



STOPPING ONLINE IP INFRINGEMENT

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TRADITIONAL INFRINGEMENT ISSUES

Copying narrative text

Recording and bootlegging movies

Unauthorized distribution, display, production

Knock-off products, both non-genuine and alleged equivalents

Brochures, packaging, static advertisements

Similar trademarks vying for market share

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TRADITIONAL REMEDIES

Cease and desist

Challenging validity of registrations

Alleging infringement

Seizure, impoundment and destruction of infringing goods

Injunctive relief



AGE OF THE INTERNET

Fleeting and permanent at the same time

Cut and paste photos and content

Software

International dimension when protections have geographic limitations

Blurring of commercial use

- Blogs with passive ad revenue, affiliate links, etc.

Redirecting consumer traffic

- Blatantly: e.g., domain names
- Secretly: e.g., ad words



SOCIAL MEDIA IMPACT

2016: 2.3 billion social media users

Audience not passive recipients of marketing anymore

- Customers
- Consumers
- Influencers



SOCIAL MEDIA IMPACT

Handles, log-ons and hashtags

Parody pages

Commentary

Petitions

Supplanting traditional pages in search engines

Marketing medium



THE BASICS

Copyright

Trademark

Patent (design and utility)

Trade dress

Trade secrets

Confidential information and know-how



US COPYRIGHT

Federal right created by US Constitution

Provisions for cooperation internationally

Copyright term is 70 years plus life of author for newer registrations

“Fixed in a tangible medium”

Expression not necessarily tied to commerce, but may be



RIGHTS OF AUTHOR/HOLDER

Copy or reproduce works

Prepare derivative works

Perform the work publicly

Display the work publicly

Perform the work publicly by means of a digital audio transmission



COPYRIGHTABLE SUBJECT MATTER

Pictures

Sculpture

Paintings

Graphics

Music

Audiovisual works

Audio works (sampling)

Databases

Computer code

Compilations

DOES NOT INCLUDE facts, titles, slogans, ideas



WHO OWNS IT?

Employees in scope of employment → employer

Independent contractor for specific types of works → scope of work,
then also need written agreement “work made for hire”

Terms of use of apps and websites

Marketplace participation

- Granting licenses, even if not ownership rights



DIGITAL MILLENNIUM COPYRIGHT ACT OF 1998

Protection for ISPs who are conduits, but not creators

Compliance requirements

- Create notices
- Methods for addressing issues
- Prompt action
- Participation on websites

Limited “pass on” of immunity



DIGITAL MILLENNIUM COPYRIGHT ACT OF 1998

Always read the copyright notice before copying any content

File for DMCA safe harbor status if your site qualifies

- Critical if you allow posting of content



FAIR USE DOCTRINE

Purpose and character of use (commercial versus nonprofit educational)

Nature of the copyrighted work

Amount and sustainability of portion used in relation to whole work

Effect of use upon the potential market for or value of the copyrighted work



MYTHS

If it is on the internet, it is in the public domain.

It is okay to use, so long as I cite where I got it.

- Plagiarism versus infringement (use is enough for infringement, attribution is not permission)

No one will ever find it if I use it.

- Entire industry devoted to this service

I'm too small of a company/just one person, no one will sue me.

Companies expect me to use this.

Okay to use if I am commenting on an event, celebrity, etc. because of the First Amendment.



MYTHS

If I didn't know it was wrong to use, I have a good defense.

If I got it from someone else who claims to have a right to use it, I have a total defense.

If not registered, ok to use.

- Still need to register as condition precedent to suit and to get optimal recovery in litigation
 - \$750 (\$200*) - \$30,000 per instance versus \$750 - \$150,000 if willful + attorneys fees to prevailing party



ADDITIONAL BEST PRACTICES

Understand licensing requirements and how enforcement works

Hyperlinking? Stay tuned...

Use original content

Protect materials before posting

Agreements with users to protect from copying

Be aware of indemnification obligations

Pay special attention to software

- Source, derivative, permitted uses



TRADEMARK BASICS

Commercial speech

Source indicator for specific goods and services

Common law and registered (state and federal)

Infringement versus dilution

- Dilution requires fame

Quality of trademark

Use it or lose it – potentially perpetual, but marketing cycles changing

Geographic limitations



DISTINCTIVENESS

Ability to claim infringement

- Use of mark descriptively
- Use of adword for category
- Complicates clearance process
 - Considerations beyond registries and common law

Impacts enforceability

- Retaliatory action options and likelihood of success



ENFORCEMENT CONCERNS

Confusion of source / passing off

Endorsement

Quality issues

False comparisons

Unfair competition

Theft of consumer base/goodwill

Email/phishing scams using well-known marks



ENFORCEMENT ISSUE: ANONYMITY

Counter to the entire foundation of trademarks

Difficult to track ownership of sites, true source of products, rapid open/shut down of store fronts

Social media issue: who is the real party at issue?

Impact to goodwill



OTHER ENFORCEMENT OPTIONS: ANTICYBERSQUATTING CLAIMS

Registers in bad faith, traffics or uses domain name that is identical, confusingly similar to or dilutive of the mark or name

Raised as a separate claim to infringement

Brought as a separate claim in litigation

Timing is important to establishing cause of action



ICANN DOMAIN NAME DISPUTES

Registrar of domain names – confirm registrar

Expedited way to attend to fraudulent registrations

- Intent and timing key to options for enforcement
- Forcible transfer and shut down
- Lower cost alternative to full-scale litigation



TAKEDOWN OPTIONS THROUGH PRIVATE MECHANISMS

Usually requires a registration

- Automated process
- Loose community privileges
- Loose ability to open new storefront/flags user
- Remember infringement is commercial
 - Still have disparagement concerns
- Fair use also a defense
- *There is an appeal process*



MONITOR SOCIAL MEDIA

Increased speed and impact of both positive and negative associations

- Reviews
- Comments
- Complaints
- Viral marketing and campaigns

Some have “first come, first serve” → you cannot necessarily claim handles, etc. based on registrations

Report bad actors

Secure marks where available

Monitor comments

Customer service dedicated to social media



IMPACT OF SOCIAL MEDIA

Care in using traditional methods

- Can exacerbate brandjacking and have unintended effect

More combination claims

- Small competitor modifies logo and takes content from website to suggest their products are same as yours
- Unauthorized distributors stealing content and marks



QUESTIONS?

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