

Intellectual Property Online: Attacks & Defenses

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Internet of Things Disputes

- The Internet has grown into the world's telecommunications medium, but has not grown up completely
- There are still growing pains
 - Websites want user-generated content ("UGC"), but don't want to be responsible for bad UGC
 - Infringers copy UGC, websites, pages, brands, products
 - Thieves steal domain names and hard products
 - Trolls threaten baseless suits
- What's a lawyer to do?



Overview

- Over time, we have developed a number of tools specifically for use on the Internet, and adapted other tools
- Almost all of the tools are based in intellectual property

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Intellectual property...

... is the name of a category or collection of related areas of the law

... is not a single, unified area of the law

**Copyright ≠ Patent ≠ Trademark ≠ Trade Secret
≠ Mask Work ≠ ...**

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Intellectual property: 3 examples

<u>Type</u>	<u>Protects</u>	<u>Registration</u>	<u>Duration</u>
Copyright	Expressions of ideas	Required prior to suing; recommended	Life + 70 years; or shorter of 95 years from 1 st publication, or 120 years from creation
Trademark	Brands	Not required; but recommended	Indefinitely, as long as used with goods/services
Patent	Inventions	Required prior to or within one year of invention on sale, publicly disclosed or practiced	Expires 20 years after initial filing

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First Up: Copyright law ...

- Protects original *expressions* of ideas
- Does *not* protect the underlying ideas
- Embodied in a “tangible medium of expression”

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Problem: Someone copied my stuff!

- For any client worried about protecting their websites, software, apps, text, photos, graphics and other content, you or the client should file a copyright application
- Registration is required before you can file an infringement suit
 - *Unless*, you're not a U.S. citizen or resident
- If you file an application prior to an infringement, then you may seek attorney's fees or statutory damages from the infringer

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How to file an application

- File online at copyright.gov/eco
- Don't need a lawyer!
- Filing fees under \$100
- Registration as of filing date
- Certificate arrives 4-6 months later
- File new application each time the work is substantially modified

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Problem: My customers are posting infringing works, and I'm getting blamed!

- One part of the DMCA created a Designation of Agent process
- Each “online provider” (website, ISP, etc.) must take several steps:
 - File a Designation of Agent form with the Copyright Office (<https://www.copyright.gov/dmca-directory/>); keep it current
 - Establish an internal process to review & implement takedown notices
 - Publish the process on client's website
 - Implement the process properly when the client receives takedown notices

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Trademark law ...

- Protects brands (called “marks”)
- Any distinctive designation of the source of goods or services
- Does *not* protect any other aspect of a good
 - Trademarks are not copyrights or patents
- Protections effective when marks used to sell goods and services

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Common law trademark rights

- Under the common law (law made by judges) in the US, you gain rights to a mark on a use-it-or-lose-it basis *in the United States*, and can enforce those rights in court
- May also enforce rights via Section 43(a) of the Lanham Act
- Rights are limited:
 - Time of selling
 - Particular goods or services you sell
 - Geographic area in which you sell

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Federal trademark law

- Federal registration adds rights and remedies in addition to common law rights
- Protects marks in geographic areas within the US where you are *not* using the mark
- Can file an application before you begin using the mark (the application acts like a reservation)

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Problem: Cybersquatting

- Common law rights help protect domain names
- Federal trademark registration better
- Several options to fight cybersquatters including UDRP and ACPA

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Uniform Domain Name Dispute Resolution Policy (UDRP)

- It's not arbitration; it is binding; it can be appealed
- Under the UDRP, the owner must establish
 - (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights
 - (ii) the registrant does not have any rights or legitimate interests in the domain name
 - (iii) the registrant registered the domain name and is using it in "bad faith"

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UDRP Process

<https://www.icann.org/resources/pages/help/dndr/udrp-en>

- One or three panelists
- Panel may order the domain name to be transferred
- If the complainant (trademark owner) sought to use the UDRP process to steal the domain away, the panel may declare the complainant a reverse domain name hijacker
- If a respondent (domain name registrant) loses a UDRP proceeding, it must file a lawsuit against the trademark holder within ten days to prevent ICANN from transferring the domain name

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Anticybersquatting Consumer Protection Act (ACPA)

15 U.S.C. § 1125(d)

- Trademark owner may sue a domain name registrant who
 - (i) has a bad faith intent to profit from the mark and
 - (ii) registers, traffics in, or uses a domain name that is
 - (a) identical or confusingly similar to a distinctive mark, or
 - (b) identical or confusingly similar to or dilutive of a famous mark.

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ACPA: Proving bad faith

- Factors for determining bad faith
 - Registrant's trademark or other intellectual property rights in the domain name
 - Registrant's legal or common name
 - Registrant's prior use of the domain name in connection with the bona fide offering of goods or services
 - Registrant's bona fide noncommercial or fair use of the mark in a site accessible by the domain name

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ACPA: More factors to prove bad faith

- Registrant's intent to divert customers from the mark owner's online location for commercial gain or with the intent to tarnish or disparage the mark
- Registrant's offer to transfer, sell, or otherwise assign the domain name to the mark owner or a third party for financial gain, without having used the mark in a legitimate site
- Registrant's providing misleading false contact information when applying for registration of the domain name
- Registrant's registration or acquisition of multiple domain names that are identical or confusingly similar to marks of others
- The extent to which the mark in the domain is distinctive or famous

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UDRP v. ACPA

- UDRP is generally less expensive
- UDRP can be “overruled” or superseded by a court case filed promptly (including an ACPA case)
 - Most cybersquatters don’t bother, because their investment in each domain name is so small
- ACPA is a court case, so if you expect to go to court, you may want to start with ACPA

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Amazon Brand Registry

<https://brandservices.amazon.com/>

- Harkens back to earlier internal processes, such as Network Solutions’ Domain Dispute Policy from the 1990s
- Bad guys infringe the Amazon pages of small companies, and then bait-and-switch the goods until Amazon removes the bad guys’ pages
- Formerly, allowed brand owners to register based on common law trademark rights
- Currently requires a federal trademark registration

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How to file a trademark application...

- Search online at <http://tmsearch.uspto.gov>
- File online at <https://www.uspto.gov/trademarks-application-process/filing-online>
- File an “intent-to-use” (“ITU”) application if not yet selling across state lines
- File an “actual use” application if selling across state lines

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Questions?

Thank you!

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