Act.¹¹ Instead of defamation, you may find more success through trademark and copyright law in removing damaging information.¹²

False Association. This is a slippery slope on the Internet and subject to all the fair use defenses provided by the Lanham Act.¹³ A brand owner must also consider the damage to the brand for being overly vigilant in this area. In a situation like *New Kids on the Block*,¹⁴ even if the trademark owner were to prevail against the defendant, the result might be a lot of bad will against the mark and possibly irreparable harm to the brand through bad PR and “sucks” sites that are beyond the ability to control.¹⁵

Going back to the issue of SEO, linking is another way to increase website ranking, and here is where you need to rely on that good old-fashioned business acumen again. The question always is, “Do I want to be associated with this website?” It is a mistake to not allow other sites to link to your site and vice versa. After all, this is goodwill on the Internet. By utilizing other traffic sources to get your website seen, you can increase exposure exponentially. But that being said, you are giving them a license, and it is conditional. It is the nature of the Internet that sites are bought and sold. You need to be in control of who is linking to you and how. Should you decide that you do not like the association, you can revoke that license. This, again, is something that can be monitored with good analytics.

To Cease and Desist or Not. While you are monitoring a brand online, you should look for trademark or copyright infringement, defamation, cybersquatting, misappropriation of name, and general harm to reputation, to name a few. This is also where business sense is a must. While a cease and desist to the infringer is a good idea, weigh your options. Perhaps this is someone that can help the brand instead of hurting. If they are, consider a license that can be mutually beneficial. If you decide that the use is harmful, send a cease and desist. The first touch should always be the gentlest. You cannot assume that they are maliciously infringing, they might, in truth, have no idea that you exist. A harsh cease and desist letter might not only preclude an amicable outcome down the line but may also be bad PR for the company. And rather than protecting the brand, you may damage it. Remember the saying about flies and honey. A quick glance at chillingeffects.org reveals that a cease and desist letter has become something of a rite of passage on the Internet. But although they may be commonplace, well-considered letters can still go a long way.

If, however, the cease and desist does not work, then explore further. You should first read the terms of use

of the site where you feel the brand is being harmed or misrepresented. It is easier to work within the provider’s guidelines. For social networking sites, trademark and copyright infringement should be pursued first and foremost, as most often these are the clearest claims to make. Given the take down procedures that website holders have to abide by, all you need to prove is that the intellectual property is being infringed upon. However, there are several caveats. First, you must list the works that are being infringed, specifically giving the information on the work as well as the information and link to the work on the website.¹⁶ Second, the complaint must be in good faith, which includes considering any fair use defenses before filing the complaint.¹⁷ Once those options are exhausted to no avail, look further into what other actions you can take. Sometimes a more cost-effective approach is more PR and SEO than legal.

Whether you are watching or not, brands exist on the internet and in social media. It is better to join in on the conversation, build goodwill and make sure that the message is the message that is getting out there. Given the tools available, it is getting easier to keep vigilant watch and monitor a brand, for better or for worse. Tweet and Like away, comfortably knowing that you are the first step in brand management.

Endnotes

1. See American Marketing Association, Marketing Power, Dictionary, available at http://www.marketingpower.com/_layouts/Dictionary.aspx?dLetter=B.
2. The burden of policing one’s brand has been held by courts in cases such as *Tiffany, Inc. v. eBay, Inc.*, to be on the brand owner:

The Court is not unsympathetic to Tiffany and other rights owners who have invested enormous resources in developing their brands, only to see them illicitly and efficiently exploited by others on the Internet. Nevertheless, the law is clear: it is the trademark owner’s burden to police its mark, and companies like eBay cannot be held liable for trademark infringement based solely on their generalized knowledge that trademark infringement might be occurring on their websites.

576 F. Supp. 2d 463, 527 (S.D.N.Y. 2008), *aff’d in part*, 600 F.3d 93 (2d Cir. 2010). The Second Circuit agreed with the district court that Tiffany could not hold eBay contributorily liable based on generalized knowledge but rather must have been found to be willfully blind to the infringement. However, even though eBay conceded that it knew as a general matter that counterfeit Tiffany products were listed and sold through its website, both the district court and the Second Circuit concluded that without more than this, eBay did not have enough knowledge to trigger liability under *Inwood*. *Tiffany*, 600 F.3d at 110 citing *Tiffany*, 576 F. Supp.2d at 513-14 and *Inwood Lab, Inc. v. Ives Lab, Inc.*, 456 U.S. 844, 102 S. Ct. 2182 (1982).
3. Brian Solis has been an outspoken proponent of businesses engaging the public in the social media forum as a brand marketing strategy, see “The Social Media Manifesto—Integrating Social Media into Marketing Communications,” June 11, 2007, available at <http://www.briansolis.com/2007/06/future-of-communications-manifesto-for/>.

4. See *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002) (“The fundamental purpose of a trademark is to reduce consumer search costs by providing a concise and unequivocal identifier of the particular source of particular goods.”).
5. There is no cure for “genericide.” Once the mark becomes associated with a whole class of goods or services any challenge by a junior user wanting to remove a protection will succeed. See discussion, *infra*, at note 7. Therefore, it is important to communicate with the consuming public that a mark is not the product, i.e., it is not a q-tip that cleans ears, it is a Q-TIP cotton swab.
6. *Bayer Co. v. United Drug Co.*, 272 F. 505 (D.C.N.Y. 1921). The court ruled that consumers had come to know acetyl salicylic acid by no other term but “aspirin” and therefore by granting a monopoly to the plaintiff, it would deprive the defendant as well as the trade in general “of the right effectually to dispose of the drug by the only description which will be understood.” *Id.* at 514. For a further discussion of how to avoid genericism, see Charles R. Taylor and Michael G. Walsh, *Legal Strategies for Protecting Brands from Genericide: Recent Trends in Evidence Weighted in Court Cases*, *Journal of Public Policy & Marketing*, Vol. 21, No. 1, Social Marketing Initiatives (Spring, 2002).
7. Under Federal Statute, 47 U.S.C. § 230, Internet providers, such as Yelp!, who post content that is provided by another content provider, i.e., the site is not producing the content of the post, are immune from any liability based on the offending posts, except intellectual property infringements. Therefore, although a plaintiff may have a cause of action against the party that wrote and posted the defaming message, there is no action against the Internet provider that carries the post. See *Zeran v. America Online, Inc.*, 129 F.3d 327 (4th Cir. 1997), *cert denied*, 524 U.S. 937 (1998) (the court ruled that Defendant was immune from any liability for distributing defamatory material on its website despite notice from Plaintiff of its defamatory nature), *cf.*, *Fair Housing Council of San Fernando Valley v. Roommates.com, LLC*, 521 F.3d 1157 (9th Cir. 2008) (en banc) (the court concluded that the manner in which the service elicited information from users concerning their roommate preferences (dropdown menus specifying gender, presence of children, and sexual orientation without an option to not answer), and the manner in which it utilized that information in generating roommate matches (by eliminating profiles that did not match user specifications) meant that the defendant in fact created or developed the information claimed to violate the Fair Housing Act, and thus was responsible for it as an “information content provider”).
8. See *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123 (2d Cir. 2009) (The Second Circuit Court of Appeals vacated and remanded the district court’s decision holding that Google’s practice was a “use in commerce” of Rescuecom’s trademark within meaning of the Lanham Act and therefore the district court would need to make a decision on whether this use was infringing or not.). However, as of March 2010, Rescuecom dismissed its lawsuit against Google claiming victory based on the fact that Google removed its trademark from the list of keywords, something Google may have done as early as 2005, and Google has instituted a policy to disallow the use of trademarks within the text of a sponsored link with some exceptions. But, in fact, what seems to be going on here is that Rescuecom is pursuing a separate litigation against Best Buy, the owner of the GEEK SQUAD mark, seeking a declaratory judgment that it is entitled to use the term “geek squad” as a keyword for a sponsored link which supposedly suggests comparative advertising. Therefore, a decision against Google might preclude the desired outcome against Best Buy. The bottom line then is that courts have ruled that selling keywords is a trademark use and comes under the Lanham Act, but we still do not know if this is an infringing use.
9. See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999) (where the appellate court construed a narrow interpretation of the use of metatags and initial interest confusion so that the words used in the metatag had to match the mark exactly in order to fit the brick and mortar model of putting a billboard on a highway). Therefore, success may not be assured when pursuing an initial interest claim against online infringers.
10. See *Taubman v. Webfeats*, 319 F.3d 770 (6th Cir. 2003). In this case, the plaintiff sought an injunction of the original site, “theshopsatwillowsbend.com” and subsequently for the five “.sucks” sites that the defendant registered following the initial suit. The appellate court dismissed all these claims based on the fact that the defendant’s websites were neither intended nor used for any commercial purposes and therefore the use of the plaintiff’s mark was protected by free speech under the First Amendment as well as nominative fair use under the Lanham Act. The court further noted that even if there had been commercial use on these sites, there would still not have been a likelihood of confusion based on the fact that the defendant had clearly posted a disclaimer stating that his site was in no way affiliated with the plaintiff and moreover he provided a link to the plaintiff’s site for those who had navigated to his site by mistake. The court did not find it dispositive against the defendant that he had engaged in negotiations to sell the domain name to the plaintiff because the defendant had no history of buying and selling domain names to trademark owners and moreover the negotiations were initiated by the plaintiff. See also, *Bally Total Fitness Holding Corporation v. Andrew Faber*, 29 F. Supp. 2d 1161 (C.D. Ca. 1998) (the court held that Faber had demonstrated that there was no likelihood of confusion based in part on the fact that the goods were not related and that a reasonable consumer would not mistake Faber’s site for Bally’s official site given that the defendant says his site is unauthorized and that he has superimposed the word “sucks” over the plaintiff’s mark). *Cf.*, *Shields v. Zuccarini*, 254 F.3d 476 (3d Cir. 2001) (where the court held the defendant liable for likelihood of confusion for five of the domain names he registered that were very similar to the plaintiff’s trademark due to the fact that he acted in bad faith with an intent to profit based on a lack of real content on these websites and a history of making a profit on these sites).
11. 47 U.S.C. § 230, see discussion, *supra*, at note 8.
12. Intellectual property claims are not protected by Section 230 immunity, so there is no blanket protection for Internet providers with regard to trademark and copyright infringement. However, one must consider for trademark claims whether the use is protected by fair use or the First Amendment, see discussion, *supra*, at note 11. And for copyright claims, one must consider the Digital Millennium Copyright Act of 1998 (DMCA), which offers a “safe harbor” to Internet service providers that meet all of the following criteria:
 - A service provider shall not be liable for monetary relief, or, except as provided in subsection (j), for injunctive or other equitable relief, for infringement of copyright by reason of the storage at the direction of a user of material that resides on a system or network controlled or operated by or for the service provider, if the service provider—
 - (A) (i) does not have actual knowledge that the material or an activity using the material on the system or network is infringing;
 - (ii) in the absence of such actual knowledge, is not aware of facts or circumstances from which infringing activity is apparent; or
 - (iii) upon obtaining such knowledge or awareness, acts expeditiously to remove, or disable access to, the material;
 - (B) does not receive a financial benefit directly attributable to the infringing activity, in a case in

which the service provider has the right and ability to control such activity; and

(C) upon notification of claimed infringement as described in paragraph (3), responds expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.

17 U.S.C. § 512(c). The issue of notification and expeditious removal has become a hot issue where copyright owners are trying to push the courts to define what this means exactly, *see*, *Viacom International, Inc. v. YouTube, Inc.*, _ F. Supp. 2d _ 2010 WL 2532404 (S.D.N.Y., Jun. 23, 2010) (The court held that the defendant qualified for the safe harbor protection under the DMCA because it had removed any and all infringing videos that the plaintiff had specifically requested and moreover the defendant has instituted a policy of voluntarily removing posts that it feels may be infringing. It was not sufficient that the plaintiff made a general request to the defendant to remove all infringing videos, specific information was necessary.). It is important to note also that not qualifying for the "safe harbor" under the DMCA does not automatically mean that the Internet provider is contributorily liable for copyright infringement; this must still be litigated.

13. Lanham Act § 33(b)(4).

14. *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992) (fan site was allowed to use the plaintiff's trademark under a nominative fair use defense because there was no other way to refer to it).

15. See discussion, *supra*, at note 11.

16. See, 17 U.S.C. § 512(c)(1)(C) and *Viacom International, Inc. v. YouTube, Inc.*, _ F. Supp. 2d _ 2010 WL 2532404 (S.D.N.Y., Jun. 23, 2010), see discussion, *supra*, at note 13.

17. See, 17 U.S.C. § 512(f):

Misrepresentations. Any person who knowingly materially misrepresents under this section—

(1) that material or activity is infringing, or

(2) that material or activity was removed or disabled by mistake or misidentification, shall be liable for any damages, including costs and attorneys' fees, incurred by the alleged infringer, by any copyright owner or copyright owner's authorized licensee, or by a service provider, who is injured by such misrepresentation, as the result of the service provider relying upon such misrepresentation in removing or disabling access to the material or activity claimed to be infringing, or in replacing the removed material or ceasing to disable access to it.

Courts, however, have been willing to allow complaints that were based on a subjective belief on infringement, even if that belief was incorrect. *Rossi v. Motion Picture Ass'n of America*, 391 F.3d 1000, 1004-05 (9th Cir. 2004).

Natalie Sulimani, as partner of Sulimani Law Firm, PC, is engaged in a wide variety of intellectual property, technology and general corporate matters with a strong focus on small businesses and entrepreneurs. Natalie is a frequent speaker and panelist on intellectual property, protecting your brand online and small business matters. You can follow her at www.twitter.com/sulilaw.

John S. Morales is an intern for Sulimani Law Firm, PC, and a student at New York Law School. John was formerly an Associate Editor at the International Trademark Association for its law journal, *The Trademark Reporter*. John is focusing his studies in law school on intellectual property.

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