

Defending Your Trademarks in the Social Media World

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If you are familiar with Facebook[®], MySpace[®], Twitter[®] or LinkedIn[®] social networking services, you are not alone. Whether through paid advertising on a particular site, or "fanning" or "friending" a particular product, sports team or restaurant, social media raises a myriad of issues relating to trademark protection. While much has been written about how a trademark owner can use social media to deliver its brand message, little attention has been given to the flipside, the trademark owner's need to defend its brand in the social media world.

"Social media" is the commonly-accepted term used to describe the use of web technology to provide a platform for distributing user-generated content. Unlike conventional media, in which a limited number of sources provide information to the general public, in the social media context, the general public both provides and consumes information.

In the last two years, the number of social media users has soared. Recent figures suggest that Facebook now serves more than 500 million users, MySpace and Twitter more than 100 million users each, and LinkedIn more than 70 million users. Each of these services allows its users to create and post publicly-accessible content, on virtually any topic, and in virtually any manner, with little or no oversight.

Where Trademark Issues Arise

While social networking sites are beneficial in many ways, they are fertile ground for trademark misuse. In this regard, a fairly new practice has been the use of "vanity" URLs. A vanity URL is a relatively short URL that points to content that is succinctly described in the sub-domain portion of the URL. For example, there are many brands for which the URL [www.facebook.com/\[TRADEMARK\]](http://www.facebook.com/[TRADEMARK]) points to a social networking web page for the branded product associated with the trademark appearing in the vanity URL. When the associated web page is maintained by the trademark owner, displaying owner-approved content, there is no problem. However, virtually any user can create a vanity URL, and there is little to prevent an unauthorized user from using another's trademark as the essential portion of a vanity URL. For example, no identification, authentication of identity, or authorization is required to stop someone from creating a website using a vanity URL that contains a popular brand name, such as "Nike." Likewise, LinkedIn permits users to create named user groups; however virtually any user can create a named group, and upload an image (such as a logo

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easily retrieved from the trademark owner's official website) to be used to identify the group.

But, unlike domain name cybersquatting and trademark abuses for which specific legal remedies are well-established, law and procedures for resolving social media trademark issues are in their infancy. Further, the forms of trademark use are quite varied. While some unauthorized uses are commercial in nature, many others are not. Further still, some unauthorized uses may be disparaging and objectionable, while others may offer praise. Consider an online social networking web page that looks official, has a recognizable brand name, and displays the official corporate logo. Suppose that the page displays a lot of praise for the branded products. If the page is controlled by the brand owner, there may not be a trademark issue. But, what if the page is not controlled by the brand owner? There still may not be an immediate problem. But, what if the page recommends a certain online store for purchasing the products, and those products are inferior counterfeit products? Or, what if the page includes discussion of other products (or services) that appear to be sponsored by, or offered by, the corporation that has its logo displayed on the web page? These scenarios could create problems for a trademark owner that does not want to be associated with counterfeit, inferior, or competing products. Even a seemingly "friendly" social networking fan page provides a forum for visitors to post information that may be harmful to the trademark owner.

Traditional and Progressive Approaches to Resolving Trademark Issues

The trademark owner must be particularly thoughtful and creative in addressing unauthorized use of trademarks in the social media context. In a more traditional approach, the trademark owner may send the social networking page's "owner" a conventional cease-and-desist letter. This might be the right approach if the page is wrongfully using a trademark in a commercial trademark manner. However, it may not be appropriate where there is no commercial use. In such a case, lodging a complaint with the social networking website, under the web site's own policies, may be more effective.

The trademark owner may wish to gain control of a social networking page that makes unauthorized use of the owner's trademark. For example, transfer of "ownership" and control of LinkedIn Groups to trademark owners is permitted under applicable policies. After gaining control of the group, the trademark owner should establish policies for the group that are consistent with the trademark owner's interests. For example, a policy may require that visitors to the relevant social networking webpage refrain from: (i) commercial use of the mark; (ii) solicitation for purchase of any competing products or services; and (iii) posting of content that would tarnish the mark. Such policies should permit the trademark owner to bar a visitor from use of the social networking website for failure to comply with the policies.

The trademark owner should consider that taking the traditional approach may backfire when the unauthorized party is an enthusiastic fan of the trademark owner's product and is part of a large fan group. The very same social networking tools that were used to champion the trademark owner's products might be used to lead an anti-owner campaign.

In such situations, a more progressive approach to resolving the issue could begin with sending the unauthorized social networking web page "operator" a "friendly" letter permitting continued use of the trademark, but in a controlled manner. This collaborative approach involves partnering with the operator and granting permission to use the mark consistent with the trademark owner's guidelines.

In appropriate circumstances, the operator of the social networking page could be enlisted to assist in monitoring for users' actions in violation of an applicable use policy. If desired, the trademark owner could require the operator to include a disclaimer distinguishing the operator from the trademark owner, or to provide a hyperlink on the unauthorized web page to the "official" web page of the trademark owner.

The trademark owner might also require that no more than a reasonably necessary portion of the mark be displayed by the social networking page, e.g., to prohibit third party use of a logo when a mere word form of the mark is available. In a highly-collaborative approach, the trademark owner may facilitate the operator's activities, e.g., by providing owner-approved content for posting by the operator. Such collaboration may incentivize the operator to comply with the trademark owner's requests.

Social Media Strategy

Preventative measures should be taken to avoid or limit unauthorized use of new trademarks. Such preventative measures should be built into corporate workflow processes for selecting, approving and rolling-out new brands. For example, standard operating procedures should include not only clearance and federal registration for new trademarks, but also registration of domain names corresponding to new/proposed trademarks (including exact matches and variants), registration of new trademarks as usernames/vanity URLs with selected social networking websites, and establishment of brand-specific social media groups and dedicated social media pages.

As the use of social media continues to increase, it is critical for trademark owners to be vigilant in monitoring use of their trademarks in social media. Such monitoring should be focused on social media web sites that are most relevant to the trademark owner's customer base.

The considerations discussed above are summarized in the table below.

For new brands:	For existing brands:
<ol style="list-style-type: none">1. Perform clearance studies to confirm availability of new/proposed trademarks for use/registration2. Register domain names corresponding to new/proposed marks3. Reserve vanity URLs, usernames and groups names corresponding to new/proposed marks with social networking websites4. Establish dedicated web/social networking pages corresponding to new/proposed marks5. Register cleared marks	<ol style="list-style-type: none">1. Identify highly relevant social networking websites for monitoring2. Monitor relevant social networking websites for use of owned trademarks3. In the event of unauthorized use:<ul style="list-style-type: none">• Consider nature and commercial impact of the use• Consider sending a cease and desist letter• Consider lodging a complaint with the social networking website• Consider collaborating with the unauthorized user

Various tools exist for quickly determining the extent of use of a trademark on most social networking/social media websites. Trademark owners and managers should consult with trademark counsel having social media expertise to identify areas for likely trademark abuse, and to prioritize marks for additional protection measures in the social media context.

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